United States Circuit Court of Appeals

FOR THE SECOND CIRCUIT.

VICTOR TALKING MACHINE COMPANY and UNITED STATES GRAMOPHONE COMPANY,

Complainants-Appellees,

vs.

TALK-O-PHONE COMPANY,

Defendant-Appellant.

VICTOR TALKING MACHINE COMPANY and UNITED STATES GRAMOPHONE COMPANY,

Complainants-Appellees,

vs.

LEEDS & CATLIN COMPANY,

Defendant-Appellant.

APPELLANTS' BRIEF.

LOUIS HICKS,
Counsel for Defendants-Appellants,
71 Nassau Street,
New York, N. Y.

SUMMARY AND INDEX OF APPELLANTS' ARGUMENT.

PAGE

Statement. 1

Assignment of Errors. 3

POINT ONE. Berliner's basic invention for the gramophone is set forth in letters-patent of the United States No. 372,786, of November 8, 1887, the application for which was filed May 4, 1887. The patent in suit, including claims 5 and 35 thereof, describes and claims only improvements upon the basic invention. The Circuit Court, therefore, erred in holding that claims 5 and 35 of the patent in suit are claims for the basic invention, and erred in holding that the patent in suit did not expire, as to claims 5 and 35, with the expiration of prior foreign patents to Berliner for an invention for which the patent in suit was granted. 7

(*a*) *The Circuit Court, being in doubt, was constrained to grant the injunctions to permit appeals to be taken.* 7

(*b*) *In the prior suit, the evidence was not sufficient to differentiate Berliner's basic invention.* 9

(*c*) *Brief statement of Berliner's basic invention. Claims 5 and 35, in suit, are for improvements thereon.* 10

(*d*) *A comparison and analysis of the patent in suit and of Berliner's other patents, three of which granted to him for his inventions and the inventions of Werner Suess are new evidence, show the limitations of the improvements in claims 5 and 35 and in the other claims of the patent in suit.* 13

PAGE

(e) The expression "principal invention" was used by the Supreme Court in Siemens' Adm'r v. Sellers, 123 U. S. 276, merely to designate one of two inventions, and not as a ground of decision. The Circuit Court erred in refusing to follow the principle of the decision in that case and in holding that the patent in suit has a plurality of terms. 21

(f) Berliner's basic invention is set forth in his basic patent No. 372,786. 23

(g) Method of reproducing sound according to Berliner's basic invention. The method employed by defendants is an improvement thereon. 25

(h) No matter what may be the construction given to claims 5 and 35, the two claims, like all the other claims of the patent in suit, are claims for improvements merely. 27

(i) In the prior suit, the Circuit Court of Appeals and the Circuit Court, not having Berliner's basic patent No. 372,786 before them, assumed, the point not being important there as it is here, that patent No. 564,586 was Berliner's basic patent. 28

(j) Berliner's prior foreign patents further prove that claims 5 and 35, like all the other claims of the patent in suit, cover only improvements upon his basic invention. 30

(k) Claims 5 and 35, construed in the light of the new evidence presented in the records of the suits at bar, are limited to improvements, and to improvements in the details of construction of the reproducer. The Circuit Court erred in holding that these claims cover a basic invention. 33

(l) Defendants do not use the improved reproducer of the patent in suit. 33

(m) Berliner's basic invention and his and Suess' improvements thereon, shown by the patents in evidence, were all patented in for-

PAGE

cign countries, before the grant of the patent in suit, by patents which have all expired. Berliner's home patents for his same basic invention and improvements thereon have also expired. The holding of the Circuit Court that claims 5 and 35 can alone still survive is contrary to the plain meaning, and contrary to the equity, of § 4887 of the Revised Statutes. 34

(*n*) *Conclusion of Point One.* 36

POINT TWO. Berliner patent in suit No. 534,543, of February 19, 1895, was granted for an invention previously patented by Berliner in Germany, by Berliner German patent No. 53,622, of November 20, 1889. The term of the patent in suit, therefore, expired with the expiration of the term of the prior German patent on Nov. 7, 1902, before either of these suits was begun. Section 4887 of the Revised Statutes considered and the authorities collated. 37

(*a*) *German patent No. 53,622 is new evidence. Defendants' affidavits show that it was granted for an invention for which the patent in suit was granted.* 37

(*b*) *German patent No. 53,622, being a patent for an improvement, expired on Nov. 7, 1902, according to the German law, with the patent for the invention upon which the improvement was made.* 37

(*c*) *The description and claims of the patent in suit for the invention previously patented by the German patent.* 38

(*d*) *The description and claim of the prior German patent for an invention for which the patent in suit was granted. Judge Townsend found that the invention described and claimed in the German patent is described and claimed in the patent in suit.* 43

(*e*) *Futile effort of complainants' counsel in the Circuit Court to find some slight difference between the description and drawings of*

PAGE

German patent No. 53,622 and French patent No. 207,090 and the description and drawings of the patent in suit. 45

(*f*) *The provision of § 4887 of the Revised Statutes, fixing the single term of a home "patent granted for an invention" previously patented in a foreign country, is clear and unambiguous and must control the decision in these suits without change by judicial action "based upon some supposed policy of Congress." The Circuit Court erred in refusing to follow the unambiguous provision of the Statute, and in holding, contrary to the statute and the decision of the Supreme Court, that a patent can have a plurality of terms and can expire in parcels.* 48

(*g*) *The principle of the decisions of the Supreme Court in Siemens' Adm'r v. Sellers, 123 U. S. 276, and of the lower courts following that decision, is that a "patent cannot expire in parcels", "cannot be construed as running partly from one date and partly from another. This would be productive of endless confusion." Such principle is derived from, and is the only principle which can be derived from, the provision of § 4887 of the Revised Statutes fixing the term of the patent.* 55

(*h*) *Broadening or narrowing of the claims of an American patent will not prevent the operation of the Statute.* 58

(*i*) *The test of the question, whether an American "patent is granted for an invention" previously patented in a foreign country, is whether an article made according to the description of the invention of the foreign patent would infringe the American patent, that is any claim of the American patent.* 58

(*j*) *In determining whether a home patent is granted for an invention previously patented in a foreign country, the precise question is whether ANY of the claims of the home patent include the invention or some substantive part*

PAGE

of the invention shown by the prior foreign patent. If so, the home patent expires as to all its claims with the foreign patent since a "PATENT CANNOT EXPIRE IN PARCELS." 60

(k) The Circuit Court and the Circuit Court of Appeals for the Second Circuit have determined the question, whether a home patent was "granted for an invention" previously patented in a foreign country, by ascertaining whether "ANY ONE of the inventions" claimed in the home patent is contained in the prior foreign patent, and whether any claim of the home patent would be infringed by the structure of the foreign patent; and have held, in effect, that in such case the home patent could not expire in parcels. 62

(l) The improvements claimed in claims 24-34 are included among the elements of the improvements claimed in claims 5 and 35 of the patent in suit. Claims 5 and 35, being claims for improvements merely, as above shown under Point One, must expire, under any construction of the Statute, with the expiration of other claims for improvements, and, being claims for improvements which include the improvements claimed in the claims which concededly have expired, claims 5 and 35 must, a fortiori, have expired with the expiration of the other claims for improvements. 65

(m) Judge Brown has held, in Sawyer Spindle Co. v. Carpenter, 133 Fed. 238, aff'd, 143 Fed. 976, (1), that a patent cannot expire in part and survive in part; and (2) that a generic claim, covering the specific form of a specie claim and other forms as well, must, under any construction of the statute, expire with the expiration of the specie claim. Hence, if claims 5 and 35 in suit are generic or broad claims, they must have expired, with the specie claims under the second part of Judge Brown's decision, as well as under the first part. 69

PAGE

(n) In order that the statute shall apply and limit the term of the home patent, the home patent must be granted for an invention for which the prior foreign patent was granted. Aquarama Co. v. Old Mill Co., 124 Fed. 229; Westinghouse Co. v. Stanley Co., 138 Fed. 123. 71

(o) Judge Lacombe, in the Welsbach Light Co. cases, held that the broad generic claim of a home patent expired with the expiration of a prior foreign patent which did not cover the broad invention but covered only a species of the invention. 74

(p) Broadening or narrowing the invention of the home patent, or changing the form of the claims from process to product, will not save the home patent. If a structure made pursuant to the prior foreign patent will infringe the home patent, the latter expires with the former. This, say Judges Coxe and Wheeler, is the essence of the test. 77

POINT THREE. Berliner patent in suit No. 534,543, of February 19, 1895, was granted for inventions previously patented by Berliner in France, by Berliner French patent No. 207,090, of July 19, 1890. The term of the patent in suit, therefore, expired with the expiration of the term of the prior French patent on July 19, 1905, before the motions for preliminary injunction were made. 79

(a) French patent No. 207,090 is new evidence. Defendants' affidavits show that it was granted for inventions for which the patent in suit was granted. 79

(b) French patent No. 207,090, according to the French law, expired July 19, 1905. 80

(c) The description and claims of the prior French patent and of the patent in suit for inventions for which the patent in suit was granted. 80

(d) Judge Townsend found that French patent No. 207,090 covers the improvements of

PAGE

the patent in suit in the recorder and reproducer. 89

POINT FOUR. Berliner patent in suit No. 534,543, of February 19, 1895, expired, before suit was begun, on November 8, 1901, with English patent No. 15,232, of November 8, 1887; and on November 7, 1902, with German patent No. 45,048, of November 8, 1887; and on November 8, 1902, with French patent No. 186,827, of November 8, 1887. 90

(*a*) *This defense of expiration is based upon the opinion of the Circuit Court of Appeals in the prior suit.* 90

(*b*) *The inventions covered by the three patents mentioned were "previously patented" in the foreign countries.* 91

(*c*) *The three prior foreign patents mentioned, each, cover the inventions of Berliner's home patents No. 564,586 and No. 372,786.* 91

(*d*) *The Circuit Court of Appeals held, in the prior suit, that claims 5 and 35, in suit, broadly cover the invention of patent No. 564,586; hence, they cover the same invention previously patented in the three foreign patents mentioned.* 93

(*e*) *If the invention of claims 5 and 35, in suit, is not the same as the invention of patent No. 564,586, then defendants' new defence of two years prior, public use is a valid, complete defence, proven beyond a reasonable doubt.* 94

(*f*) *Berliner himself, in patent No. 564,586, asserts that the invention, illustrated in Fig. 10 of that patent and construed by the courts on the evidence in the prior suit to be the invention of claims 5 and 35 in suit, is a mere modification, embodying the main features of the invention of patent No. 564,586.* 98

(*g*) *The evidence shows that the invention of claims 5 and 35 in suit, as construed by the*

PAGE

courts in the prior suit, on the evidence therein, is the same as the invention of patent No. 564,586 and of the three prior foreign patents mentioned. 100

(*h*) *Two patents are for the same invention, although each attempts to cover separate features thereof. The finding of the Circuit Court that the three prior foreign patents do not show Fig. 10 of patent No. 564,586, is, therefore, immaterial.* 101

(*i*) *It may, in addition, be noted that claims 31 and 32 and 6 and 8 of the patent in suit would be infringed by the lever and stylus of the prior German patent mentioned.* 104

(*j*) *Claims 5 and 35 of the patent in suit, claim 8 of patent No. 564,586, and claim 9 of the prior English patent mentioned, for example, cover the same invention. Claims 5 and 35 could not, therefore, survive the expiration of the three prior foreign patents mentioned.* 106

(*k*) *As above shown under sub-division (h) of this point, two patents cannot be secured for separate features of an invention. The invention of claims 5 and 35 in suit, is a feature of the invention of patent No. 564,586, or it is not. If it is, then that INVENTION was previously patented by the three foreign patents mentioned and claims 5 and 35 expired with them; if it is not, then the application for patent No. 564,586, filed Nov. 7, 1887, was not an application for the invention of claims 5 and 35 and the new defence of two years prior, public use set forth under subdivision (e) of this point is valid.* 111

(*l*) *The new evidence in the suits at bar proves that Berliner was not the inventor of the invention of claims 5 and 35 as construed by the courts in the prior suit.* 111

POINT FIVE. Grouping together the expired prior foreign Berliner patents discussed under

PAGE

Points Two, Three and Four, it is clear that the essence of the invention set forth in the various claims of the patent in suit was previously patented in foreign countries. There is no authority in the Statute for holding that claims 5 and 35 in suit can still survive. 113

POINT SIX. In Canadian patent No. 41,901, of February 11, 1893, to Berliner, assignee of Suess, Berliner asserted that a reproducing stylus mounted to have a free movement controlled by the walls of the record-groove over the surface of the record tablet was the invention of Suess. Unless, therefore, claims 5 and 35 of the patent in suit are limited to Berliner's improvements in the details of construction of his reproducer, Suess anticipated Berliner and claims 5 and 35 are invalid. 115

(*a*) *The Canadian patent is set forth in the records and discussed in defendants' affidavits.* 115

(*b*) *Judge Townsend correctly found that the Canadian patent "discloses and broadly claims the invention of the claims here in suit", as construed by the courts in the prior suit; and erred in not further finding, as a result thereof, that unless a limited construction be put upon the said claims, they are invalid.* 116

(*c*) *The new evidence in the suits at bar proves that the features of the gramophone here in controversy were the invention of Suess and in no particular the invention of Berliner.* 119

(*d*) *In the prior suit, complainants, in order to distinguish the Berliner-Suess home patent, relied upon the absence of claims therein broadly covering the pivoted swinging arm and the stylus point adapted to be vibrated and propelled by the record-groove. The Berliner-Suess Canadian patent contains such broad claims and covers the invention of claims 5 and 35 in suit, as construed by the courts in the prior suit.* 120

(*e*) *In the prior suit, because of the absence*

PAGE

of the evidence contained in the records of the suits at bar, the courts were not apprised of the radical departure of Suess' improvements from Berliner's early gramophone and were not informed that defendants' machines, as to the features in controversy, embody only Suess' improvements. 121

(*f*) *The claims of the Berliner-Suess Canalian patent prove that the movement of the stylus across the face of the record by means of the pressure exerted upon the stylus by the walls of the record-groove was the invention of Suess. This explains why that invention was never previously or subsequently claimed by Berliner and necessitates a limited construction of claims 5 and 35 in suit.* 122

(*g*) *Had the new evidence in the suits at bar been before the courts in the prior suit, the limitations of the invention of claims 5 and 35 in suit would have been clearly understood and stated.* 123

(*h*) *It is not reasonable to hold that what Berliner claimed in Canada as the invention of Suess, he subsequently claimed in the United States, by the claims in suit, as his own invention. Claims 5 and 35 must, therefore, be limited, and, when limited, they are not infringed by defendants.* 124

(*i*) *Defendants use the reproducer of Suess' gramophone, shown in the Canadian patent, which reproducer has none of the features of the invention of the patent in suit. Defendants' machines embody the invention of Suess.* 127

(*j*) *The same patent solicitor, acting for Berliner, made the application for the Berliner-Suess Canadain patent and the application for the patent in suit. It is not reasonable to hold that he first claimed the invention for Suess in Canada and then claimed the same invention for Berliner in the United States.* 128

(*k*) *Berliner's Canadian patent No. 55,079,*

PAGE

identical with the patent in suit, was applied for and issued after the issue of the Berliner-Suess Canadian patent; hence, the Canadian patent office, as well as Berliner, considered that claims 5 and 35 did not cover the broad invention of the earlier Berliner-Suess Canadian patent, but were limited, as above stated. 129

POINT SEVEN. Unless claims 5 and 35 of the patent in suit are limited by Berliner's improvements in the details of construction of his reproducer, abandonment of the invention by Berliner is clearly proved. 130

(a) The Berliner-Suess Canadian patent is incontrovertible proof of abandonment by Berliner. 130

(b) Berliner, having elected to claim the invention in Canada as the invention of Suess, became estopped, under the authorities, from subsequently claiming the invention as his own. 131

(c) Other evidence in the records, taken with the Berliner-Suess Canadian patent, further proves abandonment by Berliner. Berliner never claimed in any patent the special features shown in Figure 10 of patent No. 564,586, because they were not his invention. 132

(d) In the Electrical World for November 12, 1887, more than four years before the application for the patent in suit was filed, Berliner published a description of the special features of the apparatus shown in Figure 10 of patent No. 564,586. After that date Berliner never again described or referred to such impractical apparatus. 133

(e) In his lecture before the Franklin Institute on May 16, 1888, Berliner acknowledged that the freely swinging, pivoted arm adapted, with the aid of the record-groove to guide the reproducing stylus across the face of the record, was the very ingenious adaptation of Suess. 135

PAGE

(f) In the Electrical World for August 18, 1888, nearly four years before the application for the patent in suit was filed, Berliner published a complete description of the perfected gramophone, with a perfect illustration thereof embodying the invention of Suess, which invention included all the features of defendants' machines and all the features shown and claimed in the Berliner-Suess Canadian patent. Still Berliner made no claim in any patent for such features. 136

(g) In Berliner-Suess United States patent No. 427,279 issued May 6, 1891, on an application filed August 6, 1889, nearly three years before the application for the patent in suit was filed, Berliner published a full description and illustration of the perfected gramophone shown in the Electrical World for August 18, 1888, and still made no claim that the features thereof here in controversy were his invention. 137

(h) On May 5, 1891, about a year before the application for the patent in suit was filed, Berliner, as the assignee of Suess, applied for the Berliner-Suess Canadian patent, disclosing and claiming therein as the invention of Suess, all the features of the gramophone here in controversy, as Judge Townsend has found. Still Berliner had made no claim in any patent that he was the inventor of such features. 138

(i) When, on March 30, 1892, Berliner filed the application for the patent in suit, he had irrevocably abandoned any right which he may have had to claim as his invention the features of the gramophone here in controversy. 139

(j) The new evidence in the suits at bar conclusively shows that the apparatus shown in Figure 10 of patent No. 564,586 was impracticable, and never went into use. If it was the invention of Berliner, he abandoned it. 139

(k) The freely swinging, pivoted arm with the horn and reproducing diaphragm and stylus mounted thereon are features of the Suess

PAGE

invention, and such features are embodied in defendants' machines. Such a horn could not possibly be used in the apparatus shown in Figure 10 of patent No. 564,586, and for other reasons set forth in the affidavits of defendants' experts, the apparatus shown in said Figure 10 is impracticable. 143

(*l*) *An impracticable apparatus is not, under the authorities, an anticipation of a successful apparatus.* 144

(*m*) *Abandonment of an invention may be evinced by the conduct of the inventor at any time before or after the patent is granted.* 145

POINT EIGHT. Berliner patent in suit No. 534,543, of February 19, 1895, expired February 11, 1899, before this suit was begun with the expiration of the term of six years for which the prior Berliner-Suess Canadian patent No. 41,901, of February 11, 1893, was granted. 145

(*a*) *Judge Townsend found that the Berliner-Suess Canadian patent "discloses and broadly claims the invention covered by the claims here in suit," and "that if this patent expired, as claimed in 1899, the patent in suit expired at the same time." Judge Townsend was in great doubt as to the effect upon the patent in suit, of the expiration of the Canadian patent in 1899, but resolved the doubt on this and other points in favor of complainants to permit an appeal to be taken.* 145

(*b*) *Assuming, as Judge Townsend found, that the Berliner-Suess Canadian patent "discloses and br[illegible]ly claims the invention covered by the claims here in suit", the patent in suit expired with the expiration of the six year term for which the Canadian patent was granted, on Feb. 11, 1889.* 147

(*c*) *The invention of the Berliner-Suess Canadian patent was, under the statute and decided cases, patented and caused to be patented by Berliner, the patentee of the patent in suit.* 148

PAGE

(d) Under the patent act of Canada a Canadian patent expires, within the meaning of § 4887 of the Revised Statutes at the expiration of the term for which the fee to the government has been paid, unless a further fee for a further term is paid. The patent does not lapse, and is not forfeited, but its term expires. 150

(e) Judge Townsend erred in holding that the legal term of the Canadian patent did not expire but lapsed or became forfeited in 1899. The Bonsack case, cited by Judge Townsend in support of his ruling, is directly opposed thereto, and the Welsbach case, cited by him in support of his ruling, in no way involved the question at issue. 152

(f) In the Bonsack case it was squarely held that a Canadian patent for which the fee for a five year term only had been paid and which was not prolonged by payment of a further fee for a further term before the expiration of the original five year term, expired with the expiration of the original five year term and did not lapse or become forfeited. 154

(g) In the Welsbach case the only question involved was whether, where a prior French patent had lapsed before the grant of the home patent but after the filing of the application therefor, the home patent was invalid upon the ground of abandonment or other ground arising out of those facts only. The question whether the prior French patent had lapsed or had expired was not involved, for, concededly, it had lapsed. 158

(h) The distinction, under § 4887 of the Revised Statutes, between patents granted for a short term and not prolonged before the expiration of the short term for a further term by reason of which the short term and the patent expire by lapse of time, and patents granted for a fixed term subject to forfeiture or lapsing as a penalty upon breach of a condition subsequent during the term for which the patent was granted is well settled by authority in the pat-

PAGE

ent law of this country. Judge Townsend erred in not recognizing this distinction and in not holding under the doctrine of stare decisis that the Canadian patent expired in 1899 with the expiration of the six year term for which it was granted, and which was the only term it ever had. 159

POINT NINE. The Berliner-Suess Canadian patent No. 41,901, of February 11, 1893, could not, under the Canadian patent Act, be prolonged beyond May 6, 1905, because the same invention having been patented by Suess on May 6, 1890 by French patent No. 205,491, "under any circumstances, if a foreign patent exists, the Canadian patent shall expire at the earliest date on which any foreign patent for the same invention expires." Therefore, even if the Canadian patent did not expire in 1899, it did expire on May 6, 1905, with the expiration of the term of the prior French patent, and with it the patent in suit expired, before the making of the motions for preliminary injunction. 167

POINT TEN. Berliner patent in suit No. 534,543 was anticipated by English patent No. 1644, of 1878, to Edison, as to claims 5 and 35, if those claims are to be broadly construed and not limited by the special form of reproducer shown in figures 6 and 7. 176

POINT ELEVEN. In the prior suit between complainants and the American Graphophone Company decided by Judge Hazel and the Circuit Court of Appeals, complainants, by contract, promised the defendant, the American Graphophone Company, a license under the patent in case defendant should lose, and promised also by the same contract to waive all claim for past royalties and damages. The prior suit was not, therefore, a suit in which Berliner patent in suit No. 534,543, of February 19, 1895, was fairly in controversy. The Circuit Court of Appeals has held defendant was guilty of laches in its search for defences in that suit. 182

PAGE

POINT TWELVE. Defendants' machines do not infringe claims 5 and 35 of the patent in suit when those claims are properly construed in view of the prior art disclosed by defendants in opposition to the motions. 187

POINT THIRTEEN. Complainants delayed the prosecution of these suits, took no testimony and defendants were entitled, at the time of the motions, to dismissals of the bills upon the pleadings under the rules of the Circuit Court. 188

POINT FOURTEEN. Sound records having lateral undulations existed before the date of the invention of the patent in suit and were patented by Berliner in several forms in divers patents which have expired. Such records are capable of use with machines of various constructions. The proposition that the making and selling of such sound records can be an infringement of the patent in suit in untenable. 191

POINT FIFTEEN. The Talk-O-Phones operating by mechanical feed devices do not infringe claims 5 and 35 of the patent in suit. 195

CONCLUSION. It appearing that the patent in suit expired before either of these suits was begun and that the claims in suit are invalid or not infringed, the motions for preliminary injunction should have been denied and the bills dismissed. The orders should, therefore, be reversed with directions to dismiss the bills. 198

Argued by
Louis Hicks.

United States Circuit Court of Appeals

FOR THE SECOND CIRCUIT.

VICTOR TALKING MACHINE COMPANY and UNITED STATES GRAMOPHONE COMPANY,
Complainants-Appellees,

vs.

TALK-O-PHONE COMPANY,
Defendant-Appellant.

VICTOR TALKING MACHINE COMPANY and UNITED STATES GRAMOPHONE COMPANY,
Complainants-Appellees,

vs.

LEEDS & CATLIN COMPANY,
Defendant-Appellant.

APPELLANTS' BRIEF.

Statement.

These are appeals from orders granting preliminary injunctions. The bills allege infringement of claims 5 and 35 of Letters-Patent No. 534, 543, of February 19, 1895, to Emile Berliner, for improve-

ments in the method of and apparatus for recording and reproducing sounds. Claims 5 and 35 of the patent were sustained at final hearing by Judge Hazel, whose decision was affirmed on appeal by the Circuit Court of Appeals, in the suit of these complainants against the American Graphophone Company. In the court below, in the suits at bar, the motions for preliminary injunction were argued together, because the defences interposed on behalf of each defendant were, for the most part, alike. There is, however, one substantial difference between the positions of the two defendants. The Talk-O-Phone Company manufactures only talking machines (p. 283, fol. 849) and the Leeds & Catlin Company manufactures only sound records (p. 116, fol. 347). In the settlement of an account, the Leeds & Catlin Company took a number of talking machines from the Talk-O-Phone Company in part payment (p. 292, fol. 876; p. 284, fol. 851). Hence, the questions presented in the two suits are alike, although the interest of the Talk-O-Phone Company in the suits is far greater than that of the Leeds & Catlin Company. There is no connection whatever existing between the Talk-O-Phone Company and the Leeds & Catlin Company, and the affidavit of Thomae in the Talk-O-Phone Company case to that effect, based entirely upon innuendo, is false and disproved by the answering affidavits of Mr. Irish and of Mr. Leeds (T. case, pp. 325, 328; L. & C. case, pp. 309, 312), presidents, respectively, of the Talk-O-Phone Company and of the Leeds & Catlin Company.

It will save the time of the court to argue the appeals in the two above entitled suits together. The records on appeal in the two suits are identical, except that at pages 47-49 an affidavit of Kennedy alleging infringement appears in the Talk-O-Phone Company case and an affidavit of Fagan alleging

infringement appears in the Leeds & Catlin Company case, and except that the affidavit of Thomae which appears at pages 309-324 of the Talk-O-Phone Company case is not a part of the record in the Leeds & Catlin Company case. Excepting the affidavits of Kennedy and Fagan mentioned, the numbers of the pages and the subject matters of the two records are identical up to and including page 308. After page 308 the subject matters of the two records are identical except that the Thomae affidavit is not a part of the record in the Leeds & Catlin Company case, and the numbers of the pages subsequent to page 308 differ in the two records because of the in ertion of the Thomae affidavit in the record in the Talk-O-Phone Company case at pages 309-324 thereof.

Separate references in this brief to the records will, therefore, seldom be necessary, and only when reference is made to the pages subsequent to page 308.

Assignment of Errors.

The errors assigned, all of which are relied upon, are the same in both suits (T., case, p. 549; L. & C., case, p. 534) and are as follows;—

The Circuit Court erred in the following particulars:

1. In not holding that the patent in suit, No. 534,543, expired with the prior German patent No. 53,622, of November 20, 1889.

2. In not holding that claim 5 of the patent in suit, No. 534,543, expired with the prior German patent No. 53,622, of November 20, 1889.

3. In not holding that claim 35 of the patent in suit, No. 534,543, expired with the expiration of the prior German patent, No. 53,622, of November 20, 1889.

4. In not holding that the patent in suit, No. 534,543, expired with the prior French patent No. 207,090, of July 19, 1890.

5. In not holding that claim 5 of the patent in suit, No. 534,543, expired with the prior French patent No. 207,090, of July 19, 1890.

6. In not holding that claim 35 of the patent in suit, No. 534,543, expired with the expiration of the prior French patent No. 207,090, of July 19, 1890.

7. In not holding that the patent in suit, No. 534,543, including claims 5 and 35, expired with English patent No. 15,232, of November 8, 1887.

8. In not holding that the patent in suit, No. 534,543, including claims 5 and 35, expired with German patent No. 45,048, of November 8, 1887.

9. In not holding that the patent in suit, No. 534,543, including claims 5 and 35, expired with French patent No. 186,827, of November 8, 1887.

10. In not holding that Berliner was not the inventor of the invention set forth in claims 5 and 35 of the patent in suit.

11. In not holding that the invention of claims 5 and 35 of the patent in suit, No. 534,543, was anticipated by Werner Suess in Canadian patent No. 41,901, of February 11, 1893.

12. In not holding that Berliner had abandoned the invention claimed in claims 5 and 35 of the patent in suit, No. 534,543, before he applied for a patent therefor.

13. In not holding that Berliner had abandoned the invention claimed in claims 5 and 35 of the patent in suit, No. 534,543, before the patent was issued.

14. In not holding that claims 5 and 35 of the patent in suit, No. 534,543, should be limited to Berliner's improvements in the details of construction of his reproducer.

15. In not holding that defendant's devices do not infringe claims 5 and 35 of the patent in suit, No. 534,543.

16. In not holding that the patent in suit, No. 534,543, expired February 11, 1899, with the expiration of the term of six years for which the prior Canadian patent, No. 41,901, of February 11, 1893, was granted.

17. In not holding that claims 5 and 35 of the patent in suit, No. 534,543, were anticipated by English patent No. 1644, of 1878, to Edison.

18. In not holding that the patent in suit, No. 534,543, was not fairly in controversy in the prior suit between these complainants and the American Graphophone Company, and that the adjudication in that suit formed no proper basis for a preliminary injunction.

19. In not holding that at the time of the hearing of the motion for preliminary injunction defendant was entitled to have the cause heard upon the pleadings and the bill dismissed.

20. In not holding that the patent in suit, No. 534,543, had expired before the commencement of this suit.

21. In not holding that the patent in suit No. 534,543 had expired before the making of the motion for preliminary injunction and the making of the order entered May 2, 1906, and hereby appealed from.

22. In not denying the motion for preliminary injunction.

23. In not dimissing the bill of complaint upon the hearing of the motion for preliminary injunction.

24. In not holding that claims 5 and 35 of the patent in suit, No. 534,543, are and always have been invalid by reason of more than two years public prior use in the United States by Berliner before the date of the filing of his application therefor.

25. In not holding that claims 5 and 35 of the patent in suit, No. 534,543, are and always have been invalid by reason of more than two years public prior use in the United States by T. Commerford Martin before the date of the filing of the application therefor.

26. In not holding that in view of the state of the prior art claim 5 of the patent in suit, No. 534,543, is void for lack of invention.

27. In not holding that in view of the state of the prior art claim 35 of the patent in suit, No. 534,543, is void for lack of invention.

28. In not holding that in view of the prior art, claim 5 should be limited to a method of reproducing sounds wherein the stylus is vibrated substantially as described in the specification of the patent in suit, No. 534,543, and shown in figures 6 and 7 thereof.

29. In not holding that in view of the prior art, claim 35 of the patent in suit, No. 534,543, should be limited to a sound reproducing apparatus having a reproducing stylus free to be vibrated substantially as described in the specification and shown in figures 6 and 7 thereof.

30. In not holding that claim 5 of the patent in suit, No. 534,543, is void as being for the function of a machine.

31. In not holding that claim 35 of the patent in suit, No. 534,543, is void as being for the function of a machine.

32. In not holding that claim 35 of the patent in suit, No. 534,543, is void as being indefinite, meaningless and claiming nothing.

33. In enjoining the manufacturing and selling of an article under claim 5 of the patent in suit, No. 534,543, which is limited to a method.

34. In granting the order for preliminary injunction.

35. In not denying the motion for preliminary injunction because of complainants' failure to prove title to the patent in suit, No. 534,543.

POINT ONE.

Berliner's basic invention for the gramophone is set forth in Letters Patent of the United States No. 372,786, of November 8, 1887, the application for which was filed May 4, 1887. The patent in suit, including claims 5 and 35 thereof, describes and claims only improvements upon the basic invention. The Circuit Court, therefore, erred in holding that claims 5 and 35 of the patent in suit are claims for the basic invention, and erred in holding that the patent in suit did not expire, as to claims 5 and 35, with the expiration of prior foreign patents to Berliner for an invention for which the patent in suit was granted.

(a). The Circuit Court, being in doubt, was constrained to grant the injunctions to permit appeals to be taken.

Judge Townsend, as appears from his opinion, was in great doubt upon the questions of law raised by the defenses interposed. The learned Judge states in his opinion that he was able to give the authorities cited but a brief examination (T. case, p. 339, fol. 1017; L & C case, p. 323, fol. 969). Although he "reached the conclusion that, *except as to the Suess Canadian patent* No. 41901, the defendants have failed to introduce any new matter which would, in my judgment, have led the Courts to reach a different conclusion if it had been before them in the original suit", nevertheless, even if he was "mistaken in this view," he was, as he says, "*constrained to grant the injunction in order to permit an appeal* and a determination of the questions at the *earliest possible moment*" (T. case, p. 343; L & C case, p. 327). To enable an appeal at once to be taken he "concluded to resolve the doubt" in favor of the complainants (T. case, p. 342, fol. 1026; L & C case, p. 326, fol. 978). The defence of the Suess Canadian patent was alone sufficient to warrant not only a denial of the motions for injunction, but also a dismissal of the bills. However, in order that the Circuit Court of Appeals might pass upon *all* the questions of law and fact raised by the defences interposed, and upon which Judge Townsend was in such doubt, all questions were, for this purpose, resolved in favor of complainants, and decrees for preliminary injunction were entered and stayed pending appeal upon the filing of the usual bonds. Judge Townsend, concluding his opinion, said:—

> "But *even if I am mistaken in this view*, and *if the expiration of the Suess Canadian patent is a complete defence* or *if a decision of the questions raised as to the character and scope of the various patents now introduced for the*

first time should be postponed until final hearing, yet I am *constrained* to grant the injunction in order to permit an appeal and a determination of the questions at the earliest possible moment."

The records before Judge Townsend in the two suits at bar were voluminous, as he said. The reason is that many serious and new defences were interposed by the defendants to the motions for preliminary injunction which were not in any way involved in the prior suit decided by Judge Hazel and the Circuit Court of Appeals. Judge Townsend, therefore, had before him not merely new and important questions of law, but also new and important proofs. Being no doubt, pressed for time, and desiring an early decision by the Appellate Court of the questions presented he was probably able to give less consideration to the subject matter of the new evidence presented to him which he regarded as voluminous and which was not in printed form, than to the authorities cited of which his examination was, as he says, brief.

(*b*). *In the prior suit, the evidence was not sufficient to differentiate Berliner's basic invention.*

In the prior suit decided by Judge Hazel, the evidence was not sufficient to differentiate Berliner's basic invention from the improvements which Berliner made thereon. The defences interposed did not require it. Judge Hazel, therefore, *assumed*, the point not being important in the suit before him, that the invention described and claimed in Berliner's patent No. 564,586, of July 28, 1896, applied for November 7, 1887, included Berliner's basic invention, whereas the fact is, and the proofs now before the court conclusively show, that the invention described and claimed in patent No. 564,586 consists entirely of *improvements* upon

the basic invention. When the Circuit Court of Appeals, in its opinion affirming Judge Hazel's decree, stated that claims 5 and 35 of the patent in suit were "broader claims" for the invention described in patent No. 564,586, and that those claims could have been made in that patent, that court did not hold that claims 5 and 35 of the patent in suit were claims for the basic invention, even though they be "broader claims," and if such holding had been made in that suit the holding would be incorrect upon the proofs now before the court, because the fact is, as the *new* proofs show, that on May 4, 1887, Berliner applied for and on November 8, 1887, obtained his first patent, No. 372,786, for the gramophone, describing and claiming therein his basis invention.

(c). Brief statement of Berliner's basic invention. Claims 5 and 35, in suit, are for improvements thereon.

It will be useful at the present time to state briefly what Berliner's basic invention was. It is so well known in the art that the mere statement of it is at once recognized and accepted by those familiar with the art. A fair, though general statement of it is that made by Berliner's patent solicitor, Mr. Lyons, and accepted by the Patent Office. In the record on an appeal before the Circuit Court of Appeals in a suit between these complainants and the American Graphophone Company, based upon Berliner patent No. 548,623, of October 29, 1895, for improvements upon his basic patent No. 372,786, is a copy of the file wrapper and contents of the proceedings upon the application therefor. In the letter dated April 9th, 1895, Mr. Lyons argued that;—

"The Examiner should know Mr. Edison *never* produced a record of sound waves by *an*

> *undulatory groove of even depth*, but always by a smooth groove of undulatory depth. This is so well known that this applicant was granted a patent just for this mode of recording sounds. This is in fact the *essential difference between the gramophone and the phonograph*, and it would seem to be late in the day to be obliged to argue this point."

The Examiner in his letter of April 13, 1895, in reply, said;—

> "That the statement that the patent to Edison, No. 382,419, shows a phonogram blank having an undulatory groove of even depth representing sound-waves, is an erroneous one, is admitted. It occurred in the last office letter because of an inadvertence.
>
> "The differences between the patents to Edison and those to Berliner, are well known to the Examiner, and it is regretted that applicant should have felt it necessary to prepare such an elaborate argument at this late day."

While the file wrapper and contents of Berliner patent No. 548,623 are not in evidence in the suits at bar, nevertheless the patent to which Mr. Lyons referred, No. 372,786, of November 8, 1887, is in evidence, and that patent shows that the fundamental difference between the gramophone on the one hand, and the phonograph and graphophone on the other hand, is that the gramophone is an instrument for recording and reproducing sound by a method and apparatus, whereby the sound-record is made in non-resisting material in *grooves having lateral undulations of even depth, is copied in solid resisting material*, and is then used for the reproduction of the original sounds through the lateral vibrations of the reproducing stylus caused by the lateral undulations of even depth of the sound-record copied in solid resisting material. *This was Berliner's basic invention.* He so states in the article in the Electrical World for Nov. 12, 1887, in

evidence (p. 243), where he first describes his basic invention in the very words of patent No. 372,786, and then describes the improvements thereon set forth in Patent No. 564,586 for which he had just filed his application on Nov. 7, 1887. This article, Mr. Berliner testifies (p. 230), was prepared by him. All of Berliner's later patents, including the patent in suit and the claims in suit, 5 and 35 thereof, describe and claim merely *improvements*, upon the gramophone constituting the basic invention, designed to accomplish a *more perfect* recording and a *more perfect* reproduction of sound. As will appear from the following statement, made with reference to the proofs now before the court, the thirty-five claims of the patent in suit are all for *improvements* upon the basic invention, and although some of the thirty-five claims may be "broader" than others, nevertheless every one of the thirty-five claims are claims for improvements, and in no sense claims for the basic invention; and there is no principle or rule of law by reason of which claims 5 and 35 can be said to be in a category different from that of the rest of the thirty-five claims since they are all claims in the *category of improvements* upon the same basic invention for recording and reproducing sound.

As will be pointed out, Berliner himself expressly states in the patent in suit that its features of invention are "features of improvement" upon his basic invention. Had Judge Townsend had sufficient time to study the proofs and the authorities cited, he never could logically have reached the conclusion that claims 5 and 35 are claims for the basic invention, or that, being claims for the basic invention, they could survive other claims of the patent which, concededly, expired by reason of the expiration of prior foreign patents for the subject matter thereof; and he never would have been led to hold, for the first time in the history of the patent

law of this country, that, under §4887 of the Revised Statutes, letters-patent of the United States can have *a plurality of terms*, thus bringing endless confusion into the patent law and making it impossible for the public to know what is the term for which a patent is granted or what part of a patent has expired and what part has not expired.

> *(d). A comparison and analysis of the patent in suit and of Berliner's other patents, three of which granted to him for his inventions and the inventions of Werner Sucss are new evidence, show the limitations of the improvements claimed in claims 5 and 35 and in the other claims of the patent in suit.*

Before proceeding further and before considering the several defenses relied upon by defendants, it is necessary to understand clearly the invention described and claimed in the patent in suit No. 534,543, of February 19, 1895, to Berliner for "features of improvement" in the gramophone.

Berliner tells us at the outset that;—

> "My invention has reference to *improvements* in the *method* of and *apparatus* for *recording* and *reproducing* sounds, the *improvements being more particularly directed* to the construction of that kind of sound *recording* and *reproducing* apparatus which I have called gramophone, and for which letters-patent of the United States No. 382,790, dated May 15, 1888, have been granted to me" (p. 1, lines 8-16.)

Referring to Berliner's patent No. 382,790, dated May 15, 1888, it will be seen that Berliner there states (p. 1, lines 8-20) that the invention thereof is an improvement upon that described in the previous *basic* patent to Berliner, No. 372,786, of Nov. 8, 1887.

Referring to patent No. 564,586, of July 28, 1896,

to Berliner for gramophone, it will be seen that Berliner there states (p. 1, lines 8-39) that the invention of that patent has reference likewise to improvements upon his gramophone described in No. 372,786, of November 8, 1887.

Patent No. 372,786, issued November 8, 1887, original application filed May 4, 1887, divisional application filed September 26, 1887, was the first patent which Berliner obtained in the United States upon his gramophone, and it is apparent, therefore, from the references above cited, that Berliner's later patents, No. 382,790, of May 15, 1888, No. 534,543, of February 19, 1895, the patent in suit, and No. 564,586, of July 28, 1896, are for improvements upon the gramophone described in the original basic patent No. 372,786. In the suit of the Victor Talking Machine Company *et al.* against the American Graphophone Company on the patent in suit, No. 534,543, *Berliner's early patents No. 372,786 and No. 382,790 were not in evidence;* hence, the courts did not know what was the nature of Berliner's original gramophone or to what extent patents No. 534,543 and 564,586, described improvements thereon and therein. Nor did the courts know, as appears from Judge Hazel's opinion, to what extent the gramophone of Werner Suess, described in letters-patent No. 427,279, of May 6, 1890, issued to Berliner, assignee of Suess, was an improvement upon or departure from Berliner's early gramophone.

Like all other patents issued to Berliner for the gramophone, the Suess-Berliner patent No. 427,279, states that the invention thereof has reference to improvements upon Berliner's basic invention set forth in patent No. 372,786. The Suess-Berliner patent No. 427,279, says (p. 1, lines 8-21);—

"My invention has reference to improve-

> ments in the reproducing apparatus adapted for use in the method of recording and reproducing sounds set forth in Letters Patents No. 372,786, of November 8, 1887, and No. 382,790, of May 15, 1888, both granted to Emile Berliner. The whole apparatus used for the practice of the said method has been called the "gramophone," and in this class of sound recording and reproducing apparatus the record is ordinarily produced on the face of a rotating disk as a volute band consisting of a sinuous or *undulating groove of even depth.*"

Since, as stated above, Berliner patents No. 372,786 and No. 382,790 were not in evidence in the prior suit, Judge Hazel, had no means of knowing the extent of Suess's improvements and, therefore, concluded, upon the erroneous testimony of complainants' expert, that the extent of Suess's improvements was limited by the narrow claims of patent No. 427,279 and by certain language in the specification which, in the absence of the prior Berliner patents, was not intelligible; an erroneous conclusion, when the two prior Berliner patents mentioned and the *broad* claims of the Suess-Berliner Canadian patent, No. 41,901, here presented as *new evidence*, are read and considered. The essential point made and to be considered here, however, is that when Berliner filed his application for the patent in suit, No. 534,543, on March 30, 1892, he had already secured No. 372,786 on November 8, 1887, and No. 382,790 on May 15, 1888, and had, more than four years previously and on November 7, 1887, filed his application for No. 564,586, although the patent upon the application of November 7, 1887, did not issue until July 28, 1896. He had also secured for *Suess'* improvements Letters-Patent of the United States, No. 427,279, issued May 6, 1890, on an application filed August 6, 1889, and Letters-Patent of Canada, No. 41901, issued February 11,

1893, on an application filed May 5, 1891, which Letters-Patent of Canada for Suess' improvements Judge Townsend found (T. case, p. 340, fol. 1019; L & C case, p. 324, fol. 971), "*discloses and broadly claims the invention covered by the claims here in suit.*"

The application for the patent in suit, therefore, was filed several years later, at least four years later, than the application for any one of the other three Berliner patents above mentioned and considerably later than the application for either of the two Suess-Berliner patents mentioned. We should expect to find in the patent in suit, therefore, a statement that the invention of this patent consists in *improvements in details* of the gramophone; and such is the statement which Berliner makes in the first words describing the invention of the patent in suit, for at page 1, lines 17-36, he says;—

> "*One feature* of my invention has reference to *improvements* in the *method of recording sound* by tracing upon a fatty film deposited upon a metallic surface, undulatory lines, corresponding to sound waves, and then etching such lines in the metal base, or, as it is now commonly called, the record tablet; while the *other features* of my invention have reference to the *construction of the details of both the recorder and the reproducer of the gramophone.* Each of these *features of improvement* are designed to overcome certain difficulties, and to avoid certain imperfections *heretofore met with in the operation of the gramophone.* These difficulties and imperfections, and the manner in which they are avoided, will be particularly pointed out in the following detailed description with reference to the accompanying drawings, in which—"

In the specification Berliner first describes his improved recording machine as a whole (p. 1, line 51, to p. 3, line 2.) This improved record-

ing machine is illustrated in figures 1 and 2. The construction of the apparatus for the convenient application of alcohol, more alcohol than was used according to prior patent No. 382,790, during the process of recording, is the main feature here described of the improvement. Next Berliner describes the recording diaphragm and stylus or recorder (p. 3, line 3, to p. 3, line 109). The recorder is illustrated in figures 4 and 5 of the drawings and is shown in figures 1 and 2 as part of the recording machine. Next Berliner describes the mouth-piece shown in figure 8 (p. 3, lines 110-126). Next Berliner describes the use of the recording machine for the recording of sound with the aid of alcohol spread continuously, instead of once as in prior patent No. 382,790, upon the surface of the record tablet (p. 3, line 127, to p. 4, line 94). This operation is illustrated in Figure 1. Next Berliner describes the reproducing apparatus as a whole (p. 4, line 95, to p. 5, line 33). It will be noticed that although Berliner states that "*My* improved gramophone recorder is shown as a whole in figs. 1 and 2" (p 1, line 51), he does not state that the reproducing apparatus as a whole is his invention; but his language is, "*The* reproducing apparatus as a whole is represented in Fig. 3," (p. 4, line 95.) As will hereinafter be shown, the reproducing apparatus as a whole and the main features of the reproducing apparatus were, *according to Berliner's own statements*, and the incontrovertible fact, the invention of Werner Suess. Next Berliner describes the reproducing diaphragm and stylus or reproducer (p. 5, lines 34-102). The reproducer is illustrated in figs. 6 and 7, is shown as *part of the reproducing apparatus illustrated as a whole* in fig. 3, and embodies the *essence* of the improvements claimed in claims, 5 and 35, in suit.

Next come the claims of the patent, thirty-five in number. Claims 1-4 cover the continuous use of alcohol in the process of recording. A very narrow improvement, if any, upon the invention of prior patent, No. 382,790. Claim 5 covers an improvement in the method of reproducing sound, consisting in "*vibrating*" and "propelling" a stylus *as described*. Claims 6-16 cover the improved *recording* diaphragm and stylus or recorder. Claims 17-22 cover a new form of the horizontal rotary table, shown in the earlier application for patent No. 564,586 and in prior foreign patents. Claim 23 covers the mouth-piece shown in fig. 8. Claims 24-34, except claim 31, which is for the *recording* stylus, are for the improved *reproducing* diaphragm and stylus or reproducer, claim 25 covering also the improved *recording* diaphragm and stylus. Claim 35 covers an improvement in the reproducing apparatus, a *travelling* tablet having a sound record formed thereon and a reproducing stylus, shaped for engagement with the record as in claim 32 and free to be *vibrated* and propelled *as described*. Such then are the description and claims of the patent in suit covering *as one feature*, the improvement in the method of recording and covering, *as the other features*, the construction of the "*details*" of both the recorder and the reproducer of the gramophone, and constituting *improvements* upon the method of, and apparatus for, recording and reproducing sound set forth in the *basic patent* No. 372,786.

As will hereinafter be shown, the patent in suit has expired, and claims 5 and 35 were anticipated by Werner Suess and Edison *unless* claims 5 and 35 are limited by the improvements in the details of the reproducer, whereby the stylus, provided with a *wedge-shaped point*, so shaped for engagement with the record, is permitted to be *vibrated in the manner described*.

A comparison of Figs. 1 and 2, which show Berliner's improved gramophone recorder as a whole, with Figs. 4 and 5, which show the details of improvement in the recorder, makes it clear that the improvements in the "*details of the recorder*" are incorporated in the improved gramophone recorder as a whole and form a *substantive* part thereof. So a comparison of Fig. 3, which shows the reproducing apparatus as a whole, not claimed by Berliner to be his invention, with Figs. 6 and 7, which show the details of improvement in the reproducer, makes it clear that the improvements in the "*details of the reproducer*" are incorporated in the reproducing apparatus as a whole and form a *substantive* part thereof, and are, indeed, the essence of the improvements in the reproducing apparatus for which, together with the improvements in the details of the recorder, Berliner applied for the patent in suit. *As hereinafter shown the reproducing apparatus shown as a whole in Fig. 3 and its method of operation were unquestionably the invention of Werner Suess, and Berliner so stated, when as Suess' assignee he applied for and obtained Canadian patent therefor No. 41901, issued Feb. 11, 1893, applied for May 5, 1891.* JudgeTownsend, moreover, so found, for he states in his opinion that the Suess-Berliner Canadian patent "*discloses and broadly claims the invention covered by the claims here in suit.*"

From the foregoing analysis and consideration of the patent in suit, it appears, without question, that the *improvements* described and claimed relate, *first*, to the recording of sound, and, *second*, to the reproducing of sound. It is impossible seriously to contend that the essence of the improvements consists rather in the *reproduction* of sound than in the *recording* of sound. It is just as essential, in the practice of Berliner's improve-

ments to record the sound as it is to reproduce the sound after the sound has been recorded; indeed, it might with more reason be contended that the recording of sound, according to the *improvements* described and claimed in the patent, is the more essential, since, as is self-evident, a reproduction of sound can be had only after the sound has been recorded. Upon what theory, then, did the Circuit Court hold that the reproduction of sound by the method and apparatus of claims 5 and 35 was a more important or the principal part of the improvements of the patent? It would be as reasonable to hold that of the two factors, 5 and 2, of 10, 2 is the more important, as to hold that of the improvements of the patent the reproducing of sound is more important than the recording of sound. Each factor of 10 is essential and equally important in the process of multiplication whereby the product, 10, is obtained, for without either factor the product cannot be obtained; so in practising the improvements of the patent the recording of sound and the reproducing of sound are alike essential and important. Reproduction of sound, moreover, had previously been accomplished by Berliner's gramophone, in its original form shown in basic patent No. 372,786. The use of the improved method and apparatus claimed in claims 5 and 35 was intended, therefore, to accomplish merely a *more perfect* reproduction of sound and claims 5 and 35 are, therefore, claims for *improvements only.*

But the Circuit Court, as appears from the opinion, seems to have considered not only that the reproduction of sound is more important than the recording of sound in practising the improvements of the patent in suit, but also that claims 5 and 35 of the patent, which relate to a method of and apparatus for reproducing sound, are more im-

portant than all the numerous other claims of the patent relating to the reproduction of sound, notwithstanding the fact that claims 5 and 35 rest upon and are permeated with the improvements set forth in the other claims for reproduction, and notwithstanding Berliner's express statement that the "details" of improvement in the reproducer together with the "details" of improvement in the recorder constitute principal "*features of improvement.*"

> (*e*). *The expression "principal invention" was used by the Supreme Court in Siemens' Adm'r v. Sellers, 123 U. S. 276, merely to designate one of two inventions, and not as a ground of decision. The Circuit Court erred in refusing to follow the principle of the decision in that case and in holding that the patent in suit has a plurality of terms.*

The expression "principal invention" was used by the Supreme Court to denote a primary or first invention upon which improvements had subsequently been made. This was in the case of *Siemens' Adm'r* v. *Sellers*, 123 U .S. 276, where it was held that a United States patent was limited as to its term by a prior English patent because both patents claimed "*an*" invention, which in that case happened to be the original, primary or principal invention upon which improvements, constituting a further and other invention, had subsequently been made and incorporated into the United States patent. *The expression "principal invention" was used in antithesis to "improvements" upon that invention, merely to refer to and to point out AN invention which was found in both the United States patent and in the prior English patent;* but the relative importance of the primary invention and of the invention consisting

of improvements upon it was not considered or stated by the Supreme Court and in no sense entered into the decision of the case, for the Supreme Court expressly said, that a patent "*cannot be construed as running partly from one date and partly from another. This would be productive of endless confusion.*" In other words the Supreme Court squarely held that if a United States patent expires as to one or more of its claims for *an* invention for which it was granted, it must expire as to all of its claims, no matter what they are or what may be the invention which they cover. A United States patent, therefore, must have a *single* term, which cannot, where the United States patent is "granted for *an* invention" (Rev. St. §4887) previously patented in a foreign country, exceed the shortest term of the terms of the prior foreign patents. But the Circuit Court in the suits at bar, refusing to follow the decision of the Supreme Court to the effect that a patent "cannot be construed as running partly from one date and partly from another" has held that although the patent in suit has expired as to many or most of its thirty-five claims, it, nevertheless, survives as to the two claims, 5 and 35, in suit. *For the first time in the history of the patent law of this country it has been held, contrary to the clear provision of §4887 of the Revised Statutes and to the decision of the Supreme Court in Siemens' Adm'r v. Sellers, supra, that a patent can be construed as having a plurality of terms and as running partly to one date and partly to another and that the endless confusion necessarily resulting therefrom is, in effect, a matter of no consequence.* As will hereinafter be more fully shown, the Circuit Court erred in so holding. At the present time it is intended merely to point out that under §4887 of the Revised Statutes, the relative importance of the

subject matter of various claims of a patent is not controlling; and that it cannot reasonably be held or said of the claims of the patent in suit either that the claims which cover the reproduction of sound are more important than those which cover the recording of sound, or that among the several claims covering the reproduction of sound any tenable ground exists for holding that the two claims in suit, 5 and 35, are more important than the others which cover principal and essential features of improvement of the patent according to the express statement of the patentee. *They are all claims for improvements, stand in the same category, and are subject to the same rule of law, as to expiration under the Statute.*

The Revised Statutes (§4887) provide;—

> "But every *patent* granted for *an* invention which has been previously patented in a foreign country *shall be so limited* as to expire at the same time with the foreign patent."

This provision fixes the *term* of the home *patent*, which shall expire with the expiration of the term of the prior foreign patent.

> *(f). Berliner basic invention is set forth in his basic patent No. 372,786.*

Berliner had made his *basic* invention when, on May 4, 1887, he applied for patent No. 372,786, issued November 8, 1887. *No earlier statement of Berliner's basic invention has so far been produced.* Patent No. 372,786 is for a gramophone and the invention thereof "has reference to a *novel* method of and apparatus for recording and reproducing all kinds of sounds" (p 1, lines 8-10). In this patent Berliner first describes the *ordinary* method of recording spoken words or other sounds for reproduction by means of *vertical* vibrations of the recording stylus, and points out the alleged diffi-

culties and disadvantages thereof (p. 1, lines 14-75). He then states that according to his invention, which he is describing, the recording stylus vibrates *laterally* or parallel with the record surface (p. 1, lines 76-97). He then describes his gramophone machine, his record surface and the manner of recording sound by means of the lateral vibrations of the recording stylus (p. 1, line 96 to p. 2, line 97). He says, (p. 2, line 80);—

> "Under the impact of the sound-waves the diaphragm is set into vibrations, whereby the free end of the stylus is also caused to vibrate to the right and left of its normal position, removing at the same time an undulating line *y*, of lampblack from the record surface, as indicated, greatly exaggerated, in Fig. 5."

Berliner then describes how the phonautographic record thus obtained *is copied* for the reproduction of the sound "in *solid resisting material*, preferably metal, either by the purely mechanical process of engraving, or by *chemical deposition*, or by photo-engraving. * * * The copy thus obtained, which may be multiplied to any desired extent, is a grooved wave-line upon a strip or sheet of copper or other metal, as shown in Figs. 1, 4, 6, and 7, and for the reproduction of the recorded sounds it has the advantage over the ordinary records in tin-foil, wax, &c., that it is not sensibly attacked by the reproducing-stylus, and will stand an indefinite number of reproductions *without the slightest variation in the accuracy and loudness of the reproducing sounds*" (p. 2, line 98 to p. 3, line 21, p. 2, lines 111-130). He then says, with reference to the reproduction of sounds, (p. 3, lines, 10, 22-33);—

> "If, now, the drum is rotated with uniform speed, the end of the stylus will be *forced to follow* the undulations of the groove *y*, and *the*

diaphragm will be vibrated positively in both directions in strict accordance therewith, and will therefore reproduce the exact sounds which originally produced the record. This peculiarity of positive vibratory movement in both directions of the diaphragm is a feature which also *distinguishes my method and my apparatus* from others heretofore used.

"In the phonograph and graphophone the end of the *reproducing* stylus which bears upon the indented or engraved record has a vertical, upward and downward movement. . . . *In my improved apparatus the stylus travels in a groove of even depth and is moved positively in both directions.*"

(*g*). *Method of reproducing sound according to Berliner's basic invention. The method employed by defendants is an improvement thereon.*

A comparison of Berliner's gramophone, shown in Fig. 1 of patent No. 372,786, with Scott's phonautograph of 1857, shown in Fig. 1 of Berliner's lecture before the Franklin Institute (p. 249), shows that Berliner's gramophone in its original form was a modification of Scott's phonautograph, the cylinder of which, bearing the record, was moved forward under the stylus by a feed-screw (p. 249). The use of the feed-screw for such purpose was well known in the prior art. Judge Hazel found that in the Bell & Tainter machine of the prior art (see patents Nos. 341,214 and 341,288):

"An auxiliary joint or feed-screw was necessary, as already stated, to effectuate the required passage of the record over the point of the stylus, *or* to cause the stylus and reproducer diaphragm to travel across the surface of the record" (p. 68, fol. 202).

Such use of the feed-screw is shown also in the

earlier patents to Edison No. 200,521; No. 215,554; No. 227,679; and No. 1644 of 1878 of England; to Hall, No. 219,939; to Reynolds, No. 287,166; and in all the patents of the prior art contained in the records in the suits at bar. The article in the Electrical World for Nov. 12, 1887, (p. 255), prepared by Berliner (p. 230, fol. 690), shows, in Fig. 1, an early form of the gramophone employing a feed-screw for recording *and* reproducing.

Not till the autumn of 1894, Mr. Berliner testifies (p. 240, fol. 719), were talking machines "sold, in which a feed screw for the purpose of propelling the reproducing sound box across the record was dispensed with." He further testifies (p. 241, fol. 723) that an "apparatus in which the record groove both propels and vibrates the reproducing stylus or sound box * * practically means to the exclusion of a feed screw * * ".

The essence of Berliner's basic invention set forth in patent No. 372,786 consisted in copying, in solid resisting material, the phonautographic record of Leon Scott, and then placing such record upon the gramophone, which was a modified phonautograph, and reproducing the sound by and in accordance with the copy of the original record. (See claims 1-3 and p. 1, lines 87-97, of patent No. 372,786). *The idea of "propelling the stylus in the groove across the surface of the record without a feed screw or other mechanism"*, to quote Judge Hazel's words, *was no part of Berliner's basic invention and is nowhere suggested in his earliest patent for his basic invention No. 372,786. Reproduction was had by other well known means.* The discarding of the feed-screw and the permitting of the record groove to propel the stylus across the face of the record, if it was not invented by Edison (see Figs. 31 and 37 and p. 8, lines 48-53, p. 9, lines 11-14, of English patent

1644 of 1878), was a later *improvement* upon the basic invention and an improvement which Berliner, in the Suess-Canadian patent, tells us was made not by him but by Suess. The propelling of the reproducing stylus without a feed-screw in the manner described, Judge Townsend found, was described and claimed by *Berliner*, as the invention *of Suess*, in Canadian patent No. 41,961; but whoever may have invented it, and this is the point, it was an *improvement*, consisting in the discarding of the feed-screw previously employed, in the reproduction of sound.

> (*h*). *No matter what may be the construction given to claims 5 and 35, the two claims, like all the other claims of the patent in suit, are claims for improvements merely.*

In practising the method and in using the apparatus of claims 5 and 35 there are retained and used all the *fundamental features* of the gramophone of Berliner's basic invention patented by him in his first United States patent No. 372,786 and in his early foreign patents hereinafter mentioned; therefore, upon the argument of the prior suit before the Circuit Court of Appeals, it was contended on behalf of complainants that the *novel feature* or improvement residing in the claims and giving them patentability consisted in the propelling of the stylus across the face of the record without any external mechanical appliance, such as a feed-screw, and by means of the pressure exerted upon the stylus by the walls of the rotating record-groove. Concededly, there was no novelty in vibrating the stylus by and in accordance with the record, but, it was argued, there was novelty in discarding the feed-screw so as to permit the walls of the rotating record-groove to propel the stylus across the face

of the record. The difference between propelling, by means of a feed-screw or other like mechanism, the reproducing stylus across the face of the record or the record over the point of the stylus, concededly a method well known in the prior art, and propelling the stylus across the face of the record without such aid, the feed-screw being discarded, was discussed, upon the argument, by the court and counsel. The difference was stated to consist in the discarding of the feed-screw of the early phonograph and graphophone, which feed-screw Berliner used in the early gramophone, and in permitting the pressure of the walls of the rotating record-groove to propel the stylus across the face of the record. Therefore, no matter what may be the construction given to claims 5 and 35, it must remain true that the method and the apparatus of the two claims constitute merely an improvement upon Berliner's original gramophone which embodied his basic invention, consisting in recording sounds by means of lateral undulations of even depth, in non-resisting material, then copying the same for reproduction in solid resisting material, and then reproducing the sounds from such copy, all in the manner and by the apparatus described and shown in his first United States and foreign patents. The two claims, therefore, are, like all the other claims of the patent, claims for improvements.

> (*i*). *In the prior suit, the Circuit Court of Appeals and the Circuit Court, not having Berliner's basic patent No. 372,786 before them, assumed, the point not being important there as it is here, that patent No. 564,586 was Berliner's basic patent.*

The Circuit Court of Appeals, concurring in the opinion which Judge Hazel wrote, except as to

the question of prior public use, held, on that question, that the defense of prior public use interposed by the American Graphophone Company was not valid because, (1) although the patent in suit was not applied for until March 30, 1892, the specifications of Berliner's application for patent No. 564,586, applied for November 7, 1887, were full enough to warrant the making of the claims in controversy (5 and 35); (2) the application for the patent in suit might fairly be considered a continuation of the application filed November 7, 1887, for patent No. 564,586; and (3) Berliner's application thus antedated the public use in question. It is clear from Judge Hazel's opinion, that Judge Hazel, not having Berliner's basic patent No. 372,786 before him, assumed, the point not being important there as it is here, that Berliner's patent No. 564,586, applied for November 7, 1887, was the basic patent, for in the course of his opinion he said (pp. 66-67, fols. 198-200);—

> "In the patent to Emile Berliner, No. 564,586, issued on July 28, 1896, application filed November 7, 1887, the process of recording and reproducing sound vibrations differs essentially from the method used in the phonograph and the graphophone. The specification described a process by which the sounds were inscribed upon a layer of non-resisting material; which was afterwards copied in a non-yielding material, from which the sounds were reproduced. The specification says:
>
> > 'The original record, as well as the copy of the same, is thus obtained as *an undulatory line of even depth*, as distinguished from the line of varying depth obtained by the ordinary phonograph and graphophone.'
>
> "It is not disputed that such mode or process was a *new* and meritorious invention and that

> it was not merely a patent for the functional effect of the machine in connection with which it was used. The earlier specification does not claim the method nor the details of construction of the claims in controversy; hence it is contended by the defendant, as will presently appear, that there was a surrender or waiver thereof. In the patent in suit two features of the invention are mentioned, one concerning the process or mode of recording sound upon a record, the other as to the construction of the apparatus."

But the process by which the sounds were inscribed upon a layer of non-resisting material in an undulatory line of even depth and afterwards copied in a non-yielding or solid resisting material and reproduced was the process described and claimed in the original basic patent No. 372,786 of Nov. 8, 1887, which expired November 8, 1904.

> *(j). Berliner's prior foreign patents further prove that claims 5 and 35, like all the other claims of the patent in suit, cover only improvements upon his basic invention.*

Reference to Berliner's foreign patents, hereinafter more fully considered, *none of which were in evidence in the prior suit*, will make still more clear what was Berliner's basic invention and the order in which Berliner made his basic invention and his improvements thereon.

In England, Berliner obtained two patents, No. 15,232 of Nov. 8, 1887, and No. 7204 of May 15, 1888. The first, No. 15,232 of 1887, covers the subject matter of United States patents No. 372,786 of November 8, 1887, and No. 564,586 of July 28, 1896, applied for November 7, 1887.

Clearly, therefore, as appears from and *as is stated in this English patent* (p. 5, line 4), the invention of United States patent No. 372,786 was Berliner's basic invention and the invention of

United States patent No. 564,586 was an *improvement* thereon. If, as the Circuit Court of Appeals held, the invention of the patent in suit, contained in claims 5 and 35 thereof, was a part of the invention described in patent No. 564,586, it is impossible to hold that the patent in suit is for Berliner's basic invention. In order to carry the date of the invention contained in claims 5 and 35 of the patent in suit back to November 7, 1887, the specification of patent No. 564,586 was and is alone relied upon. But patent No. 372,786 was previously applied for on May 4, 1887, and Berliner himself states in all his subsequent United States and foreign patents that the inventions thereof were *improvements* upon his first patent for his basic invention set forth in No. 372,786.

Berliner's second English patent No. 7204 of May 15, 1888, corresponds to his second United States patent No. 382,790 of May 15, 1888.

Berliner's first French patent No. 186,827 of November 8, 1887, and Berliner's first German patent No. 45048 of November 8, 1887, set forth and claim the subject matter of his first English patent No. 15,232 of November 8, 1887.

Berliner's second French patent No. 190,602 of May 15, 1888, and his second German patent No. 47099 of May 16, 1888, set forth and claim the subject matter of his second English patent No. 7204 of May 15, 1888.

But Berliner's *third* French patent No. 207,090 of July 19, 1890, sets forth and claims the improvements in the *recorder and reproducer* which, as Berliner says in the patent in suit, constitute principal features of invention of the patent in suit. And in like manner Berliner's *third* German patent No. 53,622 of November 20, 1889, sets forth and claims the improvements in the *reproducer* which, as Berliner states in the patent in suit,

constitute principal features of invention of the patent in suit.

It may be well to note that the claims of Berliner's basic United States patent No. 372,786 cover the method of *recording* and *reproducing* spoken words and other sounds in the manner described and by the apparatus shown in the drawings. Berliner's first German, English and French patents, which also cover his basic invention, claim the method of recording and reproducing sounds according to his basic United States patent, and the apparatus shown by identical figures 1-7 in the first United States, German, English and French patents mentioned. For instance, claim 2 (p. 143) of Berliner's first German patent No. 45048 of November 8, 1887, covers the gramophone shown in patent No. 372,786 for recording, and claim 3 of said German patent covers the same gramophone for the reproduction of sound. The drawings of the first German patent No. 45048 are identical with the drawings of the first English patent No. 15,232, (stipulation, T. case, p. 554, fol. 1662; L & C case, p. 540, fol. 1620). Berliner's first French patent No. 186,827 of November 8, 1887 (p. 123) is identical with the first English patent No. 15,232. Claims 9, 10, 11, 12, 13 and 15 of English patent No. 15,232, of November 8, 1887, cover the gramophone and the sound record of United States patent No. 372,786. In addition the said German, French and English patents claim and show in Figs. 8-16, the improvements set forth in United States patent No. 564,586 upon Berliner's basic invention. In English patent No. 15,232 (identical with French patent No. 186,127) at page 3, lines 4-40, etc., it is said that the gramophone shown in Figs. 1-7 is the "*original*" gramophone and that that shown in Figs. 8-16, while retaining all the fundamental features of the original, is an "*improve-*

ment" thereon; and in German patent No. 15048 (p. 137, fol. 409), the gramophone of Figs. 1-7, identical with the gramophone of the same figures in U. S. patent No. 372,786, is said to contain the fundamental principles of the gramophone and that of Figs. 8-16, identical with that of Figs. 1-9 of U. S. patent No. 564,586, is said to be a new form of apparatus containing improvements upon the first.

> (k). *Claims 5 and 35, construed in the light of the new evidence presented in the records of the suits at bar, are limited to improvements, and to improvements in the details of construction of the reproducer. The Circuit Court erred in holding that these claims cover a basic invention.*

In the light of these facts, which were not before the courts in the prior suit, it is clearly incorrect to say, and the Circuit Court erred in holding, that the invention or any part of the invention of the patent in suit was Berliner's basic invention. *The patent in suit is*, as Berliner himself expressly states, *a patent for improvements upon his basic invention*, consisting in improvements in the method of recording and in the details of construction of his apparatus for recording and reproducing sound. *Claims 5 and 35 of the patent in suit must be construed in the light of this new evidence now first presented to the court, and, as will hereinafter be clearly shown, if claims 5 and 35 are to be held to have been valid at all, they must be limited by the improvements in the details of construction of the reproducer.*

> (l). *Defendants do not use the improved reproducer of the patent in suit.*

The improvements in the details of construction of the reproducer have never been used by either of the defendants. This appears from a comparison of

the reproducers of defendants' machines with Figs. 6 and 7 of the patent in suit. They use the reproducer of Suess-Berliner Canadian patent, shown in Fig. 1 of the drawings of that patent, which by stipulation (T. case, p. 555; L. & C. case, p. 541) are the same as the drawings of patent No. 427,279.

(m). Berliner's basic invention and his and Suess' improvements thereon, shown by the patents in evidence, were all patented in foreign countries, before the grant of the patent in suit, by patents which have all expired. Berliner's home patents for his same basic invention and improvements thereon have also expired. The holding of the Circuit Court that claims 5 and 35 can alone still survive is contrary to the plain meaning, and contrary to the equity, of § 4887 of the Revised Statutes.

The patent in suit had expired before either of the suits at bar was begun and before the motions for preliminary injunction were made, by reason of the expiration of several prior foreign patents taken out by Berliner for "an invention," for which the patent in suit was granted. The Berliner-Suess Canadian patent No. 41,901, of February 11, 1893, covered broadly the subject matter of claims 5 and 35 in suit unless those claims are limited by the improvements in the details of construction of the reproducer. This Canadian patent was granted for a term of six years and expired on February 11, 1899, with the expiration of the term for which the patent was granted. Berliner German patent No. 53,622 of November 20, 1889, covered improvements of the patent in suit relating to the reproduction of sound and expired on November 7, 1902. Berliner French patent No. 207,090, of July 19, 1890, covered improvements of the patent in suit for the recording and for the reproduction of sound and expired on July 19, 1905. Berliner English

patent No. 15,232, of November 8, 1887, expired November 8, 1901. Berliner French patent No. 186,827, of November 8, 1887, expired November 8, 1902. Berliner German patent No. 45,048, of November 8, 1887, expired November 8, 1902. These three English, French and German Berliner patents cover the inventions of Berliner's basic United States patent No. 372,786, of November 8, 1887, and of his United States patent No. 564,586, of July 28, 1896, and, therefore, the invention of claims 5 and 35 of the patent in suit, which the Circuit Court of Appeals held, are broad claims for the invention set forth in patent No. 564,586. Berliner's basic United States patent No. 372,786, of November 8, 1887, expired November 8, 1904, with the expiration of the seventeen year term thereof. Berliner's second United States patent No. 382,790, of May 15, 1888, expired May 15, 1905, with the expiration of the seventeen year term thereof. Berliner's foreign patents corresponding to his United States patent No. 382,790, have also expired as follows; No. 7204, of May 15, 1888, of England on May 15, 1902; No. 190,602, of May 15, 1888, of France on May 15, 1905; and No. 47,099, of May 16, 1888, of Germany on November 7, 1902. Berliner's United States patent No. 564,586, of July 28, 1896, expired on November 8, 1901, with the prior English patent for the same invention, No. 15,232, of November 8, 1887. *The result is that Berliner's inventions for the recording and reproducing of sound by means of the gramophone, including his basic invention and improvements thereon, have become free to the public in the United States and foreign countries.* Not one of the patents mentioned still survives. Under such circumstances the holding of the Circuit Court in the suits at bar that claims 5 and 35 of the patent in suit still survive is contrary, not only to the express provisions of §4887 of the Revised Statutes, but also to the equity and manifest intention of the

Statute. It is also contrary to the decision of the Supreme Court in *Siemens' Adm'r v. Sellers, supra*, that a patent "cannot be construed as running partly form one date and partly from another. This would be productive of endless confusion." It is contrary to the decision of Judge Severens in *Western Electric Co. v. Citizens' Tel. Co.*, 106 Fed. 215, 219, that a "patent cannot expire in parcels", and of Judge Brown in *Sawyer, Spindle Co v. Carpenter*, 133 Fed. 238, 240, that a patent cannot "expire in part, and survive in part," following *Siemens, Adm'r* v. *Sellers, supra*. It is a decision which construes claims (5 and 35) for improvements to be claims for the basic invention and then holds that the claims so construed survive the expiration of *all* Berliner's prior foreign patents, not only for his improvements but also for his basic invention. It is the first decision in the history of the patent law of this country to the effect that a United States patent can, under § 4887 of the Revised Statues, have *a plurality of terms for the different claims thereof*. It is a decision which, if upheld, will produce the endless confusion which the Supreme Court has said is a sufficient reason against such an interpretation of § 4887 of the Revised Statutes.

(*n*). *Conclusion of Point One.*

Such, may it please the court, is a general statement of the subject matter of the patent in suit and the facts relevant thereto. The defenses indicated in the course of the foregoing general argument, together with other defenses relied upon by defendants, are dealt with in the following points, wherein the facts and the authorities relied upon are set forth.

POINT TWO.

Berliner patent in suit No. 534,543, of February 19, 1895, was granted for an invention previously patented by Berliner in Germany, by Berliner German patent No. 53,622, of November 20, 1889. The term of the patent in suit, therefore, expired with the expiration of the term of the prior German patent on Nov. 7, 1902, before either of these suits was begun. Section 4887 of the Revised Statutes considered and the authorities collated.

(a). German patent No. 53,622 is new evidence. Defendants' affidavits show that it was granted for an invention for which the patent in suit was granted.

German patent No. 53,622, of Nov. 20, 1889, to Berliner, was not set up in the answer or offered in evidence in the prior suit. It is new matter absolutely. A certified copy of the patent forms part of defendants' exhibits (stipulation, T. case, p. 556; L. & C. case, p. 542). A copy of the drawings and a translation of the specification of the patent are to be found in the record (pp. 150-154).

That the invention described and covered by the German patent is an invention described and covered by the patent in suit and for which the patent in suit was granted, is shown by defendants' affidavits (Aff. Hicks, pp. 82-86, fols. 245-256; aff. Ensign, pp. 99-101, fols. 297-303; aff. Lessls, pp. 116-118, fols. 348-352.)

(b). German patent No. 53,622, being a patent for an improvement, expired on Nov.

7, 1902, according to the German law, with the patent for the invention upon which the improvement was made.

A copy of the material parts of the German Patent Law is included in defendants' exhibits (p. 179).

According to the German law, the duration of a patent is fifteen years, but if an invention is an improvement upon another invention patented in favor of the applicant, a patent of addition only can be obtained, which terminates with the patent for the original invention (p. 179, fols. 537-538). It appears upon the face of German patent No. 53622, that it is a second patent of addition to patent No. 45,048, of November 8, 1887, which patent No. 45,048 also forms one of defendants' exhibits together with a translation thereof (p. 132). Patent No. 53,622, therefore, expired November 7, 1902 with patent No. 45,048, and that the term of the patent No. 53622 was limited to expire on November 7, 1902, is stated on the face of the patent. The certificate of the German Patent Office also states that patent No. 53622 has been cancelled in the rolls (p. 151, fol. 451.)

(*c*). *The description and claims of the patent in suit for the invention previously patented by the German patent.*

What then is the invention described and claimed in German patent No. 53,622 and also in the patent in suit No. 534,543? A comparison of figures 6 and 7 of the patent in suit with figures 1 and 2 of the German patent shows that the reproducer illustrated in the patent in suit is identical with the reproducer illustrated in the German patent. As stated under Point One the reproducer of the patent in suit illustrated in figures 6 and 7 thereof is described at page 5, lines 34-102. The reproducer

consists of a diaphragm and stylus. The diaphragm 92 is mounted in a casing 91. A leaf spring 101 carries the stylus 112. The leaf spring is bent or twisted at right angles at 102, so that the face of one part of the leaf spring is perpendicular to the face of the other part of the leaf spring. The leaf spring faces with its flat side the face of the diaphragm up to a point beyond the center of the diaphragm, and is secured at one end to the diaphragm casing. The other end of the leaf spring crosses the diaphragm casing at a point opposite to the point at which the flat end is fixed, and is, as above stated, perpendicular to the face of the flat part of the leaf spring which is fixed to the diaphragm casing. As stated in the patent in suit (p. 5, lines 53-54), "the spring is therefore elastic in two directions at right angles to each other." At the point where the leaf spring passes over the center of the diaphragm, it is by means of a screw pin 106, connected with the center of the diaphragm, and nuts are provided whereby the *tension* between the diaphragm and the leaf spring can be regulated (p. 5, lines 61-71). The end of the leaf spring which crosses the diaphragm casing is not secured thereto, but is free to vibrate and it is called the free end, 103, of the spring. To the free end of the spring a binding post, 111 is secured in which the reproducing stylus, 112 having a wedge-shaped point is held by a set screw 113 (p. 5, lines 72-76.) In order to reduce the volume of the emitted sound or to render it more clear, one or more perforated diaphragms 114, may be placed in the neck 90 leading from the diaphragm casing (p. 5, lines 90-102.) In order to dampen the individual vibrations of the leaf spring, soft rubber cushions, 104, may be placed upon the leaf spring (p. 5, lines 60-61). The tendency of the leaf spring 101 is to press toward the

diaphragm and the edge of the part 103 which crosses the diaphragm casing bears against the diaphragm casing 99 and also against the block 100 (p. 5, lines 47-54.) Such are the features of the reproducer of the patent in suit and these features are covered specifically in claims 24-34. The features of the reproducer are also covered by claims 5 and 35 which are limited by, and depend for their novelty upon, a stylus "vibrating" and "free to be vibrated," *substantially as described*, and having a "*wedge-shaped point*" that is a point so "*shaped for engagement with said record.*" Since a recording stylus may also be reproducing stylus, claim 31 can be read upon the reproducer shown in figures 6 and 7. Claims 24-34 summarize the specific points of the reproducer and are as follows:

> "24. In a gramophone a sound reproducing diaphragm in combination with a stylus lever extending diametrically across the same, and elastic in two directions at right angles to each other, substantially as described.
>
> 25. In a gramophone, the combination of a diaphragm and a stylus carrier composed of a leaf spring twisted at one point so as to bring the edge of the one portion at right angles to the face of the other portion, whereby it is elastic in two directions, substantially as described.
>
> 26. In a gramophone the combination of a reproducing diaphragm and stylus; with a stylus carrier composed of a leaf spring extending flatwise over the face of the diaphragm and edgewise over the edge of the diaphragm, substantially as described.
>
> 27. In a gramophone the combination of a reproducing diaphragm mounted in a suitable frame the latter being provided at one point with a boss or stop; with a double elastic stylus carrier composed of a twisted leaf spring tend-

ing toward the diaphragm and against the boss or stop, substantially as described.

28. In a gramophone, a reproducing diaphragm and stylus in combination with an elastic stylus carrier extending over the face of the diaphragm and tending toward the same, of an adjustable connection between the diaphragm and stylus carrier and adjustable for varying the pressure between diaphragm and style carrier, substantially as described.

29. In a gramophone the combination of a reproducing diaphragm mounted in a suitable frame provided with a boss or stop; with a double elastic stylus carrier tending toward the diaphragm and toward the stop and elastic non-resonant dampers interposed between the style carrier and the frame and stop, substantially as described.

30. In a gramophone a sound reproducing diaphragm and a sound conveying tube for the same, with one or more non-resonant perforated diaphragms in the said tube for reducing the volume of sound conveyed to the ear, substantially as described.

31. In a gramophone a recording stylus pivoted to move in response to the vibrations of a diaphragm and elastic in a plane at right angles to such motions, substantially as described.

32. In a gramophone, a reproducing stylus having a wedge-shaped point engaging the walls of the record groove, substantially as described.

33. In a gramophone reproducer, a stylus carried or formed by a spring fixed at one end to the diaphragm holder and freely extending across and beyond the same and operatively connected with the center of the diaphragm, substantially as described.

34. In a gramophone reproducer, a spring constituting or carrying a stylus, fixed at one end to the diaphragm holder and extending

> across and beyond the periphery of the same and freely pressing against the diaphragm, substantially as described."

Claims 5 and 35 read as follows:

> "5. The method of reproducing sounds from a record of the same which consists in *vibrating* a stylus and propelling the same along the record by and in accordance with the said record, *substantially as described.*
>
> 35. In a sound reproducing apparatus consisting of a traveling tablet having a sound record formed thereon and a reproducing *stylus shaped for engagement with said record* and *free to be vibrated* and propelled by the same, *substantially as described.*"

Obviously, a reproducer consisting of a diaphragm and stylus mounted thereon in the manner described has for its object the lateral vibrations of the stylus carried by the free end of the leaf spring. Judge Hazel held this to be of the essence of the invention.

Judge Hazel said, (p. 67);—

> "Complainants contend, and the proofs show, that the stylus attached to the diaphragm is arranged so as to permit the same to vibrate laterally and that owing to lateral undulations in the walls of the record groove, a desirable swaying motion is imparted to the reproducer diaphragm."

Indeed, a stylus carried by a leaf spring so constructed and so mounted could vibrate in no other manner than laterally, and, as the specification states (p. 5, lines 27-29), the stylus and diaphragm vibrate "in accordance with the undulations of the record groove," which undulations are lateral and not vertical. The "*vibrating*" stylus of claim 5, and the reproducing stylus "*free to be vibrated*" of claim 35, each "*substantially*

as described" is, of course, the stylus mounted upon the leaf spring of the reproducer claimed specificially in claims 24-34. Furthermore the "*stylus shaped for engagement with said record*" of claim 35, is the "*reproducing stylus having a wedge-shaped point engaging the walls of the record groove*" of claim 32.

(*d*). *The description and claim of the prior German patent for an invention for which the patent in suit was granted. Judge Townsend found that the invention described and claimed in the German patent is described and claimed in the patent in suit.*

Referring now to the specification and drawings of German patent No. 53,622, there is the same diaphragm casing *cc'* which holds between its parts the same diaphragm *b*. There is the same leaf spring *aa'*, consisting of two parts, one the flat part fastened to the diaphragm casing at *g*, and the other twisted so that its face is perpendicular to the face of the flat part and it is free to vibrate. The free end of the leaf spring carries the stylus *k*, *having a wedge-shaped point, shaped for engagement with the record*. The stylus *k* is secured to the leaf spring in the same manner by means of a block *h*, made fast to the leaf spring, and a set screw *i*. Just as in the United States patent, the leaf spring is connected with the diaphragm by means of a pin *m*, and nuts and screws, *n*, *f* and *e*, serve to regulate the *tension* between the leaf spring and the diaphragm, just as the *tension* between the leaf spring and the diaphragm is regulated in the United States patent. In order to obtain a dampening of the leaf spring, the free end of the leaf spring is surrounded by a ring of rubber, *s*, just as in the United States patent. The tube *d* leads from the diaphragm

casing but is cut off so that the perforated tube, shown in the corresponding French patent next to be considered and in the United States patent, does not appear. Without question, the invention shown in the German patent is shown in the United States patent, and *that invention is covered by both patents.* Within the language and meaning of § 4887 of the Revised Statutes the United States patent was "*granted for an invention which has been previously patented*" in Germany and "shall be so limited as to expire at the same time with the foreign patent." The claim of the German patent reads as follows (p. 153);—

> "The replacing of the two armed lever (*s*) protected by claim 2b of the chief patent No. 45048, and of the recording stylus (29) protected by claim 4b of the same, by a spring (*aa'*) carrying the stylus for the reproduction of the sound, which with the one end is made fast to the casing (*cc'*) enclosing the diaphragm, while the other end of the same can vibrate freely, so that the vibrations communicated to the latter are carried over by means of the pin (*m*) connecting the spring and the diaphragm at right angles to the surface of the diaphragm."

The two-armed lever (*s*) protected by claim 2b of the chief patent No. 45048, and the recording stylus 29 protected by claim 4b of the same are shown in figures 2 and 9 of German patent No. 45048 and are identical with the two-armed lever (*s*) of Berliner's U. S. Patent No. 372,786, shown in figure 2 thereof, and with the recording stylus 29, shown in Figs. 1 and 2 of Berliner's U. S. patent No. 564,586, which figures 1 and 2 of U. S. patent No. 564,586 are identical with figures 8 and 9 of German patent No. 45048. The drawings of German patent No. 45048 and of French patent 186,827 are identical with the drawings of English

patent 15,232 of 1887, and by stipulation (T. case, p. 554; L. & C. case, p. 540) have not been reproduced. It thus clearly appears that in Germany, as in the United States, the improvements which Berliner describes in the construction of the details of his recorder and reproducer of the gramophone were improvements upon the gramophone set forth in his early German patents as well as in his early United States patents. It should be understood that in Germany and in France Berliner took out three patents in each country; and that in England Berliner took out two patents; that the first German, French and English patents covered the subject matter of United States patents Nos. 372,786 and 564,586; that the second German, French and English patents covered the subject matter of United States patent No. 382,790; and that the *third* German and French patents covered subject matter of the patent in suit No. 534,543.

[As will hereinafter be shown, under Point Four, if the patent in suit, as the Circuit Court of Appeals held, contains broad claims (5 and 35) for the invention described and claimed in No. 564,586, the patent in suit covers the second invention of the first German, French and English patents, and expired therewith.]

Judge Townsend found (T. case, p. 336; L. & C. case, p. 320);—

> "The drawings of the German patent are substantially identical with Figures 6 and 7 of the patent in suit and the specifications describe and the claims cover these constructions."

(c). *Futile effort of complainants' counsel in the Circuit Court to find some slight difference between the description and drawings of German patent No. 53,622 and French patent No. 207,090 and the description and drawings of the patent in suit.*

Complainants' counsel in the Court below, realizing the strength of the defences set forth under this and the following point of this brief, laboriously endeavored to find some slight distinction between the description and drawings of Berliner's third German and French patents (see Point Three for French patent) and the description and drawings of the patent in suit. Complainants' counsel admitted that the imaginary differences in operation claimed by him are nowhere stated to exist in the patent in suit. It is unnecessary to deal with these hair-breadth distinctions which complainants' counsel endeavored to draw. Concededly and obviously the numerous claims of the patent in suit would be infringed by the reproducers and recorder described and patented in the prior German and French patents. Hence the patent in suit was granted for an invention previously patented in the German and French patents, according to all the authorities, and whether there are differences or not is immaterial, as Judge Severens expressly stated in *Western Electric Co.* v. *Citizens' Tel. Co.*, 106 Fed. 215,219, where he "conceded that there are differences in some details between the foreign and the home patents upon which independent claims might be based." But he added;—

> "If the home patent CANNOT EXPIRE IN PARCELS, and the Italian patent, for instance, covered the matter of the first claim of the patent in suit, it necessarily follows that the home patent expired with the Italian patent three years after the issue of the latter, and from this it necessarily results that the complainant must fail, and that the bill should be dismissed."

In the German and French patents as well as in the United States patent there is a positive con-

nection between the spring and the diaphragm. Claim 28 of the patent in suit shows that "an adjustable *connection between the diaphragm and stylus carrier* and *adjustable* for varying the *pressure* between diaphragm and style carrier" were particularly pointed out as elements of the reproducing diaphragm and stylus. Claim 33 also covers the connection between spring and diaphragm. The same, of course, is true of the recorder of the patent in suit. Various parts of the specification might be referred to, but it seems unnecessary. As above shown constant *tension* exists between the spring and diaphragm in the United States and German patents, and means are shown in each patent for regulating the tension. The same is true of the French patent. Whatever vibrations the diaphragm does have, in reproducing the record, are due to the positive pressure of the stylus in one direction and the removal or reduction of the pressure of the stylus in the other direction, in which latter case the tension of the diaphragm comes into play to straighten the diaphragm and thus produce a vibration, as it were, toward the stylus. This clearly is the mode of operation in all the patents, notwithstanding any possible differences in the use or placing of a particular nut or screw.

Complainants' counsel did not intimate, even in the vaguest manner, and could not truthfully say that the imaginary differences, which he claimed to exist and upon which he argued, affect in the slightest degree the proposition that the numerous claims of the patent in suit, referred to under Points Two and Three of this brief, would be infringed by the structures described and patented in the prior German and French patents.

Of course, the acoustic springs of the French and

German patents, as well as of the patent in suit, have a tendency to press toward the diaphragm. The figures of the patents all show this. The French patent claims it (claim 7, p. 129). The description of the French patent expressly states that the extremity of the acoustic spring presses against the casing of the sound-box (p. 127, fol. 381) and claim 34 of the patent in suit would be infringed by this. The perforated diaphragm 111 in the tube 90 of the patent in suit (Fig. 7) is the perforated diaphragm D of Fig. 3 of the French patent. Hence claim 30 of the patent in suit would be infringed by the reproducer of the French patent, but it is useless to pursue this question further. That numerous claims of the patent in suit would be infringed by the reproducers and recorder of the German and French patents is pointed out fully elsewhere in this and the following point.

> *(f). The provision of §4887 of the Revised Statutes, fixing the single term of a home "patent granted for an invention" previously patented in a foreign country, is clear and unambiguous and must control the decision in these suits without change by judicial action "based upon same supposed policy of Congress." The Circuit Court erred in refusing to follow the unambiguous provision of the Statute, and in holding, contrary to the Statute and the decision of the Supreme Court, that a patent can have a plurality of terms and can expire in parcels.*

The point now under consideration is that the invention described and covered by prior German patent No. 53,622 is an invention covered by the patent in suit No. 534,543 and for which the patent in suit was granted. What then is the law applicable to this state of facts?

At the time the patent in suit was issued, February 19, 1895, section 4887 of the Revised Statutes was in force and read as follows:

> "Sec. 4887. No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country, unless the same has been introduced into public use in the United States for more than two years prior to the application. But *every patent* granted for *an* invention which has been previously patented in a foreign country *shall be so limited* as to expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years."

The German patent was previously patented (*Bate Refrig. Co.* v. *Sulzburger*, 157 U. S. 1).

The following provision of the Statute fixes the *term* of the United States patent:

> "But *every patent* granted for *an* invention which has been previously patented in a foreign country *shall be so limited* as to expire at the same time with the foreign patent."

The *test* is whether the United States *patent* has been granted for "*an*" invention which has been previously patented in a foreign country. Clearly there is no ambiguity in these words of the Statute. It is the *patent*, and not the separate claims thereof, which shall be so limited to expire. If there is *an* invention described and claimed in the United States patent, then it is clear that the United States *patent* was granted for *that* invention; and, if *that* invention was previously patented in a foreign country the *term* of the United States *patent*

> "must be so limited as to expire at the same time with the foreign patent, or, if there be

more than one, at the same time with the one having the shortest *term*."

The *definition* and *designation*, contained in the statute, of the *invention* which must appear in the United States patent and in the prior foreign patent, in order that the former shall be limited to expire with the latter, is an invention "*which has been previously patented in a foreign country.*" This is the sole and exclusive definition and designation. The court cannot change the definition and designation. The test, therefore, is solely, whether the United States patent claims the "invention which has been previously patented in a foreign country." If so, the statute applies and the United States *patent* expires with the foreign patent.

This provision of the Statute fixes the *term* of the United States *patent* as a whole. To fix the *term* of the *patent* is the sole purpose of the provision (*Sawyer Spindle Co.* v. *Carpenter*, 143 Fed. 976,979. It does not assign to the several claims of the patent different terms. It assigns to the patent as a whole a *single term* and the *patent* or *the* term of the patent must be so limited as to expire at the same time with the foreign patent. The Statute applies *whenever* a United States patent is granted for an invention which has been previously patented in a foreign country. When the Statute once applies, the *term* of the United States patent is limited by the *term* of the prior foreign patent and must expire therewith. No exception is made in favor of a United States patent which may contain additional claims which would not be supported by the specification of the foreign patent. No matter what else the United States patent may contain, if it *does* contain, and if it *is* granted for, *an* invention previously patented in a foreign country, the *term* of the United States patent *as a whole* must expire with the *term*, and the *shortest term*, of the prior

foreign patents. The single term of the prior foreign patent measures the single term of the home patent. This clearly is what the Supreme Court held in *Siemens' Adm'r. v. Sellers*, 123 U. S. 276, when it said that a patent "*cannot be construed as running partly from one date and partly from another. This would be productive of endless confusion*"; and this clearly is the plain provision of the Statute. Under such circumstances, the question whether one claim of a patent embodies a basic invention or is more important than another claim of the same patent need not be determined since the answer to such a question, if, *indeed, it can be answered*, is *not the test prescribed by the Statute*. Such a test would involve the greatest doubt, *confusion* and uncertainty. There is no provision in the statute limiting the *extent* of the expiration of a patent granted for an invention previously patented in a foreign country. There is no provision in the Statute giving to a patent "*granted for an invention which has been previously patented in a foreign country*" one term for claims covering *that* invention and another term for other claims which may be contained in the patent. *According to the Statute*, the United States *patent* is to have a *single* term if it is granted for *an* invention previously patented in a foreign country, no matter what else the United States patent may be granted for. The rule of the Statute is clear and positive. No exception is stated. The rule applies to "*every* patent." When therefore, the Circuit Court in the suits at bar held that claims 5 and 35 of the patent in suit could survive the expiration of prior foreign patents granted, concededly, for *an* invention for which the United States patent in suit was granted, the Circuit Court clearly erred on the question of law, and further erred in holding that claims 5 and 35 cov-

ered Berliner's *basic* invention. As above shown, under Point One, claims 5 and 35, like all the other claims of the patent, are claims for *improvements*, stand in the same category with all the other claims as being for improvements upon the basic invention set forth in patent No. 372,786, must, in fact be limited by the details of improvement in the reproducer if they ever had any validity, and are subject to the same rule of law as to expiration with prior foreign patents. But even if claims 5 and 35 do cover Berliner's basic invention, the numerous other claims of the patent in suit, as above and hereinafter shown, cover *an* invention previously patented in foreign countries; therefore, the *term* of the *patent* in suit was limited by §4887 of the Revised Statutes to expire with the expiration of the shortest term of the terms of the prior foreign patents, and when the *term* of the patent in suit *expired* claims 5 and 35 could not survive, no matter how important or how basic may have been the subject matter thereof. Suppose several prior foreign patents granted in the same country for different features of the invention covered by the home patent. In such case, the home patent must expire "*with the one having the shortest term.*" The Patent Office so held even before the decision in *Siemens' Adm'r v. Sellers* (*ex parte Unsworth*, 15 O. G. 882).

In *Bate Refrig. Co.* v. *Sulzberger*, 157 U. S., 1, 36, the Supreme Court, referring to the language of §4887 of the Revised Statutes, said, as summarized in 4 Fed. Rep. Digest 9048;—

> "Where the language of a statute is *plain* and *unambiguous*, it is the *duty* of the court to enforce it according to the *obvious meaning* of the words, *without attempting to change it* by adopting a different construction, based upon some *supposed policy* of congress in regard to the subject of legislation, or upon considerations of *injustice* or *inconvenience* arising from the enforcement of the statute according to its terms."

There can, however, be no injustice in enforcing the Statute in cases such as the suits at bar. Assuming, contrary to the fact, that claims 5 and 35 are separable from the other claims of the patent in suit, then Berliner *voluntarily* included them in the patent with other claims for inventions which to his knowledge he had previously patented in foreign countries. He, therefore, *voluntarily* subjected the claims in suit to the operation of the Statute and no strained or forced interpretation or construction of the Statute should be resorted to in order to protect him against his voluntary act.

In support of its holding that where the language of a statute is plain and unambiguous, "a refusal to recognize its natural, obvious meaning would be justly regarded as indicating a purpose to change the law by judicial action based upon some supposed policy of Congress", the Supreme Court in *Bate Refrig. Co.* v. *Sulzberger*, cited and quoted at p. 37 (157 U. S.), its prior decisions in the two following cases;—

Hadden v. *Collector*, 5 Wall, 107, 111, where the court said;—

> "What is termed the policy of the government with reference to any particular legislation is generally *a very uncertain thing*, upon which all sorts of opinions, each variant from the other, may be formed by different persons. It is a ground much too unstable upon which to rest the judgment of the court in the interpretation of statutes."

Scott v. *Reid*, 10 Pet., 524, 527, where the court said;—

> "Where the language of the act is explicit, there is great danger in *departing from the words used*, to give an effect to the law which may be *supposed* to have been designed by the legislature. *It is not for the court* to say, where the language of the statute is clear, that it shall be so construed as to embrace cases because no good reason can be assigned why they were excluded from its provisions."

By what authority, then, did Judge Townsend read into the statute the exception that it "does not apply to cases where the foreign patents which have expired do not cover the *broad* claims for the *basic* invention?" There is contained in the statute no such exception to the clear and imperative rule that the United States patent shall expire with a prior foreign patent if the invention protected by the prior foreign patent is "*an* invention" for which the United States patent was granted.

The proper rule for the interpretation of a statute, such as the Canadian Patent Act, hereinafter referred to under Point Nine, was stated, in perfect agreement with the rule stated by the Supreme Court in *Bate Refrig. Co.* v. *Sulzberger*, *supra*, by the House of Lords in England in *Dominion Cotton Mills Co.* v. *General Engineering Co.*, L. R. App. Cas. (1902), p. 570. In that case it was said (p. 573);—

> "The whole question, therefore, turns on the meaning and legal effect of the words 'under any circumstances, *if a foreign patent exists*, the Canadian patent shall expire at the earliest date on which any foreign patent for the same invention expires.'"

The Canadian Exchequer Court held, in the first instance, that the words "if a foreign patent exists" referred to the date of the *grant* of the Canadian patent. The Canadian Supreme Court reversed the Exchequer Court and held that the words referred to the date of the *application* for the patent. Thus both the Exchequer Court and the Supreme Court attempted, by judicial legislation, to read into the statute something which was not there. The House of Lords held that the words meant *just what they said* and that according to the statute a Canadian patent must expire with a foreign patent existing *at any time* during the continuance of the Canadian patent. The House of Lords said (p. 573);—

"The language is *clear* and *imperative*. Their Lordships can only understand it as declaring that under all circumstances as soon as any foreign patent for the same invention expires the Canadian patent, if then existing, shall expire also; they can *find* no limit as to time except that the foreign patent must both exist and expire after the Canadian patent has been granted and before it has ceased from any other cause."

(g). *The principle of the decisions of the Supreme Court in Siemens' Adm'r. v. Sellers, 123 U. S. 276, and of the lower Courts following that decision, is that "a patent cannot expire in parcels," "cannot be construed as running partly from one date and partly from another. This would be productive of endless confusion." Such principle is derived from, and is the only principle which can be derived from, the provision of §4887 of the Revised Statutes fixing the term of the patent.*

In the leading case of *Siemens' Adm'r. v. Sellers*, 123 U. S. 276, the question was whether a United States patent which had four claims had expired with a prior English patent which had only one claim. It was argued on behalf of the appellants as follows (123 U. S. 280):—

"II. But if it be admitted that this claim is anticipated by the English patent of 1861, this would not invalidate the first three claims of the patent."

In answer to this argument the Supreme Court said;—

"It is contended by the counsel of the complainants, that the American patent contains improvements which are not exhibited in the English patent. But if this were so, it would not help the complainants. The principal invention is in both; and if the American patent contains improvements, this fact cannot save the patent from the operation of the law which is invoked, *if it is subject to that law at all.*

> A patent cannot be exempted from the operation of the law by adding some new improvements to the invention; *and cannot be construed as running partly from one date and partly from another. This would be productive of endless confusion.*"

The Supreme Court held that the United States patent was limited by the prior English patent. The *principle* of the decision in *Siemens' Adm'r.* v. *Sellers, set forth in the words above italicized,* has been followed without exception in all reported cases, except the suits at bar. The decision was made in 1887. As the claims of the home patent, for features not contained in the foreign patent, were held to have expired with the foreign patent, the law became settled, that *the home patent could not be kept alive as to such features by disclaiming the features of the expired foreign patent.*

The decision in *Siemens' Adm'r.* v. *Sellers* establishes that a patent *cannot* be construed as running partly from one date and partly from another, the *reason* being that *this would be productive of endless confusion.* Hence, the *principle* may be broadly stated, that where a United States patent covers an invention which has been previously patented abroad, the term of the United States patent will expire with the term of the foreign patent, although the United States patent may cover improvements or other matter not described or covered by the prior foreign patent. Clearly, therefore, the patent in suit expired on November 7, 1902, with German patent No. 53,622, before the suit against the Talk-O-Phone Company or the suit against the Leeds & Catlin Company was begun. The suit against the Leeds & Catlin Company was brought in July, 1904, and the suit against the Talk-O-Phone Company was brought in September, 1904, (Aff. Hicks, p. 76, fol. 228).

As above shown under Point One, Subdivision (*c*) (p. 21), the expression "principal inven-

tion" was used in antithesis to "improvements" upon that invention, merely to refer to and to point out *an* invention, which was found in both the home patent and the prior foreign patent; but the relative importance of the principal, first or primary invention and of the invention consisting of improvements upon it was not considered or stated by the Supreme Court and *in no sense entered into the decision of the case*, which proceeded *solely* upon the *principle* embodied in the *Statute* that the *term* of the home patent must expire with the term of the prior foreign patent, that the home patent cannot have a plurality of terms and *cannot be construed as running partly from one date and partly from another.*" The decision would have been the same, under the *principle* stated as the *ground of the decision*, had the invention found in both the home and prior foreign patents been the improvements upon the principal invention; for whether the prior foreign patent contains only the improvements or only the principal invention found in the home patent the Statute must apply, since, in either case, the home patent is "granted for *an* invention which has been previously patented in a foreign country" and "*every*" such "*patent*" must expire, that is its *term* must expire, with the expiration of the term of the prior foreign patent. This is why the lower Courts, including the Circuit Court of Appeals for the Second Circuit in *Electrical Accumulator Co. v. Brush Electric Co.*, 52 Fed. 130, 139, cited, *infra*, p. 63, following the *principle* of the decision of *Siemens' Adm'r. v. Sellers*, have without exception and repeatedly, as will hereinafter appear, directed their inquiry to ascertain whether *any one* invention claimed in the home patent is contained in the prior foreign patent, and have repeatedly stated that "*a patent cannot expire in parcels*," "*cannot expire in part and survive in part.*"

(*h*). *Broadening or narrowing of the claims of an American patent will not prevent the operation of the Statute.*

In *Federal Statutes Annotated*, Vol. 5, p. 470 (published by Edward Thompson Co., 1905), the law settled by the decision of *Siemens' Adm'r* v. *Sellers* and other cases following that decision, is stated as follows;—

> "*The addition of new improvements* not contained in the foreign patent, or the *broadening or narrowing* of the claims of an American patent, will not prevent the operation of the statute, as *a patent cannot be construed as running partly from one date and partly from another. Siemens' Adm'r* v. *Sellers* (1887) 123 U. S., 276; *Clark* v. *Wilson* (1886) 28 Fed. 95; *Holmes Electric Protective Co.* v. *Metropolitan Burglar Alarm Co.* (1887) 33 Fed. Rep. 254; *Accumulator Co.* v. *Julien Electric Co.* (1893) 57 Fed. Rep. 605; *Brush Electric Co.* v. *Electrical Accumulator Co.* (1891) 47 Fed. Rep. 48."

Hence, the question is whether an invention covered by the prior foreign patent is also covered by the United States patent. If so, the United States patent was granted for that invention and expires with the prior foreign patent under section 4887 of the Revised Statutes. Broadening and narrowing of claims is immaterial. If an invention is described and protected by the prior foreign patent and is also described and protected by the United States patent, the United States patent must expire with the foreign patent irrespective of all other considerations. The decided cases leave no doubt upon this proposition.

(*i*). *The test of the question, whether an American "patent is granted for an invention" previously patented in a foreign country, is whether an article made according to the de-*

scription of the invention of the foreign patent would infringe the American patent, that is any claim of the American patent.

The case of *Commercial Manufacturing Co.* v. *Fairbank Co.*, 135 U. S. 176, is a leading case setting forth the test for identity of invention. In that case a prior Austrian and a prior Bavarian patent had expired. The original term granted for the Austrian patent was one year and the patent was "*prolonged*" from year to year, and then permitted to expire. The original term was granted October 31, 1869, and the patent expired May 26, 1876 (see record on appeal, pp. 484-486). The Bavarian patent was granted April 8, 1873, "for the space of two years." It was then "*prolonged* (renewed) from April 8, 1875, for another year" and "became void on the 8th of April, 1876, on account of expiration of the granted term" (record on appeal, p. 487.) Upon the argument in the Supreme Court, as appears from page 3 of appellant's brief by Mr. Offield, the "asserted error" was that the court below dismissed appellant's bill upon this ground alone, namely, "that the complainant's patent expired April, 1876, by the expiration of the Bavarian and Austrian patents."

The Supreme Court affirmed the decree of the court below, dismissing the bill for the reasons stated, and upon the question of identity of invention the Supreme Court said;—

> "In regard to the foreign patents the opinion of the Circuit Court says; . . . p. 194, 'A fair test of the question as to whether the American patent is anticipated by the foreign patents, or *is included in them*, we think would be: were a person in this country, after the issue of the present American patent, to commence the manufacture of oleomargarine by the precise process described in the Bavarian or Austrian patents, supposing that process had not been patented abroad, would the courts

refuse an injunction to restrain the use of the process on the ground that it infringed that covered by the American patent? We can hardly deem it possible that any intelligent court would deny an injunction if applied for under such circumstances, and we think this fairly illustrates the relation of the foreign to the American patent.'

"The conclusion of the Circuit Court was that the plaintiffs' *patent expired* by the *expiration* of the Bavarian and Austrian patents.

"We have carefully considered the arguments urged in the briefs of the counsel for the plaintiffs, in connection with the testimony of their experts, and are of opinion that *the views of the Circuit Court, above quoted, are correct.*"

(*j*). *In determining whether a home patent is granted for an invention previously patented in a foreign country, the precise question is whether* ANY *of the claims of the home patent include the invention or some substantive part of the invention shown by the prior foreign patent. If so, the home patent expires as to all its claims with the foreign patent since a* "PATENT CANNOT EXPIRE IN PARCELS."

In *Western Electric Co.* vs. *Citizens Tel. Co.*, 106 Fed. 215, Judge Severens applied the principles of *Siemens' Adm'r* v. *Sellers* and *Commercial Mfg. Co.* v. *Fairbanks Co. supra*, in accordance with the uniform action of the lower courts following the decisions and opinions of the Supreme Court in those two leading cases. The question before Judge Severens was, whether a United States patent had expired with the expiration of several prior foreign patents to the same inventor. A prior Italian patent had been granted to the same patentee for a term of three years and had expired at the end of the three years. Prior English and French patents had also been granted to the same patentee and

had also expired. Differences existed between the United States patent and the prior foreign patents, and the question was whether the United States patent was granted for an invention, *any invention*, covered by the prior foreign patents, and whether the United States patent expired with the prior foreign patents. Judge Severens in deciding that case held that the United States patent was granted for "*an*" invention covered by the prior foreign patents, and, therefore, expired with the Italian patent. As stated in the head note, the *point* of the decision was, whether *any* of the claims of the home patent included any substantive part of the *invention* of *the foreign patent*. In the course of his opinion, Judge Severens said (p. 217);—

> "The question then is whether the Eldred invention covered by his home patent was patented by the one taken out in Italy, *or*, putting it another way, and with rather *more precision*, do its claims, *or any of them*, include the invention, or *some* substantive *part* of the invention, on which an independent claim might be founded, shown by the Italian patent. There being no formal claims in the latter patent, it is *prima facie* to be presumed that the law of Italy does not require it. And the further inference arises that whatever is new either in a single element, or in a combination of several elements, such as might stand for a claim under our own statute, would be covered by the patent. . . . *A careful study of the Eldred Italian patent leaves no doubt that it does embody the very matter of many of the claims of his home patent; that is to say, very many of the claims of the latter could be well founded on the specification of the former.*
>
> . . . (p. 219) "To the British patent are appended nine claims, eight, at least, of which are founded on the *details* of the single exchange office, and are for combinations and congeries thereof. Identical claims are appended to the French patent. With respect to most of those claims, if one were allowed to substitute equivalents, they could be made upon the specifications of the home patent. But, what is more directly to the point, the es-

sence of the patent in suit contained in the first *claim* thereof, namely, the cutting out of the annunciator from the circuit employed for conversation, is embodied in the description of the invention in the foreign patents. The construction given in the specification necessarily involves it. The case is, therefore, brought under the operation of the rule, laid down in *Siemens' Adm'r.* v. *Sellers*, 123 U. S. 276, even though it be conceded that there are differences in some details between the foreign and the home patents upon which independent claims might be based. *If the home patent cannot expire in parcels, and the Italian patent, for instance, covered the matter of the first claim of the patent in suit, it necessarily follows that the home patent expired with the Italian patent three years after the issue of the latter, and from this it necessarily results that the complainant must fail, and that the bill should be dismissed."*

The basis of this decision, as appears from the words in italics, is that the *"home patent cannot expire in parcels,"* following the *rule* of the Supreme Court that a patent *"cannot be construed as running partly from one date and partly from another. This would be productive of endless confusion."* Such rule is in conformity with the clear, unambiguous provision of the Statute. The Circuit Court, in the suits at bar, in order to hold claims 5 and 35 to be still in force, was obliged to ignore, as it did ignore, the principle of the Statute and of the two decisions cited and to rely upon a ground inconsistent with the statute and the *principle* of the decisions cited.

(*k*). *The Circuit Court and the Circuit Court of Appeals for the Second Circuit have determined the question, whether a home patent was "granted for an invention" previously patented in a foreign country, by ascertaining whether* "ANY ONE *of the in-*

> *ventions" claimed in the home patent is contained in the prior foreign patent, and whether any claim of the home patent would be infringed by the structure of the foreign patent; and have held in effect, that in such case, the home patent could not expire in parcels.*

In *Electrical Accumulator Co.* v. *Brush Electric Co.*, 52 Fed., 130, the Circuit Court of Appeals for the Second Circuit, following *Siemens' Adm'r* v. *Sellers* and *Commercial Mfg Co.* v. *Fairbank Co.*, *supra*, held that a home patent did not expire with a prior Italian patent, giving as the reason therefor, that *no one* of the inventions of the home patent was covered by the prior Italian patent. The Court said (p. 139);—

> "In our opinion, the Italian patent is not the same in *its* essential particulars with *any one* of the inventions which are claimed in 337,299, and the home 'patent would not be infringed by a structure made in accordance with the provisions of the foreign patent.'"

Clearly the court had in mind the *rule* that a patent cannot expire in parcels, cannot be construed as running partly from one date and partly from another, and the *further rule* that a United States patent is granted for an invention previously patented in a foreign country if the home patent, that is any *claim* of the home patent, would be infringed by a structure made in accordance with the provisions of the foreign patent. If it would be so infringed, then the "essential particulars" of the prior foreign patent are the same as *some* invention, "*any one*" of the inventions, *claimed* in the home patent and the term of the home patent must expire with the expiration of the term of the prior foreign patent.

In the court below (47 Fed., 48, 52), in the same

case, Judge Coxe was clearly of the same opinion. In the course of his opinion, he said (p. 52);—

> "Whether the expiration of a foreign patent for an improvement only will operate to overthrow a domestic patent for a broad invention, which contains also a claim covering the improvement, has not, *apparently*, been decided by the Supreme Court. *The language of the Court in Siemens' Adm'r v. Sellers, supra*, is, *perhaps, comprehensive enough to cover such a contingency, but this is a question which need not now be considered.*"

Judge Coxe's meaning is clear. Although the facts in *Siemens' Adm'r v. Sellers* were slightly different from the facts in the case supposed, nevertheless the *principle* of the decision in the *Siemens'* case, contained in the comprehensive language referred to, would cover the situation in the case supposed. It is significant that, in the same case on appeal, the Circuit Court of Appeals agreed, as above shown, with Judge Coxe's statement as to the comprehensive character of the *principle* enunciated in the *Siemens'* case and, therefore, applied the *rule* and *test*, which appellants in the suits at bar contend is the *only* rule and test prescribed by the statute. The principle, by which this case is to be decided, must be derived from the *statute solely* and the statute affords no basis for any distinction in principle between the facts in the *Siemens'* case and the facts in the case put by Judge Coxe. Judge Townsend, in the suits at bar, was unable to state or to point out any such distinction in principle and no such distinction exists or has ever been stated to exist in any reported case, while, on the other hand, every expression bearing directly upon the question used by the courts confirm the appellants

in their contention that the rule and test applied by the Circuit Court of Appeals in the *Electrical Accumulator Co.* case, above cited, is the only rule and test derivable from the statute.

No further consideration of authority is necessary to show that if the subject matter of one or more claims of a United States patent is covered or protected by a prior foreign patent to the same inventor, the United States patent is "granted for an invention" previously patented in a foreign country and its *term* expires, and, therefore, all its claims expire, with the expiration of the term of the prior foreign patent. *The patent cannot expire in parcels; it can have but a single term.* And the test as to whether the subject matter of a claim of the United States patent is covered or protected by the prior foreign patent, or is included in it, is, as laid down by the Supreme Court in *Commercial Mfg. Co* v. *Fairbank Co., supra*, whether an article made according to the description of the prior foreign patent would infringe the American patent. If the article would infringe the American patent, that is, any *claim* of the American patent, then the same invention is covered by the American and the prior foreign patent, and the term of the American patent and all the claims thereof expire with the prior foreign patent. These propositions of law are so clear under the statute and the authorities cited and their application to the suits at bar is so obvious that it is unnecessary further to show that the reproducer of Berliner's prior German patent No. 53,622, would, without question, infringe claims 24, 25, 26, 28, 31, 32, 33 and 34, and possibly other claims.

(*l*). *The improvements claimed in claims 24-34 are included among the elements of the improvements claimed in claims 5 and 35 of*

the patent in suit. Claims 5 and 35, being claims for improvements merely, as above shown under Point One, must expire, under any construction of the Statute, with the expiration of other claims for improvements; and being claims for improvements which include the improvements claimed in the claims which concededly have expired, claims 5 and 35 must, a fortiori, have expired with the expiration of the other claims for improvements.

Althought not necessary to the point hereunder discussed, because if claims 24-34 or anyone or more of them cover the invention of the prior German patent No. 53,622, the term of the patent in suit, and all its claims, including claims 5 and 35, expired with the expiration of the term of the German patent, it may be here remarked that the reproducer covered *specifically* by the claims mentioned 24-34 of the patent in suit and by the prior German patent is an *element* of claims 5 and 35. The stylus is provided with a wedge-shaped point, shaped for engagement with the record, and is permitted to *vibrate substantially as described* in claim 5; and the reproducing stylus, shaped as above described, is free to be *vibrated substantially as described* in claim 35. The reproducer is constructed so as to permit the stylus to engage with the record-groove and to vibrate laterally, and it is the lateral vibration of such a stylus which is referred to and covered in claims 5 and 35 as well as in claims 24-34. *Hence, the invention covered by claims 24-34 permeate claims 5 and 35.* Referring to Judge Hazel's opinion, forming part of the moving papers upon the motions for preliminary injunction, it will be seen that Judge Hazel held that the *lateral vibration* of the stylus and the *construction* and *mounting* of the stylus so as to permit engagement with the record and the lateral vibrations

thereof form a primary, distinguishing and essential feature of Berliner's invention of the patent in suit as claimed in claims 5 and 35 thereof. Judge Hazel, having claims 5 and 35 alone under consideration, said (p. 67);—

> "Complainants contend, and the proofs show, that the stylus attached to the diaphragm is arranged so as to permit the same to *vibrate laterally*, and that owing to lateral undulations in the walls of the record groove, a desirable swaying motion is imparted to the reproducer diaphragm. * * * In the Suess patent is contained a description corresponding to the features of claim 35, in suit. The primary object of Suess, an employee of Berliner, however, was merely *to construct a suitable pivotal support for the diaphragm and stylus, so as to assist such device in its passage across the record.* It is expressly stated in the specification of the Suess patent that the invention relates to improvements in the reproducing apparatus of Berliner, and that the *construction and mounting of the stylus* form no part of the invention. *The improvement of Suess, therefore, is not an anticipation.*"

Thus it was established in the prior suit that the *construction and mounting* of the stylus of the reproducer, so as to permit its engagement with the record and its lateral vibration, was an essential element of claims 5 and 35. But it did not appear in the prior suit, as it does now in the suits at bar, that the construction and mounting of the stylus for such purpose, in the manner shown in the patent, was a mere *improvement* in the details of construction of the reproducer of the gramophone of Berliner's earlier United States and foreign patents.

Reference to the moving affidavits upon the motions also shows that the lateral vibration of the reproducing stylus, shaped for engagement with the record, is regarded by complainants' ex-

perts as an essential feature of claims 5 and 35. Mr. Middleton, for example, in describing the operation of complainants' machine, says (aff. p. 51, fol. 153) that;—

> "The stylus of the sound-box *engages the record groove* of complainants' sound record and when the latter is rotated with the turntable, the stylus is *laterally vibrated* to set up vibrations in the sound-box diaphragm."

Mr. Kennedy, in describing the invention of the patent in suit says, (aff. p. 57, fol. 169);—

> "The sound-box contains a diaphragm which is set in vibration by a stylus suitably connected therewith, which stylus *enters the record* groove and is *laterally vibrated* thereby. These lateral vibrations being reproduced in the diaphragm," etc.

Although the proposition that a reproducer, having a stylus with a wedge-shaped point, shaped for engagement with the record, and so constructed as to permit the lateral vibration of the stylus, is an element of, and permeates, claims 5 and 35, is not essential to the point here under discussion, that the reproducer of the prior German patent No. 53,622 having been patented by the patent in suit, the *term* of the patent in suit and, therefore, all the claims thereof expired with the expiration of the term of the prior German patent; nevertheless, in *Sawyer, Spindle Co.* v. *Carpenter*, 133 Fed., 238, aff'd 143 Fed. 976, Judge Brown held, that where a *specie claim* of a home patent expired with the expiration of a prior foreign patent, a *generic claim* of the home patent, covering the specific form of the specie claim and *other forms as well*, also expires, *because* although the American generic claim may be *broader*, "it is still true that what is claimed under the generic

claim has already been patented in a foreign country."

> *(m). Judge Brown has held, in Sawyer Spindle Co. v. Carpenter, 133 Fed., 238; aff'd, 143 Fed., 976, (1), that a patent cannot expire in part and survive in part; and (2) that a generic claim, covering the specific form of a specie claim and other forms as well, must, under any construction of the statute, expire with the expiration of the specie claim. Hence, if claims 5 and 35 in suit are generic or broad claims, they must have expired, with the specie claims under the second part of Judge Brown's decision, as well as under the first part.*

In *Sawyer, Spindle Co.* v. *Carpenter*, 133 Fed., 238, aff'd, 143 Fed., 976, Judge Brown criticised Judge Thomas' decision in Aquarama Co. v. Old Mill Co., 124 Fed., 229, and said;—

> Brown, D. J; p. 240. "The defendant contends also that the invention of claim 5 of the patent in suit was not patented by the British patent. It is conceded that the first four claims of the patent in suit and of the British patent are substantially identical, and that the inventions covered thereby are the same. The defendant argues that, though the patent in suit may have expired as to four of its claims, it may still exist as a valid patent for the invention of the fifth claim: citing *Aquarama Co.* v. *Old Mill Co.* (C. C.) 124 Fed. 229. I do not find, however, in the opinion in that case, any reference to *Siemens' v. Sellers*, 123 U. S. 276, where a similar contention was made (page 280, 123 U. S.). The court said (page 283, 123 U. S.):
>
> "'A patent cannot be exempted from the operation of the law by adding some new improvements to the invention, and *cannot be construed as running partly from one date and*

partly from another. This would be productive of endless confusion.'

"But assuming *for the sake of the argument only*, that a patent may be limited *in term* by a foreign patent as to some of its claims, and not as to others—that it may expire in part and survive in part—it would still seem impossible that a single claim should in part expire and in part survive. Where the difference between two claims is merely in breadth, the first being a specific claim for a particular embodiment of an invention, and the second being a generic claim which covers the specific form of the first claim, and other forms as well, it follows, upon the expiration of the specie claim, that the specific invention claimed therein can no longer be held to infringe the patent, and that the generic claim has expired in part at least. Two patents and two claims may be regarded as for the same invention, though one claims only a special machine, and the other claims broadly a genus which includes the former. *Otis Elevator Co.* v. *The Portland Co.*, 127 Fed. 557 (C. C. A.); *Miller* v. *Eagle Mfg. Co.* 151 U. S., 186; *Robinson on Patents* § 464 465, vol. 2, p. 45. When this is the case, *though the American claim may be broader than that of the prior British patent, it is still true that what is claimed under the generic claim has already been patented in a foreign country.* I can see no reason why the rules which are applied to determine the question of double patenting when United States patents are involved are not also applicable when the question is whether the invention has been first patented in a foreign country."

Judge Brown was clearly of the opinion that *a patent cannot expire in parcels, cannot expire in part and survive in part;* but, under the assumption made by him *"for the sake of the argument only"*, if claims 5 and 35 are generic claims, they must be held to have expired with the specie claims 24-34, covering the construction of the stylus with a wedge-shaped point, so as to permit

engagement with the record, and covering the construction and mounting of the stylus, so as to permit the lateral vibrations, substantially as described, since those elements are all embodied in, and permeate, claims 5 and 35.

> (*n*). *In order that the statute shall apply and limit the term of the home patent, the home patent must be granted for an invention for which the prior foreign patent was granted. Aquarama Co. v. Old Mill Co., 12½ Fed., 229; Westinghouse Co. v. Stanley Co., 138 Fed., 123.*

Judge Brown was correct in stating that in Judge Thomas' opinion in *Aquarama Co.* v. *Old Mill Co., supra*, there was no reference to *Siemens' Adm'r* v. *Sellers*, 123 U. S., 126. A careful reading of Judge Thomas' opinion discloses, however, that Judge Thomas did not hold anything contrary to the decision of the Supreme Court in *Siemen's Adm'r.* v. *Sellers*, that a patent "*cannot be construed as running partly from one date and partly from another. This would be productive of endless confusion.*" If Judge Thomas did so hold, his decision, of course, is not in accordance with the well settled law. Counsel for defendants in the suits at bar was connected with the suit of the *Aquarama Co.* v. *The Old Mill Co.*, in one of its aspects, but not upon this question of the expiration of the United States patent by reason of the prior English patent. In order to understand, however, what was decided by Judge Thomas upon this point in that case, counsel has examined all the papers, including the affidavits, exhibits and briefs on both sides filed on the motion to dissolve the injunction upon the ground that the United States patent had expired with the expiration of a prior English patent. The

question argued by the experts in the affidavits and by counsel in their briefs was *solely* the question as to whether or not the invention covered by the United States patent was the same as the invention covered by the prior English patent. There was really but little argument on the point on behalf of the defendants, who were not represented by counsel of the patent bar. Complainant's experts and counsel argued at great length to show that the canal of the English patent would not infringe the U. S. patent and that the inventions of the two patents were not the same and Judge Thomas, as appears from his opinion, took that view. The decision of the Supreme Court in *Siemens' Adm'r* v. *Sellers* was not cited in the brief of either counsel. No such point was made. In fact, counsel for defendants in support of the motion cited only one case, *Commercial Mfg. Co.* v. *Fairbank Co.* in the Court below, 27 Fed., 78, on the question of identity of invention and in addition cited *Edison Co.* v. *Electric Co.*, 60 Fed., 401, aff'd, 66 Fed., 509, and *Bonsack* v. *Smith*, 70 Fed., 383, to the effect that the burden was upon the complainant to show that the prior English patent had been renewed. No other cases whatever were cited on behalf of the defendants in support of their motion, and no other points whatever were raised either in their affidavits or in their brief in support of the motion. Hence, *the only question before Judge Thomas was whether or not the inventions of the United States and of the English patents were the same*, and on this point he held with the complainants that the inventions were not the same, and it followed necessarily that the United States patent not covering the invention of the English patent and being for an improvement of a patentable nature did not expire with the

English patent. There was no claim of the United States patent which would have been infringed by the structure covered by the English patent, and hence Judge Thomas merely held, that the United States patent was for a patentable improvement over the invention shown in the English patent, and was not "granted for an invention" previously patented in a foreign country and did not expire with the English patent. Judge Thomas did not hold contrary to the decision of the Supreme Court in *Siemens' Adm'r.* v. *Sellers* that the United States patent expired as to part and continued in force as to the improvements. Being a patent for improvements *only* not set forth in the English patent, it was not granted for an invention previously patented by the English patent and did not, therefore, expire with the English patent.

In *Westinghouse Co.* v. *Stanley Co.*, 138 Fed. 125, it was argued by complainants' counsel (see brief on appeal, p. 27) that;—

> "There is no case which desides that a foreign patent for an *improvement* not described or suggested in a United States patent will limit the latter's term."

The court upheld this contention which was unquestionably correct. The improvement, the court said, "was a patentable improvement" and hence the invention of the prior English patent, which was for the patentable improvement, was not the same as the invention of the United States patent which did not cover the improvement for which *alone* the English patent was granted. The United States patent, therefore, was not "granted for an invention" previously patented in the foreign country and the Statute did not apply.

On the other hand, in *Aquarama Co.* v. *Old Mill Co.*, 124 Fed. 229, Judge Thomas held that a United

States patent for an improvement *only* was not limited by a prior English patent which did not contain the improvement. At p. 232, Judge Thomas said;—

> "In the United States patent the obvious purpose was to *close* the space. Everything shows that the space was to be kept *open* in the British patent and to be *closed* in the United States patent. . . ."
>
> This difference, Judge Thomas held (p. 233) was "so valuable and apparently so indispensable to the proper operation of the canal that it must be concluded that it shows patentable invention."

The foregoing decisions in *Westinghouse Co.* v. *Stanley Co.* and in *Aquarama Co.* v. *Old Mill Co.* are in accord with the decision of the Supreme Court in *Miller* v. *Eagle Mfg. Co.*, 151 U. S. 186, where the Supreme Court laid down the broad rule that (p. 198);—

> "The result of the foregoing and other authorities is that no patent can issue for an invention actually covered by a former patent, especially to the same patentee, although the terms of the claims may differ; that the second patent, although containing a broader claim, more generical in its character than the specific claims contained in the prior patent is also void. . . .
>
> (p. 199) "It is also settled that an inventor may make a new *improvement* on his own invention of a patentable character, for which he may obtain a separate patent, and the cases cited by the appellee come to this point and to this point only, that a later patent may be granted where the invention is clearly *distinct from*, and *independent* of, one previously patented."

(*o*). *Judge Lacombe, in the Welsbach Light Co. cases, held that the broad generic claim of a home patent expired with the expiration of*

a prior foreign patent which did not cover the broad invention but covered only a species of the invention.

In *Welsbach Light Co.* v. *Rex Incandescent Light Co.*, 94 Fed. 1006, 1009, Judge Lacombe held that the patent there in suit to Rawson and Rawson, covering the coating of a mantle with paraffine or other suitable material in order to strengthen it for transportation, differed from the prior English patent to Rawson and Rawson in that the prior English patent, as interpreted by the English Court, was limited to a *hot* solution, while the United States patent included, not only a *hot*, but also a *cold* solution. Nevertheless, about a year later, upon the expiration of the prior English patent to Rawson and Rawson, when counsel for defendants in the suits at bar, Mr. Hicks, moved before Judge Lacombe to dissolve the preliminary injunctions previously issued against the use of the process of the patent upon the ground of the expiration of the United States patent with the expiration of the term of the English patent, Judge Lacombe granted the several motions, stating from the bench that there was no question but that the United States patent expired with the English patent. Although the claims of the English patent were different from the claims of the United States patent, and although the English patent was limited to the use of a *hot* solution and the United States patent broadly covered the use of all solutions, both *hot* and *cold*, it was clear that the United States patent was granted for an invention, the use of a *hot* solution, previously patented in the English patent. Hence, under the statute, the term of the United States patent expired with the expiration of the term of the English patent, and with the expiration of the term of the patent the *generic* claim, covering the use of *all* solutions.

hot and *cold*, expired. Orders dissolving the injunctions were entered on August 31, 1900, in the office of the clerk of the Circuit Court in six suits, being those of *Welsbach Light Co.* v. *United Incandescent Light Co.; same* v. *Rex. Inc. Light Co.; same* v. *Daylight Inc. Light Co.; same* v. *Union Inc. Light Co.; same* v. *New York Chemical Refining Co.;* and *same* v. *American Inc. Lamp Co.* The court will, of course, take judicial notice of these orders filed of record. No written opinion was filed.

The claim of the Rawson U. S. patent (see case on appeal, p. 67, *Welsbach Co.* v. *American Co.*, 98 Fed. 613) was as follows:

1. The herein described improvement in strengthening incandescent mantles consisting in coating the completed mantle with paraffine *or other suitable material*, substantially as set forth.

This claim had been held to cover a *hot* and a *cold* solution because of differences in the United States patent.

The Claims of the English patent to the Rawsons, No. 11,161, of 1886, (see case on appeal, p. 306, *Welsbach Co. v. American Co.*, 98 Fed. 613) for this part of the invention, were as follows:—

2. The treatment of the mantles after ignition by immersion in a liquid which will afterwards *set* and will burn away without prejudicial results to the mantles for the purposes set forth.

3. The use of paraffin substantially as described in the treatment claimed under the second claim.

These claims, the English court and Judge Lacombe held, were limited to the use of a *hot* solution (see opinion of Justice Wills in *Sunlight Inc. Gas Lamp Co.* v. *Inc. Gas-Light Co.*, 14 Rep. of Pat. Des. & Trade Cas. 757, and opinion of Judge La-

combe in *Welsbach Light Co. v. Rex Inc. Light Co.*, 94 Fed. 1006).

> (*p*). *Broadening or narrowing the invention of the home patent, or changing the form of the claims from process to product, will not save the home patent. If a structure made pursuant to the prior foreign patent will infringe the home patent, the latter expires with the former. This, say Judges Coxe and Wheeler, is the essence of the test.*

In *Clark* v. *Wilson*, 28 Fed. 95, Judge Wheeler held, as stated in the head note, that;—

> "1. A patent which is a mere adaptation of a foreign patent expires in this country at the same time with the foreign patent (Rev. St. § 4887)."

In *Clark* v. *Wilson* a slight addition, not constituting a different invention, had been made to the United States patent. This Judge Wheeler held narrowed the United States patent and brought it within the scope of the English patent, instead of making it for a different invention. "What would infringe the American patent," he said, "would infringe the English patent, and what would infringe that was made free to the public by the expiration of that and the corresponding American patent." Here we have a *narrowing* of the invention in the United States patent, while in *Welsbach Light Co. v. the Rex Inc. Co. supra*, we had a *broadening* of the invention in the United States patent; nevertheless, in each case it was held that the United States patent was granted for an invention previously patented in the foreign country and that the United States patent expired with the prior foreign patent.

In *Holmes Electric P. Co.* v. *Metropolitan Co.* 33 Fed. 254, Judge Coxe held that although the claims of the United States patent took "*a much wider*

range" than the claims of a prior United States patent, and a prior foreign patent, nevertheless the patentee had by the second United States patent attempted to claim the same invention *more broadly*, and he accordingly held, not only that the second United States patent was void for double patenting, *but also* that under the decision of the Supreme Court in *Siemens' Adm'r.* v. *Sellers*, the United States patent expired with the prior foreign English patent, and quoted, in support thereof, the part above quoted from the opinion of the Supreme Court in *Siemens' Adm'r.* v. *Sellers*.

In *Accumulator Co.* v. *Julien Electric Co.*, 57 Fed. 605, Judge Coxe held that a United States patent expired with a prior Spanish patent, although the claim of the Spanish patent was for a product and the claim of the United States patent was for a process. "The two patents were," he said, "for the same invention" following *Plummer* v. *Sergeant*, 120 U. S., 442 and *Mosler Safe Co.* v. *Mosler*, 127 U. S. 354, where the Supreme Court held that: "Although there are two patents, one for a process and the other for a product, there is in fact but one *invention*." In the same case (p. 607) Judge Coxe also stated that the tests for identity between a home patent and a foreign patent come down to the question "*Will a structure made pursuant to the foreign patent infringe the domestic patent?*"

In *Oval Co.* v. *Sandy Co.*, 60 Fed., 285, 289, the same principle was stated and applied by Judge Coxe.

In *J. L. Mott Iron Works* v. *Henry Co.*, 80 Fed. 516, Judge Wheeler said;— (p. 518)

> "*The Canadian patent is for this balanced float valve, in combination with other parts*, in a tank for intermittent supply; and the United States patent is for the same thing, *in*

various combinations with other parts in such a tank. They appear to be for the *same invention, in substance*, and by the expiration of the former the latter was ended. Bill dismissed."

In *Atlas Co.* v. *Simmonds Co.*, 102 Fed. 338, Judge Buffington held that "it is not essential that the foreign patent shall be the equivalent of a patent granted by the United States, either as to the length of the term or the breadth of the exclusive rights secured to the grantee."

In *Williams Co.* v. *Miller Co.*, 108 Fed. 967, and 115 Fed. 526, Judge Wheeler applied the test of *Commercial Mfg. Co.* v. *Fairbank Co.*, *supra*, and held that the devices of a prior British patent would infringe the claims of the United States patent, and that the United States patent, therefore, expired with the British patent.

POINT THREE.

Berliner Patent in suit No. 534,543, of February 19, 1895, was granted for inventions previously patented by Berliner in France, by Berliner French patent No. 207,090, of July 19, 1890. The term of the patent in suit, therefore, expired with the expiration of the term of the prior French patent on July 19, 1905, before the motions for preliminary injunction were made.

(*a*). *French patent No. 207,090 is new evidence. Defendants' affidavits show that it was granted for inventions for which the patent in suit was granted.*

French patent No. 207,090, of July 19, 1890, to

Berliner was not set up in the answer or offered in evidence in the prior suit. It is new matter absolutely. A certified copy of the patent forms part of defendants' exhibits (stipulation, T. case, p. 556; L & C case, p. 542). A copy of the drawings and a translation of the specification of the patent are found in the record (pp. 126-131).

That the inventions described and covered by the French patent are identical with inventions described and covered by the patent in suit and for which the patent in suit was granted, is shown by defendants' affidavits (Aff. Hicks, pp. 86-88, 82-85, fols. 256-262, 245-253; aff. Ensign, pp. 99-101, fols. 297-303; aff. Leeds, pp. 116-119, fols. 348-355).

(*b*). *French patent No. 207,090, according to the French law expired July 19, 1905.*

According to the French Law, the longest duration of a patent is fifteen years (p. 176, fol. 527). It appears upon the face of the French patent No. 207,090 of July 19, 1890, that it was granted for the period of fifteen years from that date, (p. 126, fol. 377). It is clear, therefore, that the French patent is a prior patent to Berliner for the same inventions, for which the patent in suit was granted, that it expired July 19, 1905, and that, if we disregard the expiration of the patent in suit on November 7, 1902, with the prior German patent, the patent in suit expired with the French patent on July 19, 1905.

(*c*). *The description and claims of the prior French patent and of the patent in suit for inventions for which the patent in suit was granted.*

Referring to the specifications and drawings of the French patent No. 207,090, to Berliner, it ap-

pears that Figures 1 and 2 illustrate Berliner's recorder or recording diaphragm and stylus, and that Figures 3 and 4 illustrate Berliner's reproducer or reproducing diaphragm and stylus. Since we have just considered the reproducer in connection with the prior German patent, it will be more convenient to consider first the reproducer and then the recorder of the French patent, and compare them with the reproducer and recorder of the patent in suit.

The reproducer shown in Figures 3 and 4 of French patent No. 207,090 is identical with the reproducer shown in figures 6 and 7 of the patent in suit. There is the same diaphragm B mounted in the same casing A. There is the same leaf-spring FH bent at right angles so that the face of one part is perpendicular to the face of the other part. The one part of the leaf-spring faces the face of the diaphragm and is secured at the end to the casing at P, while the free end of the leaf-spring crosses the diaphragm casing edgewise, just as in the United States patent. Where the leaf-spring crosses the diaphragm casing edgewise the leaf-spring comes in contact with the casing and presses against the casing. The French patent says (p. 127, fol. 381);—

> "In the reproducing sound-box, 3, 4, the extremity of the acoustic spring H, carrying a ring of caoutchouc G, presses against the casing of the sound-box. From the point of view of reproduction this is more advantageous than if the spring were free, as in the recording sound-box, 1, 2."

The leaf spring of the French patent is provided with a ring of caoutchouc or rubber G, just as is the leaf spring of the United States patent, "so that this envelope dampens the individual vibrations of the acoustic spring" (p. 128, fol. 383). In the

French patent there is the same block M attached to the free end of the leaf spring in which, by means of the set screw N, the stylus O, having the same wedge-shaped point, shaped for engagement with the record, is secured in precisely the manner described in the United States patent. Also in the French patent the leaf-spring is connected with the center of the diaphragm by the pin I which is secured by the casing L, and the screw Q. The pin I is fixed in the same manner for the connection of the leaf spring with the diaphragm and the same means exist for fixing or regulating the *tension* between the leaf spring and diaphragm. In the tube C, leading from the diaphragm casing, is the perforated diaphragm D to render the tone more clear, just as in the United States patent the perforated diaphragm 114 is inserted in the tube 90 for the same purpose. Thus it appears that the reproducer of the French patent is identical in every particular with the reproducer of the United States patent, and would infringe claims 24-34 of the United States patent quoted *supra* under Point Two, Subdivision (*c*), pp. 40-42.

Referring now to the recorder of the French patent illustrated in Figures 1 and 2 thereof, and comparing it with the recorder of the United States patent illustrated in Figures 4 and 5 thereof, it appears that *every feature of the recorder of the French patent is embodied in and forms part of the recorder of the United States patent.* The eccentricity of the leaf spring in the recorder of the United States patent is a mere detail which, as Judge Wheeler held in *Clark* v. *Wilson*, 28 Fed. 95, referred to, *supra*, under Point Two, Subdivision (*p*), p. 77, merely narrows the United States patent and brings it within the scope of the French patent.

Moreover, the leaf-spring is so mounted upon the

diaphragm and diaphragm casing that its eccentricity can be done away with and the leaf spring made to extend along the line of a diameter of the diaphragm (see Fig. 4, patent in suit; aff. Leeds, p. 118, fol. 353-354; aff. Ensign, p. 101, fol. 301; aff. Hicks, p. 83, fols. 248-249).

What then are the features of the invention of the recorder of the French patent and of the recorder of the United States patent? Referring to figures 1 and 2 of the French patent and to the specification thereof (pp. 126-131), it appears that there is the diaphragm B mounted in the casing AA with a tube C leading from the diaphragm casing and having a perforated diaphragm D in the tube to render the tone more clear. Extending across the face of the diaphragm is the leaf spring or acoustic spring FH, composed of two parts F and H joined together so that the face of the part H is at right angles to the face of the part F. It will be noted that the leaf spring in the recorder is formed, not by twisting a single piece of metal so that the parts shall be at right angles the one to the other, but by joining together two separate thin strips of metal so that the parts shall be at right angles the one to the other. The specification of the patent states (p. 126, fol. 378) that the acoustic spring FH may be "composed either of two springs placed at right angles the one to the other, as in figures 1 and 2, or of a spring bent as in figures 3 and 4." It is well to observe here that in figures 3 and 4 of the French patent the reproducer is shown having a leaf spring which is bent and in figures 6 and 7 of the United States patent the reproducer is shown having the leaf spring similarily bent; but in the recorder shown in figures 1 and 2 of the French patent and in figures 4 and 5 of the United States patent the leaf spring or acoustic spring is composed of two parts joined

together at right angles "by soldering or otherwise," as stated in the patent in suit (p. 3, line 54). Continuing now with the description of the recorder in the French patent, the leaf spring is connected with the center of the diaphragm by the pin I and nuts KK serve to regulate the *tension* between the leaf spring and the diaphragm (p. 127, fol. 379). One end of the leaf spring is secured to the diaphragm casing while the other end is free to vibrate and crosses edgewise the diaphragm casing. The leaf spring faces with its flat side the face of the diaphragm. In order to dampen the individual vibrations of the leaf spring, one or more bands of rubber G are placed upon it. The free end of the leaf spring is bent in its normal position, but opens so as to become straight when it presses upon the tablet for the recording of the sound waves (pp. 127-128, fols. 380 and 383). Such are the features of the recorder of the French patent.

The seven claims of the French patent, broadly covering both the reproducer and the recorder of the patent in suit, are as follows (p. 128);—

> 1. An apparatus for *recording* and *reproducing* sound-waves, composed of a diaphragm and of a vibrating spring or leaf placed transversely over the latter and of which one end is fixed while the free end is in contact with the surface recording the sound waves.
>
> 2. An apparatus for *recording* and *reproducing* sound-waves, composed of a diaphragm, of an acoustic spring placed over the diaphragm and attached to it, a spring which is in part surrounded by gutta-percha, felt or by other like material, so that this envelope dampens the individual vibrations of the acoustic spring.
>
> 3. An apparatus for *recording* sound-waves, composed of a diaphragm and of an acoustic

spring connected with it, the free end of which is bent in its normal position but opens, so as to become straight, when it presses upon the tablet for the recording of the sound-waves.

4. An apparatus for *recording* sound-waves, composed of a diaphragm, of an acoustic spring placed over it and of a pin which connects the spring to the diaphragm in such manner that the tension between it and the acoustic spring can be regulated.

5. An apparatus for *reproducing* sound-waves, composed of a diaphragm, of an acoustic spring placed over it and of a casing at the free end of the acoustic spring, into which casing one point of a needle is fixed in such manner as to be able to be taken out of it and replaced without difficulty.

6. An apparatus for *reproduction* of sound-waves, composed of a diaphragm, of an acoustic spring placed over it and of a casing at the middle of the spring, which casing is traversed by a separate pin establishing the connection with the diaphragm or spring.

7. An apparatus to *reproduce* sound-waves, composed of a diaphragm, of a casing for the diaphragm and of an acoustic spring placed over the diaphragm and connected to it, while its free end presses upon or against the casing.

Referring to the patent in suit and figures 4 and 5 thereof, and the description of the recorder at p. 3, lines 3-109, it appears that the recorder of the United States patent has the same casing 40 and 57, the same diaphragm 56 mounted therein, the same acoustic spring or leaf spring composed of two parts 61 and 62 joined together so that the parts are at right angles to each other and one end is secured to the diaphragm casing while the other end is free to vibrate. The free end 62 is normally curved, 62′, but opens so as to become straight when the stylus impinges upon the record tablet preparatory to the making

of a record (patent in suit, p. 3, lines 93-109.) The leaf spring is connected with the center of the diaphragm, and by means of the screw 66, the tension of the diaphragm may be regulated. In the tube 39 leading from the diaphragm casing is the perforated disc 67, just as in the recorder of the French patent. While unquestionably the recorder of the United States patent shows some differences and modifications, it is also unquestionably true that every feature of the recorder of the French patent is embodied in, and forms part of the recorder of the United States patent, and the main features of the recorder of the United States patent are all embodied in the recorder of the French patent. In the patent in suit the main features of the invention embodied in the recorder are set forth in claims 7, 9, 10, 25 and 31, which read as follows:—

> "7. In a gramophone, the combination of a sound receiving diaphragm and an elastic recording stylus controlled by the diaphragm and adjustable with reference to a record tablet so as to press by its own elasticity upon the same at right angles to the plane of its vibratory movements, substantially as described."
>
> "9. In a gramophone, a recording stylus composed of a leaf spring terminating in a tracing point in combination with one or more elastic non-sonorous dampers, substantially as described."
>
> "10. In a gramophone, a recording stylus formed of a leaf spring terminating in a tracing point in combination with one or more sleeves of soft rubber upon the leaf spring for damping the same, substantially as described."
>
> "25. In a gramophone, the combination of a diaphragm and a stylus carrier composed of a leaf spring twisted at one point so as to bring the edge of one portion at right angles to the

face of the other portion, whereby it is elastic in two directions, substantially as described."

"31. In a gramophone a recording stylus pivoted to move in response to the vibrations of a diaphragm and elastic in a plane at right angles to such motions, substantially as described."

The foregoing like the claims of the French patent, are all broad claims is no way limited by any special details or special improvements of the recorder of the United States patent. Unquestionably, the foregoing broad claims would be infringed by a recorder made according to the French patent.

Claims 6, 8 and 16 of the patent in suit read as follows;—

6. "In a gramophone, a recording stylus pressing by its own elasticity upon the record tablet at right angles to the plane of its vibratory movements and consisting of a leaf spring terminating in a point of *harder material* than that of the body of the stylus, substantially as described."

"8. In a gramophone a recording stylus pressing by its own elasticity upon the record tablet at right angles to its plane of vibratory movements, and consisting of a leaf spring terminating in an *iridium* point, substantially as described."

"16. In a gramophone a sound receiving diaphragm and a tube for conveying sound waves thereto in combination with a recording stylus receiving motion from the diaphragm, and a *screw* mounted in the sound conveying tube bearing centrally upon the diaphragm for adjusting the tension of the latter, substantially as described."

These claims according to the decision of Judge Wheeler in *Clark* v. *Wilson*, *supra*, 28 Fed. 95, are mere adaptations of the recorder of the French

patent not constituting any separate invention but narrowing the United States patent and bringing it within the scope of the prior French patent.

A stylus or leaf spring "terminating in a point of harder material" or "in an irridium point" had been described in nearly all of Berliner's prior patents and was old. (See English patent No. 7204 of 1888, p. 3, line 20; French patent 190,602, record, p. 124, which is the same as the said English patent; German patent No. 47,099, record, p. 150, fol. 448; U. S. patent No. 564,586; p. 5, lines 34-43). On May 16, 1888, in his lecture before the Franklin Institute, Berliner described "an irridium pointed stylus" (p. 276, fol. 808; p. 268, fol. 803). To make such a point a part of the recording stylus of the patent in suit was obviously a mere adaptation of the stylus of the French patent, narrowing the United States patent and bringing it within the scope of the French patent.

Claims 11, 12, 13, 14 and 15 of the patent in suit also cover the recorder and are also narrowed by the element of the eccentricity of the stylus carrier or leaf spring. This eccentricity may be a patentable improvement, but under the decisions of the Supreme Court in *Siemens' Adm'r* v. *Sellers*, and other cases cited *supra*, under Point Two, cannot save the patent.

Clearly the *reproducers* covered by the French and United States patents are identical, and clearly the *recorders* covered by the French and United States patents are identical as to the main features thereof. Judge Townsend so found. The French patent has seven claims above quoted, *covering broadly* the recorder and reproducer (pp. 128-129). It is familiar law, however, that claims form no essential part of a French patent.

There is no requirement for claims in the French law (p. 177, fols. 529-530). A French patent should, therefore, be construed as Judge Severens construed the Italian patent without claims in *Western Electric Co.* v. *Citizens' Tel. Co.*, 106 Fed. 215, quoted *supra* under Point Two. This question, however, is not material, since, it appearing that the inventions covered by the French patent are inventions for which the United States patent was granted, it matters not whether the claims of the one patent be broader or narrower than the claims of the other patent. The claims of the two patents are equally broad. No case can be found where identity of claims has been made the test. The test is whether the United States patent was granted for an invention previously patented in a foreign country. This question is answered by determining whether a structure made in accordance with the foreign patent will infringe the United States patent, that is any claim thereof. If so, the home patent was granted for an invention previously patented in a foreign country and expires with the foreign patent.

(d). Judge Townsend found that French patent No. 207,090 covers the improvements of the patent in suit in the recorder and reproducer.

Judge Townsend, in the suits at bar, found (T. case, p. 336; L. & C. case, p. 320);—

> "The drawings of the German patent are substantially identical with Figures 6 and 7 of the patent in suit and the specifications describe and the claims cover these constructions. The same is true, (barring the claims which are immaterial) of said French patent.
>
> * * * *
>
> "The French patent and the claims of the German patent cover improvements in details of the construction of Berliner's recorder and reproducer."

POINT FOUR.

Berliner patent in suit No. 534,543, of February 19, 1895, expired before suit was begun, on November 8, 1901, with English patent No. 15,232, of November 8, 1887; and on November 7, 1902, with German patent No. 45,048, of November 8, 1887; and on November 8, 1902, with French patent No. 186,827, of November 8, 1887.

(*a*). *This defense of expiration is based upon the opinion of the Circuit Court of Appeals in the prior suit.*

The fourth point rests upon three prior Berliner patents, to wit: English patent No. 15,232 of Nov. 8, 1887, German patent No. 45,048 of Nov. 8, 1887 and French patent No. 186,827 of Nov. 8, 1887. The fourth point is a defense of expiration *based upon what the Circuit Court of Appeals held* to be the invention covered by claims 5 and 35 of the patent in suit. No one of the three patents upon which the defense is based was in evidence in the prior suit, and no defense of expiration was made in the prior suit. As the defense is established by the opinion of the Circuit Court of Appeals, it is immaterial that these three prior Berliner patents of the defense were mentioned in the answer in the prior suit, since they were not offered in evidence and since the defense of expiration was not made in any form in that suit. Comity has no application to questions *not considered* by the prior court, or, in patent cases, to alleged anticipating devices which were not laid before that court. As to such the action

of the Court is purely original. (Mast, Foos & Co. v. Stover Mfg. Co., 177 U. S., 485 and 89 Fed., 333 (C. C. A.); Page v. Holmes Co., 2 Fed. 330, 336; Stahl v. Williams, 52 Fed. 648, 650.)

(*b*). *The inventions covered by the three patents mentioned were "previously patented" in the foreign countries.*

English patent No. 15,232, of November 8, 1887, one of defendants' exhibits, (T. case, p. 532; L. & C. case, p. 518), was granted for the term of fourteen years, from November 8, 1887, was published December 31, 1887 and was sealed February 17, 1888 (aff. Hicks, p. 82, fol. 244). It was, therefore, previously patented.

German patent No. 45048 of November 8, 1887, another of defendants' exhibits, was patented, as appears from the face thereof (p. 132, fol. 395) from November 8, 1887, and was published November 2, 1888. This being Berliner's primary German patent, its duration, according to the law of Germany (p. 179, fol. 537) was for fifteen years. This patent also was previously patented.

French patent No. 186,827 of November 8, 1887, another of defendants' exhibits, was, as appears from the face thereof (p. 123, fol. 368) granted for the term of fifteen years from November 8, 1887, and was delivered to the patentee, Berliner, on January 26, 1888. It was, therefore, previously patented.

(*c*). *The three prior foreign patents mentioned, each, cover the invention of Berliner's home patents No. 564,586 and No. 372,786.*

A comparison of the three English, German and French patents mentioned to Berliner with United States patent No. 564,586, of July 28, 1896, shows that the English, German and French patents cover the invention of United States patent No.584,-

586 and also the invention of Berliner's basic United States patent No. 372,786, of November 8, 1887. The drawings of the three English, German and French patents mentioned are identical, and figures 1-7 thereof are identical with figures 1-7 of Berliner's basic United States patent No. 372,786, and figures 8-16 thereof are identical respectively with figures 1-9 of the United States patent to Berliner No. 564,586. By stipulation (T. case, p. 554; L. & C. case, p. 540) the drawings of the German and French patents are not reproduced in the record and the drawings of English patent 15,232 of 1887 are to be used as the drawings of the German and French patents. Figures 10 and 11 of United States patent No. 564,586 are omitted in the three English, German and French patents mentioned. That the three English, German and French patents cover the inventions of United States patent No. 564,586 is so obvious that it is hardly necessary to discuss the question. In United States patent No. 564,586, it is stated in the specification (p. 1, lines 14-17) that the invention is an improvement upon No. 372,786 and has been previously patented in Great Britain by No. 15,232, of November 8, 1887. The French patent is identical with the English patent, it being merely a translation thereof (record, p. 123, fols. 368-372). While the language of the German patent is somewhat different, the German patent describes and claims, without question, the same invention. That the English, German and French patents mentioned cover the invention of United States patent No. 564,586 is further shown in defendants' affidavits (aff. Hicks, p. 91, fols. 271-285; aff. Ensign, p. 103, fols. 308-332; aff. Leeds, p. 119, fol. 355), where the identity of various claims and the identity of the inventions are fully pointed out with reference to the different patents.

(d). The Circuit Court of Appeals held, in the prior suit that claims 5 and 35 in suit, broadly cover the invention of patent No. 564,586; hence, they cover the same invention previously patented in the three foreign patents mentioned.

It has been held by the Circuit Court of Appeals, as will be presently shown, that claims 5 and 35, in suit, claim broadly the invention of United States patent No. 564,586. It follows, therefore, *if such holding be correct*, that claims 5 and 35 cover broadly the invention of the three prior English, German and French patents mentioned to Berliner, and that the patent in suit expired, with each of the three prior foreign patents mentioned, before the beginning of suit, at the dates above given.

The Circuit Court of Appeals in disposing of the defense of prior use set up in the suit between these complainants and the American Graphophone Company upon the patent in suit, said;—

> "The specifications in that application (for 564,586) were full enough to warrant the making of the claims here in controversy (5 and 35); at any time the application might have been amended by adding such claims, and in our opinion it is immaterial that instead of thus amending it, he took the *broader* claims on another application filed while the first was pending. The second may fairly be considered a *continuation* of the first, and thus Berliner's application antedates the public use."

The deduc. from the foregoing statement of the Circuit Court of Appeals is that claims 5 and 35 of the patent in suit are "*broader claims*" for the invention set forth in No. 564,586, that Berliner made his application for a patent for that *invention* when he applied for No. 564,586 on November 7, 1887, and that the application for the patent in

suit may fairly be considered as a continuation of the first application filed November 7, 1887. While claims 5 and 35 may be "*broader claims*," they are claims for the invention covered by No. 564,586.

> (*c*). *If the invention of claims 5 and 35, in suit, is not the same as the invention of patent No. 564,586, then defendants' new defence of two years prior, public use is a valid, complete defence, proven beyond a reasonable doubt.*

If the invention of claims 5 and 35 of the patent in suit is not a part of the invention set forth and claimed in No. 564,586, but is a different invention, then Berliner did not apply for a patent on the invention of claims 5 and 35 on November 7, 1887, and the defense of prior, public use set up by the Graphophone Company and the new defense of prior, public use set forth in defendants' affidavits of Martin and Wetzler (pp. 191-197), and the article in the Electrical World of August 18, 1888, (p. 274) are available. But the Circuit Court of Appeals held squarely that claims 5 and 35 of the patent in suit cover broadly the invention of No. 564,586; and did not hold that the specification of No. 564,586 was bad for duplexity of invention.

Clearly the Circuit Court of Appeals, in holding that claims 5 and 35 of the patent in suit cover broadly the invention of No. 564,586, understood Judge Hazel to have held the same point, when in his opinion he said;—

> (p. 66). "In the patent to Emile Berliner, No. 564,586, issued on July 28, 1896, application filed November 7, 1887, the process of recording and reproducing sound vibrations differs essentially from the method used in the phonograph and the graphophone. The specification described a process by which the sounds were inscribed upon a layer of non-resisting material; which was afterwards copied

in a non-yielding material, from which the sounds were reproduced. The specification says:

> 'The original record, as well as the copy of the same, is thus obtained as an undulatory line of even depth, as distinguished from the line of varying depth obtained by the ordinary phonograph and graphophone.'

It is not disputed that such mode or process was a new and meritorious invention and that it was not merely a patent for the functional effect of the machine in connection with which it was used. *The earlier specification does not claim the method nor the details of construction of the claims in controversy;* hence it is contended by the defendant, as will presently appear, that there was a surrender or waiver thereof. In the patent in suit *two features of the invention* are mentioned, one concerning the process or mode of recording sound upon a record, the other as to the construction of the apparatus. . . . .

(p. 70) "That a complete disclosure was made of the described plan of mounting the reproducer diaphragm and stylus in the specification attached to the application filed November 7th, 1887, is freely admitted. Such disclosures consisted of a machine constructed in accordance with the drawing (Figure 10) of the earlier application. The diaphragm and stylus were mounted or suspended upon a conveyor arrangement having rollers. . . . .

(p. 71) "As already appears, the patent in suit was issued upon a later application than patent No. 564,586. Why the *broad claims* of the former were not made a part of the earlier application and specification does not appear. Defendant broadly contends that the fact of the omission by the patentee to claim the invention in the earlier application considered in connection with the above mentioned publication in the "Electrical World," and public exhibition, was an abandonment and forfeiture thereof."

The Electrical World, referred to by Judge Hazel, was the issue of Nov. 12, 1887 (p. 243). The Electrical World, relied upon by defendants in connection with the affidavits of Martin and Wetzler (pp. 191-197), is the issue of August 18, 1888 (p. 274), *not in evidence in the former suit.*

The affidavits of T. Commerford Martin (p. 191) and of Joseph Wetzler (p. 194) associate editors of the Electrical World at the time of the publication of the article of August 18, 1888, show that they, at the invitation of Berliner, witnessed an exhibition by Berliner of the reproduction of sound in the City of New York, by means of the improved gramophone. As a result of that exhibition, Mr. Wetzler wrote the article in the Electrical World for August 18, 1888. The article in the Electrical World is so short that it is not necessary to state here its contents in detail. However, the following clear description of the reproducing apparatus may be quoted (p. 274);—

> "Notwithstanding the simplicity of the etching process that of the reproducing apparatus is still greater. As shown in the accompanying engraving there is no gear or machinery of any kind except a small friction wheel which revolves the table having clamped down upon it the reproducing disc. The reproducing stylus connected to the diaphragm is permitted to rest by its own gravity in the reproducing groove of the record, and when the plate is made to revolve it not only vibrates the diaphragm and reproduces the sound but it also leads the diaphragm box across the disc from periphery to centre so that the record groove serves at the same time as a screw instead of a separate gear. The recording diaphragm and stylus are attached to a lever which is pivoted at a distance of about 18 inches from the centre line of the disc, and as it slowly swings across the disc it describes an arc of very flat amplitude. It may be objected that the motion given

by the hand to the disc would not be sufficiently regular but while it is true that it would be desirable to have a motor attached to the machine, there is no difficulty whatever in revolving the disc regularly by hand, and by hanging up a small pendulum to swing before the eyes of the manipulator he can regulate the revolving motion by the swinging of the pendulum."

Here then, we have a complete disclosure of the perfected gramophone on August 18, 1888, nearly four years prior to the date of the application for the patent in suit. Inasmuch as Berliner and Mr. Martin (affidavits Martin and Wetzler, pp. 191, 194) used the apparatus for the reproduction of sounds in the City of New York, we have a clear case of more than two years public prior use if Berliner is not entitled to the date of November 7, 1887, as the date of his application for the invention of the patent in suit. But the Circuit Court of Appeals has held that Berliner on November 7, 1887, made his application for a patent for the invention of the patent in suit when he applied for a patent for the invention covered by patent No. 564,586; and *defendants, therefore, contend upon that ground and upon other grounds herein fully set forth, that the patent in suit being for some of the features of the invention covered by patent No. 564,586 covers necessarily the invention covered by the three early Berliner English, German and French patents, and expired with said three patents long before this suit was begun. If, however, the invention of the patent in suit is not a part of the invention of patent No. 564,586, applied for November 7, 1887, and if in such case Berliner did not make his application for the patent in suit on November 7, 1887, then clearly the publication of the article in the Electrical World on August 18, 1888, and the use of*

the gramophone during the week preceding August 18, 1888, by Berliner and Mr. Martin, as set forth in the article itself and as stated in the affidavits of Messrs. Martin and Wetzler, is a defense clearly establishing more than two years prior public use of the invention, and the consequent invalidity of the patent if claims 5 and 35 are to be construed broadly and not limited by the improvements in the details of construction of the reproducer shown in figures 6 and 7 of the patent in suit.

> (*f*). *Berliner himself, in patent No. 564,586 asserts that the invention, illustrated in Fig. 10 of that patent and construed by the courts on the evidence in the prior suit to be the invention of claims 5 and 35 in suit, is a mere modification, embodying the main features of the invention of patent No. 564,586.*

More authoritative even than the opinions of the Circuit Court of Appeals and of Judge Hazel upon this point is the statement of Berliner himself in the specification of patent No. 564,586. In that patent Berliner first describes the drawings showing his apparatus from p. 2, line 7, to p. 3, line 54. He then describes the deposition of a suitable layer of ink upon the tablet and the making thereon of a phonatographic record by recording and the copying of that record by photo-engraving, from p. 3, line 55, to p. 4, line 45. He then describes the centering of the copied record upon the metal disc from p. 4, line 46, to p. 4, line 80. Berliner then states that "*the stylus is then adjusted with its point in engagement* with the outer end of the record groove and the weight 26 is allowed to descend. It will now be clear that *the stylus will be forced positively to follow the undulations* of the record and that the diaphragm vibrating under the stylus will emit the same

sounds which produced the original record, which sounds can be distinctly heard at the ear-piece 34" (p. 4, lines 80-89.) Having thus described his invention, Berliner in the very next line says;— "Both the process and the apparatus thus far described may be *modified* in various ways *without departing from the main features of* my invention" (p. 4, lines 90-94).

Then Berliner describes figure 10 as a modification of his invention, which he says *does not depart from the "main features" of his invention.* It is, therefore, *a part* of his invention and it *embodies the "main features"* of his invention described and claimed in patent No. 564,586. It is this description of Figure 10 contained in the specification of No. 564,586 to which the Circuit Court of Appeals referred when it said that claims 5 and 35 of the patent in suit were merely "broader claims" for the invention of No. 564,586, and might have been made in No. 564,586, and to which Judge Hazel referred in the passages above quoted from his opinion. In referring to figure 10 in the specification of No. 564,586 (p. 2, line 22) Berliner says;— "Figure 10 is a sectional elevation of a *modified form* of my reproducing apparatus."

The invention disclosed by Figure 10 was, therefore, made at the same time as the rest of the invention of patent No. 564,586 and was by Berliner embodied in his first application for a patent for that invention as a part thereof embodying the main features of his invention and not departing therefrom. Berliner did not invent the subject matter of claims 5 and 35 of the patent in suit before or after he invented the subject matter of the claims of No. 564, 586. As the Circuit Court of Appeals and Judge Hazel and Berliner himself say, claims 5 and 35 and the claims

of 564,586 cover one and the same invention, although claims 5 and 35 may be broader claims for the invention. After Berliner had filed his application on November 7, 1887, for No. 564,586, he caused to be published in the Electrical World for Nov. 12, 1887, (p. 243) a description of the Berliner gramophone. That description is one of defendants' exhibits, and a reading of it shows that in it Berliner set forth the features of his invention included in his application just filed on November 7, 1887. In the description in the Electrical World of November 12, 1887, is the statement that there are various means for making audible and enlarging vibrations of the reproducing stylus. After mentioning several, Berliner then says (p. 244);—

> "This suggests the plan of mounting a reproducing diaphragm and stylus on a carriage moving on rails and permitting the point of the stylus not only to vibrate, but also to push the carriage across the revolving disc, and thereby follow the volute of the sound record."

The evidence shows, therefore, that Berliner made his invention which was a *unitary* invention, consisting of several *features*, but still a *unitary* invention, and he applied for a patent for *that* invention, as the Circuit Court of Appeals has clearly held, on November 7, 1887, and that application the Circuit Court of Appeals said included the subject matter of claims 5 and 35 of the patent in suit.

> (*g*). *The evidence shows that the invention of claims 5 and 35 in suit, as construed by the Courts in the prior suit, on the evidence therein, is the same as the invention of patent No. 564,586 and of the three prior foreign patents mentioned.*

The point that claims 5 and 35 cover the same invention as the United States patent No. 564,586 and the corresponding English, German and French patents mentioned is so fully elaborated in defendants affidavits above referred to, that it is unnecessary to say more upon this subject (aff. Hicks, p. 91, fols. 271-285; aff. Ensign, p. 103, fols. 308-332; aff. Leeds, p. 119, fol. 355).

(*h*). *Two patents are for the same invention, although each attempts to cover separate features thereof. The finding of the Circuit Court that the three prior foreign patents do not show Fig. 10 of patent No. 564,586 is, therefore, immaterial.*

The question whether two patents cover one and the same invention has been considered by the Supreme Court in *Miller v. Eagle Mfg. Co.*, 151 U. S., 186. In order to hold that two patents are for one and the same invention, it is not necessary that each patent should cover the *same features* of the invention or that the terms of the claims should be alike. Hence, Judge Townsend's finding (T. case, p. 340; L & C case p. 324), that the English, French and German patents do not show Fig. 10 of the home patent No. 564,586, is immaterial. Two patents cover the same invention if they attempt to protect the same thing, although the terms of the claims may differ and *although each patent may attempt to cover separate features of the invention.* It is only when inventions are separate, distinct and independent that separate patents may be obtained therefor. A separate, distinct and independent improvement upon an invention is, the Courts says, an invention for which a separate patent may be obtained. Such an improvement does not, of course, inseparably involve the main features of the first invention and must be dis-

tinct therefrom in point of time (*Electrical Co.* v. *Brush Co.*, 52 Fed. 130, head note 10) and subject matter. In *Miller* v. *Eagle Mfg. Co.*, Mr. Justice Jackson, speaking for the Court upon this point, said;—

> (p. 198). "The result of the foregoing and other authorities is that no patent can issue for *an invention* actually covered by a former patent, especially to the same patentee, *although the terms of the claims may differ:* that the second patent, although containing a *broader claim*, more generical in its character than the specific claims contained in the prior patent, is also void; but that where the second patent covers matter described in the prior patent essentially distinct and separable from the *invention covered thereby* and claims made thereunder, its validity may be sustained.
>
> "In the last class of cases it must *distinctly appear* that the invention covered by the later patent was a *separate invention* distinctly different and *independent* from that covered by the first patent; in other words, it must be something substantially different from that comprehended in the first patent. It must consist in something more than a mere distinction of the breadth or scope of the claims of each patent. If the case comes within the first or second of the above classes, the second patent is absolutely void.
>
> "*It is insisted on the part of the appellee that 'whether this invention shall be protected in part of its features by one patent, and as to the rest by another, or shall be completely protected by a single patent, is a matter which concerns solely the patent office and the inventor'. Under the rule announced in the foregoing authorities this proposition cannot be sustained.*
>
> . . . . "It is settled also that an inventor may make a new improvement on his own invention of a patentable character, for which he may obtain a separate patent, and the cases cited by the appellee come to this point *and to this point only*, that a later patent

> may be granted where the invention is clearly distinct from, and *independent of* one previously patented."

Following *Miller* v. *Eagle Mfg. Co., supra,* the Courts have uniformly held that two patents cannot be obtained for the same invention, although each attempts to cover different features thereof. In *Otis Co.* v. *Portland Co.*, 127 Fed. 557-559, the Circuit Court of Appeals for the First Circuit said;—

> "Two patents may be regarded as for the same invention, though one claims only a *special* machine, and the other claims broadly a *genus* which includes the former. *Miller* v. *Eagle Mfg. Co.*, 151 U. S. 186, 198."

In *Dayton* v. *Westinghouse Co.*, 118 Fed. 562, the Circuit Court of Appeals for the Sixth Circuit, following *Miller* v. *Eagle Mfg. Co.*, said;—

> "This second patent was held void, for the reason that there was no new invention; the invention having patented *simply a part* of the invention previously patented. . . . .
>
> "And in the *Palmer Pneumatic Tire Co.* Case (90 Fed. 732), this court, following the *Miller* case, said:
>
> 'That decision shows that it is not necessary to the rule that patents should be for co-extensive inventions, or that the subject matter thereof should be technically the same.'"

In *Sawyer Spindle Co. v. Carpenter*, 133 Fed. 238, 240, Judge Brown said;—

> "Two patents and two claims may be regarded as for the same invention, though one claims only a special machine and the other claims broadly a genus which includes the former. *Otis Elevator Co.* v. *Portland Co.*, 127 Fed. 557 (C. C. A.), *Miller v. Eagle Mfg. Co.*, 151 U. S. 186."

In the foregoing argument under this point, the

proposition has been that claims 5 and 35 of the patent in suit cover the invention of patent No. 564,586, and, therefore, cover the invention of the prior English, German and French patents mentioned. The distinction between an *invention* and broad or narrow *claims* covering the different *features* of the invention is here important. The patent in suit, therefore, expired with each of the prior foreign patents mentioned.

> (*i*). *It may, in addition, be noted that claims 31 and 32 and 6 and 8 of the patent in suit would be infringed by the lever and stylus of the prior German patent mentioned.*

But specifically, it may be noted, that claims 31 and 32 of the patent in suit would be infringed by the two armed lever *s* described in claim 2b and the stylus 29, described in claim 4b (record, pp. 143-144, fols. 428 and 430) of German patent No. 45048, of November 8, 1887. The main contention here, however, is, for example, that claims 5 and 35 of the patent in suit and claim 8 of No. 564,586, and claim 9 of English patent No. 15,232, of 1887, are for one and the same invention, as fully explained in defendants' affidavits above referred to, under Subdivision (*g*) of this point (p. 100).

Claims 31 and 32 of the patent in suit read as follows:

> "31. In a gramophone a recording stylus pivoted to move in response to the vibrations of a diaphragm and elastic in a plane at right angles to such motions, substantially as described.
>
> "32. In a gramophone, a reproducing stylus having a wedge-shaped point engaging the walls of the record groove, substantially as described."

Claim 2b and claim 4b of German patent No. 45048 read as follows;—

> "2. An apparatus adapted for the use of the coating characterized under 1 for the reception of phonautographic records, characterized by;
>
> b) A two armed lever *s* fastened at the center of the diaphragm (or of the sonorous body) and attached pivotally to the casing (or at the edge) of the same, the free arm of which, pointed at the end, stands at right angles to the axis of the drum and approaches so far toward the same that its point strips off the covering of the paper strip in the direction of a line winding off as a straight or spiral line.
>
> "4. An apparatus adapted for the use of the coating characterized under 1 for the reception of phonautographic records, characterized by;
>
> b) A stylus (29) consisting of elastic stiff parts joined with each other and in like manner as under 2b), yet elastically, joined with the diaphragm (or the sonorous body), the point of which removes the coating of the disc in the direction of the recorded line—and, after the loosening of the adjusting collars connecting the bearing (7) with the shaft 16, in a circle."

In U. S. patent No. 564,586, Berliner made no claims similar to claims 31 and 32, above quoted, of the patent in suit; but the German patent No. 45,048 is the obvious equivalent of U. S. patent No. 564,586. Thus we have additional proof that in the United States Berliner protected by the patent in suit and by No. 564,586 the invention which he previously patented in the three English, German and French patents mentioned.

Referring to Figs. 2, 8 and 9 of German patent No. 45,048, (see drawings of English patent No. 15,232 of 1887) it appears that the stylus *s* and the stylus 29 have wedge-shaped points which engage

the walls of the record groove as does the stylus 112 (Fig. 7) of the patent in suit which, as stated at p. 5, line 88, should, preferably, have a point which is "rather dull." In German patent No. 45,048 the stylus *s* is described (p. 135, fol. 403) and so is the stylus 29 (p. 140, fol. 418) as follows;—

> "The stylus 29, consisting preferably of a *flat* strip of phosphor bronze, pointed at its extreme end and suitably curved."

In claim 4b of the German patent the stylus 29 is further described as a recording stylus, and is said to be elastic. So the recording stylus 62 of the patent in suit (fig. 4) is curved and elastic. In the corresponding English patent No. 15,232 of 1887, it is said (p. 6, lines 46-51); "the stylus 29, which may be of metal or any other hard and fairly *elastic* material. Preferably, the stylus is made of a flat strip of phosphor bronze . . . . at its free end, the stylus is reduced to a point, and is curved upwardly." In U. S. patent No. 564,586 the same description of the stylus 29 is given (p. 3, lines 4-13).

Unquestionably, claims 31 and 32 of the patent in suit would be infringed by the stylus *s* and the stylus 29 of the claims 2b and 4b above quoted from German patent 45048. Hence, the same invention is protected by the two patents and the patent in suit expired with the German patent.

Claims 6 and 8 of the patent in suit, discussed *supra* under Point Three (p. 87), also cover the stylus 29 of the German patent No. 45,048, as will be seen from the positive explanation of it given in Berliner's home patent No. 564,586 (p. 5, lines 34-43).

> (*j*). *Claims 5 and 35 of the patent in suit, claim 8 of patent No. 564,586, and claim 9 of*

the prior English patent mentioned, for example, cover the same invention. Claims 5 and 35 could not, therefore, survive the expiration of the three prior foreign patents mentioned.

But with reference to the main contention that claims 5 and 35 of the patent in suit embody the broad invention of the three English, German and French patents mentioned, defendants' expert, Mr. Ensign, compares the three prior foreign patents with the two home patents No. 564,586 and the patent in suit (aff. Ensign, pp. 103-106, fols. 308-318) and in conclusion says (pp. 105-106, fols. 315-318);

> "It is thus perfectly clear that claims 5 and 35 carried from the specification of patent No. 564,586 to the specification of the patent in suit No. 534,543 cover and protect the invention, the identical invention claimed in United States patent No. 564,586, and in the corresponding English, French and German patents mentioned. Claims 8, 9, 10 and 13 of patent No. 564,586 are identical or substantially identical with claims 9, 12, 13 and 14 of the English and French patents, and the preceding method claims of the three patents are so clearly alike in the United States, English and French patents, that it is unnecessary to make any analysis of them, while the corresponding German patent claims the same things and methods according to the German practice Claim 9, for instance, of English patent No. 15,232, of 1887, reads as follows;—
>
> > '9. In a gramophone, the combination of a sound receiving diaphragm or other sonorous body; with a pivoted stylus controlled by a diaphragm, and controlling the same, and a support adapted to carry a phonautographic record sheet or a copy of such record, in solid resisting material, *travelling* in the plane of vibration of the

point of the stylus, substantially as described.'

It is perfectly clear that claim 9 quoted from the English patent is inseparably connected with the invention described in claims 5 and 35 of patent No. 534,543, and that the invention described and claimed in claims 5 and 35 of the patent in suit is inseparably connected with claim 9 of the English patent. They are, indeed, for one and the same invention, made at the same time prior to Berliner's application filed November 7, 1887 in the United States for patent No. 564,586, forming part of one and the same inventive act, differing perhaps in scope, but being for essentially the same invention and including, as Berliner himself states, all the main features of his invention."

So in another of defendants' affidavits the three foreign and the two home patents are compared (aff. Hicks, pp. 91-95, fols. 273-285), and it is pointed out (pp. 91-92, fols. 273-274) that after Berliner in patent No. 564,586 has described the gramophone recording and reproducing machine embodying the main features of his invention he states in the patent (p. 4, lines 83-89) that;—

"It will now be clear that the stylus will be forced positively to follow the undulations of the record, and that the diaphragm vibrating under the stylus will emit the same sounds which produced the original record, which sounds can be distinctly heard at the ear-piece 34."

And then (p. 4, lines 90-93) Berliner, in describing Fig. 10, says;—

"Both the process and the apparatus thus far described may be modified in various ways without departing from the main features of my invention."

In conclusion the affidavit states (aff. Hicks, p. 94, fols. 280-283;—

"Claim 8 of No. 564,586 reads as follows:—

> "8. In a gramophone, the combination of a sound-receiving sonorous body; with a pivoted stylus controlled by and controlling the same, and a support adapted to carry a phonautographic recording-surface, or a copy of such record in solid resisting material, *traveling* in the plane of vibration of the point of the stylus; substantially as described."

Claim 9 of English patent No. 15,232, of 1887, reads as follows;—

> "9. In a gramophone, the combination of a sound receiving diaphragm or other sonorous body; with a pivoted stylus controlled by a diaphragm, and controlling the same, and a support adapted to carry a phonautographic record sheet or a copy of such record, in solid resisting material, *traveling* in the plane of vibration of the point of the stylus, substantially as described."

Claim 35 in suit of patent No. 534,543 reads as follows;—

> "35. In a sound reproducing apparatus consisting of a *traveling* tablet having a sound record formed thereon and a reproducing stylus shaped for engagement with said record and free to be vibrated and propelled by the same, substantially as described."

> "Obviously the combination shown in the last claim, 35, is but a mere modification of the combination shown in the two previous claims above set forth, 8 and 9. And that is what Berliner himself states and what the Circuit Court of Appeals has also held. Claims 5 and 35 of patent No. 534,543, therefore, protect the same invention as English patent No. 15,232, of 1887."

In *Thomson-Houston Co.* v. *Hoosick R. Co.*, 82 Fed. 461, 465-467, Judge Townsend in the Circuit Court had held, as he held in the suits at bar;—

> "Whatever may be the rule as to cases

> where the application for the general patent was filed subsequent to the application for the specific patent I do not think the patentee should be deprived of his broad patent where the application for such patent was made first and was delayed in the patent office through no fault of the inventor."

Judge Wallace, speaking for the Circuit Court of Appeals, said;—

> "*With these conclusions we are unable to agree.* We should concur if we could regard the later patent as the generic one, and the earlier, so far as it relates to the contact device, as *limited* to the structural *improvements* upon that device." . . . .
>
> "'The matter sought to be covered by the second patent is *inseparably involved* in the matter embraced in the former patent, and this, under the authorities renders the second patent void,' *Miller v. Manufacturing Co.*, 151 U. S. 198.
>
> "It is manifest that both patents are intended to, and do, secure to the patentee the *same general inventions* as are comprised in the combination" etc.

Since the hearing of the motions for preliminary injunction, complainants have examined their expert, Mr. Rudolph M. Hunter. In answer to XQ121, Mr. Hunter testified as follows;—

> "I do not understand that the word 'traveling' as used in claims 1, 2, 3, 7, 8 and 13 of the patent 564,586, you refer to, as meaning the *longitudinal* movement of the record tablet or its supports. These words refer to the travel of the surface of the tablet due to its *rotation*."

What Mr. Hunter says is quoted by way of argument only and it obviously is correct. Clearly, therefore, claim 8 of patent No. 564,586, claim 9 of English patent No. 15,232, of 1887, above quoted, and claims 5 and 35 of the patent in suit, cover substantially and essentially the same in-

vention; and so the Circuit Court of Appeals held, when it said that claims 5 and 35 are broader claims for the invention set forth in No. 564,586.

(k). As above shown under subdivision (h) of this point, two patents cannot be secured for separate features of an invention. The invention of claims 5 and 35 in suit is a feature of the invention of patent No. 564,586, or it is not. If it is, then that INVENTION was previously patented by the three foreign patents mentioned and claims 5 and 35 expired with them; if it is not, then the application for patent No. 564,586, filed Nov. 7, 1887, was not an application for the invention of claims 5 and 35 and the new defence of two years prior, public use set forth under sub-division (c) of this point is valid.

The Circuit Court of Appeals has held, as above shown under sub-division (*d*) of this point that the invention of claims 5 and 35 is a feature of the invention claimed in patent No. 564,586 and Berliner has asserted that it is a mere modification, embodying the main features thereof and, therefore, inseparable therefrom. Upon such holding of the Circuit Court of Appeals this point is based, and, in accordance with that holding the claims 5 and 35 in suit expired with the three prior foreign patents mentioned.

(l). The new evidence in the suits at bar proves that Berliner was not the inventor of the invention of claim 5 and 35 as construed by the courts in the prior suit.

In conclusion of this point, it may be well to note here that, as hereinafter shown under point Eight, Berliner was not the inventor of the in-

vention of claims 5 and 35 *as construed by the courts in the prior suit*. The new evidence contained in the suits at bar, especially the Suess-Berliner Canadian patent No. 41,901, proves conclusively that Berliner was not the inventor thereof. Berliner himself so stated in the Canadian patent, in which, as Judge Townsend found, Berliner, as the assignee of Suess, "discloses and broadly claims the invention covered by the claims here in suit" *as the invention of Suess*. In the light of this new evidence a different and more limited construction must be given to claims 5 and 35, if they are to be held valid at all, in which case defendants do not infringe. This explains why it was that in patent No. 564,586 Berliner made no claim covering the modification of his invention shown in Fig. 10 of patent No. 564,586 and did not show Fig. 10 in the three prior foreign patents mentioned. That modification was the invention of Suess, who put it in practical form in the Canadian patent for which Berliner applied as Suess' assignee, claiming the invention as the invention of Suess *in the broadest possible form*,—a form which would cover Fig. 10 above mentioned and every other form (see claim 11 of the Canadian patent, p. 167, fol. 501). It will be understood that the argument of Point Four proceeds upon the assumption, shown by the new evidence to be incorrect, that Berliner was the inventor of the invention of claims 5 and 35 as construed by the Courts in the prior suit without such evidence.

POINT FIVE.

Grouping together the expired prior foreign Berliner patents discussed under Points Two, Three and Four, it is clear that the essence of the invention set forth in the various claims of the patent in suit was previously patented in foreign countries. There is no authority in the statute for holding that Claims 5 and 35 in suit can still survive.

Under sub-division (*m*) of Point One, it was shown that Berliner's basic invention and his and Suess' improvements thereon, shown by the patents in evidence, were patented in foreign countries before the grant of the patent in suit by patents which have all expired. More specifically, under Points Two, Three and Four, it was shown that the subject matter of numerous claims of the patent in suit was previously patented in foreign countries by patents which have all expired. Under such circumstances, it is impossible to derive from § 4887 of the Revised Statutes any tenable ground upon which to hold that the two claims in suit, 5 and 35, can survive the expiration not only of the numerous other claims of the patent in suit which concededly expired, but also the expiration of the very essence of the claims themselves, and the expiration of the various elements which enter into, permeate and underlie the claims. The policy of Congress was clearly defined in the Statute and there is no authority, as the Supreme Court said *in Bate Refrig. Co.* v. *Sulzberger*, 157 U. S. 1, 36, "to change the law by judicial action based upon some supposed policy of Congress."

In the three prior, Berliner, German patents and

in the three prior, Berliner, French patents discussed under Points Two, Three and Four, Berliner described and claimed his basic invention and all his improvements thereon. Nevertheless, the Circuit Court, departing from the clear meaning of the statute, has held that because, in its opinion, claims 5 and 35 cover the basic invention, they can survive not only the expiration of all the other claims of the patent in suit but also the expiration therewith of the term itself of the patent. It has been shown under Point One that claims 5 and 35 are not claims for any basic invention but are claims for improvements merely. But if claims 5 and 35 are claims for the basic invention, how then can they survive the expired, prior, Berliner, English, French and German patents which describe and claim the basic invention? Clearly, therefore, if claims 5 and 35 are claims for improvements merely, as indeed they are, they expired with the expiration of all the other claims for improvements; and if they are claims for the basic invention, they must have expired with the expiration of the prior Berliner foreign patents covering the basic invention.

The Circuit Court, by its decision, has involved the patent law in the endless confusion which the Supreme Court said would be the result of holding that a patent could have a plurality of terms. It is respectfully submitted that if the courts are to weigh the relative importance of the different claims of a patent and are to differentiate the various claims of a patent by holding that some of the claims are basic in their nature and that other of the claims are not basic in their nature, and are to hold, by judicial construction and not upon any provision of the statute, that, by reason of such subtle distinction, § 4887 of the statute does not apply in the one case and does apply in the other

case, the condition of uncertainty and confusion resulting therefrom would be intolerable. On the other hand, if the clear, simple meaning of the statute is applied, the intention of Congress will be carried out and all uncertainty and confusion avoided. And how, and by what rule, it may be asked, is the court to determine which claims are basic and which claims are not basic, when all the claims cover features of one invention? Is each patent to be a law unto itself? Is the question of expiration, under the statute, to be left to judicial discretion and discrimination? Or is the provision of the statute that "*every* patent granted for *an* invention which has been previously patented in a foreign country, shall be so limited as to expire with the foreign patent" to be applied according to its clear and unambiguous meaning and effect?

POINT SIX.

In Canadian patent No. 41,901, of February 11, 1893, to Berliner, assignee of Suess, Berliner asserted that a reproducing stylus, mounted to have a free movement, controlled by the walls of the record-grooves, over the surface of the rotating record tablet, was the invention of Suess. Unless, therefore, claims 5 and 35 of the patent in suit are limited to Berliner's improvements in the details of construction of his reproducer, Suess anticipated Berliner and claims 5 and 35 are invalid.

(a) The Canadian patent is set forth in the records and discussed in defendants' affidavits.

A certified copy of this Canadian patent (p.

155), of the assignment of the *invention* thereof by Suess to Berliner (p. 169) and of the proceedings by Berliner in the Canadian Patent Office to obtain the patent (pp. 169-175) form part of defendants' exhibits. The drawings of the Canadian patent are identical with the drawings of the Berliner-Suess United States patent No. 427,279, and for that reason it has been stipulated (T. case, p. 555; L & C case, p. 541) that the drawings of the Canadian patent need not be reproduced on appeal, but that the drawings of the United States patent No. 427,279 may be used on appeal as the drawings of the Canadian patent, as well as of the United States patent.

This Canadian patent is dealt with in defendants' affidavits (aff. Hicks, p. 88, fols. 262-271; Ensign, p. 101, fols. 303-308; Leeds, p. 119, fols. 356-357). The Court is respectfully referred to the affidavits for a discussion of this important Canadian patent.

> (b) *Judge Townsend correctly found that the Canadian patent "discloses and broadly claims the invention of the claims here in suit," as construed by the Courts in the prior suit; and erred in not further finding, as a result thereof, that unless a limited construction be put upon the said claims, they are invalid.*

Judge Townsend, comparing the specification and claims of the Canadian patent with the specification and claims of the patent in suit, found (T. case, p. 341; L & C case, p. 325) that "*the Canadian patent in terms describes and claims the broad generic invention of Berliner covered by the claims here in suit.*" Unquestionably such finding is correct, upon the construction given to the claims by the Courts in the prior suit. A comparison of the Canadian patent with the patent in suit leaves

no doubt of the correctness of such finding. When we consider that Berliner, as Suess' assignee of the *invention* (p. 169), made and signed the petition upon the application for the Canadian patent (p. 170) and set forth in the petition that Suess had "invented new and useful improvements in gramophones not known or used by others before his invention thereof" and that he, Berliner, "by an assignment bearing date the 13th day of April, 1891, *acquired the right* of obtaining a patent *from Werner Suess* aforesaid for the said invention," and prayed "that a patent may be granted to him as the assignee of the said Werner Suess for the said invention, as set forth in the specification in duplicate relating thereto," it is clear that Judge Townsend erred in not finding that unless claims 5 and 35 of the patent in suit are limited by Berliner's improvements in the details of construction of his reproducer, the said claims 5 and 35 were anticipated by Suess and are, therefore, invalid. After holding that "the Canadian patent in terms describes and claims the broad generic invention of Berliner covered by the claims here in suit," there was logically no escape, upon the evidence before the Court, from the further finding that unless claims 5 and 35 here in suit are to be limited, as above stated, they are invalid because, as Berliner himself states, the subject matter thereof was invented not by him but by Suess.

Judge Townsend, in his opinion, (T. case, pp. 340-341; L & C case, pp. 324-325), said;—

> "The fourth, fifth and sixth defences are founded upon a Canadian patent (No. 41901) to Berliner as assignee of Suess, upon which defendant lays great stress. *This patent discloses and broadly claims the invention covered by the claims here in suit.* It is contended that thereby Berliner admitted that Suess was the inventor of the reproducing apparatus in

suit; that by Berliner's application as assignee of Suess he abandoned the broad claims in suit, and that as the said Canadian patent covered said broad invention and expired in 1899, the patent in suit expired with it.

"The evidence introduced in the original suit showed and the Court found on the Suess Patent 427,279 that Suess was merely an improver of a particular form of swinging arm device and some of the language used in the specifications of this Suess Canadian patent, which, however, was not before the Court in the original suit, seems to indicate that its structure is merely an improvement on the broad Berliner invention, and Berliner himself afterwards applied for and obtained a Canadian patent for the broad invention covered by the claims here in suit.

"*But the Canadian patent in terms describes and claims the broad generic invention of Berliner covered by the claims here in suit, as will be seen from the following claims:*

> '5. In an apparatus for reproducing sounds from a record tablet, the combination with a reproducer mechanism consisting of a sound conveying tube and a diaphragm and stylus mounted at one end of the tube; of a freely swinging supporting frame for the said reproducer mechanism, substantially as described.
>
> '7. In an apparatus for reproducing sounds from a record tablet, the combination with a reproducer mechanism consisting of a sound conveyer, and a diaphragm and stylus mounted at one end thereof; of a supporting frame for the said reproducer, loosely pivoted to swing freely both laterally and vertically, substantially as described.
>
> '11. *In an apparatus for reproducing sounds from a rotating record-tablet, a reproducing stylus mounted to have a free movement over the surface of the record tablet, substantially as described.*'

> "I think, therefore, that if this patent expired as claimed in 1899 the patent in suit expired at the same time, upon the authority of the decisions cited above."

(*c*). *The new evidence in the suits at bar proves that the features of the gramophone here in controversy were the invention of Suess and in no particular the invention of Berliner.*

In the original suit between these complainants and the American Graphophone Company *neither* the Canadian patent *nor* Berliner's basic United States patent No. 372,786, of November 8, 1887, *nor* Berliner's first patent of improvement thereon, No. 382,790, of May 15, 1888, were in evidence. Suess, in his United States patent No. 427,279, taken out by Berliner as the assignee of Suess, stated (p. 1, lines 8-14) that his invention was an improvement

> "in the reproducing apparatus adapted for use in the method of recording and reproducing sounds set forth in Letters-Patent No. 372,786, of November 8, 1887, and No. 382,790, of May 15, 1888, both granted to Emile Berliner."

Substantially the same statement is made in the Canadian patent (p. 157, fols. 470-471). A comparison of the Canadian patent with the Berliner-Suess United States patent No. 427,279, shows that the descriptions of the two patents are substantially identical and that the drawings of the two patents are identical; but *the claims are radically different*. Comparing the gramophone of Berliner's early patents No. 372,786 and No. 382,790 with the gramophone of the Suess Canadian and United States patents, it is clear that the features of the gramophone here in controversy were entirely the

invention of Suess, and in no particular the invention of Berliner. Suess improved upon and departed radically from Berliner's broad invention of his basic patent No. 372,786. Suess' improvements only are here in controversy. As a mere inspection of the patents referred to will show this, no detailed argument is necessary to prove it.

> (*d*). *In the prior suit, complainants, in order to distinguish the Berliner-Suess home patent relied upon the absence of claims therein broadly covering the pivoted swinging arm and the stylus point adapted to be vibrated and propelled by the record-groove. The Berliner-Suess Canadian patent contains such broad claims and covers the invention of claims 5 and 35 in suit, as construed by the courts in the prior suit.*

In the original suit between these complainants and the American Graphophone Company, the Berliner-Suess United States patent No. 427,279 was in evidence and in order to avoid the effect of the disclosure of said patent, counsel for these complainants, on examination of his expert, Mr. Hunter, brought out the fact that in the Berliner-Suess United States patent there were no "claims broadly covering the pivoted swinging arm construction and talking machine in which the stylus point is adapted to be vibrated and propelled by the record-groove." Referring to page 100 of the record on appeal in the original suit, the following question was put to Mr. Hunter and the following answer was given by him thereto;—

> "Q. 13. Referring to Defendant's Exhibit, Suess Patent, kindly state whether you find therein any claims broadly covering *the pivoted swinging arm construction* and talking machine in which the stylus point is adapted to

be *vibrated* and *propelled* by the record groove?

A. There is no claim in the Suess patent broad enough to cover the construction mentioned in the question, nor any other means for securing generically the method of vibrating the stylus, and causing it to be fed across the record."

This however, is not the case with the Berliner-Suess Canadian patent, since as Judge Townsend says in his opinion, the Canadian patent "discloses and broadly claims the invention covered by the claims here in suit," and, "the Canadian patent in terms describes and claims the broad generic invention of Berliner covered by the claims here in suit, as will be seen from the following claims."

(c). *In the prior suit, because of the absence of the evidence contained in the records of the suits at bar, the courts were not apprised of the radical departure of Suess' improvements from Berliner's early gramophone and were not informed that defendants' machines, as to the features in controversy, embody only Suess' improvements.*

Because the Berliner-Suess United States patent contained no claims "broadly covering the pivoted swinging arm construction and talking machine in which the stylus point is adapted to be vibrated and propelled by the record-groove," as above pointed out by complainants expert in the original suit, and because Berliner's early United States patents were not in evidence, and because the Berliner-Suess Canadian patent now before the court was not in evidence, it is clear that neither Judge Hazel in the court below nor the Circuit Court of Appeals on appeal had any means of determining how far Suess had departed from Berliner in the improvements which he made and described in the two patents which he assigned to Berliner and

which Berliner applied for and took out, namely, United States patent No. 427,279 and Canadian patent No. 41901. A comparison of Suess' gramophone with the gramophone of the two early Berliner patents mentioned shows that a reproducing stylus mounted to have a free movement over the surface of the rotating record tablet and the movement of the stylus, under the control of the walls of the record-groove, across the face of the disc without any positive feeding mechanism was broadly and entirely the invention of Suess. Complainants' exhibits of defendant's machines are, in all their features, like Suess' gramophone shown in his Canadian and United States patents and broadly covered by the claims on Berliner's application in the Canadian patent.

> *(f). The claims of the Berliner-Suess Canadian patent prove that the movement of the stylus across the face of the record by means of the pressure exerted upon the stylus by the walls of the record-groove was the invention of Suess. This explains why that invention was never previously or subsequently claimed by Berliner and necessitates a limited construction of claims 5 and 35 in suit.*

The mere reading and inspection of the specification and broad claims the Canadian patent also shows at once that *the broad idea of moving the stylus across the face of the disc by means of the pressure exerted by the walls of the record-groove and without any other positive mechanism was the invention of Suess.* The attention of the court is directed especially to claims 11, 12 and 13 (p. 167) of the Canadian patent, and a comparison of those claims shows that claim 11 is so broad as to make it impossible to contend that Berliner invented the free movement of the reproducing stylus across

the face of the record. That invention, covered in its broadest possible form in claim 11 of the Canadian patent, Berliner asserted belonged to Suess. Berliner made this assertion and admission before he filed the application for the patent in suit and before he ever made any claim therefor in any patent or application. It is because the invention belonged to Suess and not to Berliner that Berliner made no claim therefor in his application filed November 7, 1887 for patent No. 564,586, and did not show the construction of Fig. 10 of that patent in his corresponding early foreign patents discussed, *supra*, under Point Four. It is because the invention belonged to Suess that in the patent in suit he does not claim, as shown under Point One, the reproducoing apparatus as a whole as his invention when referring to it at p. 4, line 95. Clearly the reproducing apparatus as a whole is nothing but the gramophone of Suess constructed according to the specification and *claims* of the Canadian patent (see claims 2, 3, 5, 7, 11-13, pp. 165-167). Referring to figure 3 of the patent in suit showing the reproducing apparatus as a whole, it is clear that it is entirely Suess' invention, except the special construction of the reproducing diaphragm and stylus or reproducer illustrated in figures 6 and 7. That unquestionably was Berliner's invention and claims 5 and 35 when properly construed must be limited by a stylus vibrating and constructed as shown in figures 6 and 7 and as described in the specification at p. 5, lines 34-102.

(g). Had the new evidence in the suits at bar been before the courts in the prior suit, the limitations of the invention of claims 5 and 35 in suit would have been clearly understood and stated.

If Judge Hazel had had before him Berliner's early patents Nos. 372,786 and 382,790, upon which Berliner and Suess in United States patent, No. 427,279, said the Suess invention was an improvement, Judge Hazel would have understood how radical was the departure made by Suess from Berliner's apparatus. If Judge Hazel had had before him the Berliner-Suess Canadian patent, he would have understood that when Berliner and Suess in his United States patent, No. 427,279, stated (p. 2, line 32), "that the construction of the *stylus* and the mounting therefor form no part of the present invention and are, therefore, not specifically described herein," all that they meant was that the reproducing diaphragm and stylus or *reproducer* such as that shown in figures 6 and 7 of the patent in suit formed no part of that invention but that *the mounting of the reproducer in such manner that the stylus could have a free movement across the face of the rotating disc by reason of the control over the stylus by the walls of the record groove and without any positive feeding mechanism was the invention of Suess and not the invention of Berliner*, as Berliner and Suess stated and as Berliner admitted in the Canadian application and the Canadian patent. Hence, Judge Hazel, had he had before him the early Berliner United States patents and the Suess-Berliner Canadian patent with its broad claims, would have held and must have held that Suess anticipated Berliner and that claims 5 and 35 of the patent in suit could be held valid, only upon an interpretation limiting them by the special form of reproducer shown in figures 6 and 7 of the patent in suit.

(*h*). *It is not reasonable to hold that what Berliner claimed in Canada as the invention of Suess, he subsequently claimed in the United*

States, by the claims in suit, as his own invention. Claims 5 and 35 must, therefore, be limited, and, when limited, they are not infringed by defendants.

It is a proposition which admits of no dispute that the construction which the Court should give to claims 5 and 35 of the patent in suit should not be *inconsistent* with the construction which the Court should give to the Berliner-Suess Canadian patent, because the language of claims 5 and 35 and of the Canadian patent is the language of Berliner. There can be no question about the proper interpretation and construction of the claims of the Canadian patent. Those claims broadly cover defendants' machines. It is impossible reasonably to hold that claims 5 and 35 in suit have exactly the same meaning and the same breadth and scope as the claims of the Canadian patent and likewise cover defendants' machines. Claim 11 of the Canadian patent for "a reproducing stylus mounted to have a free movement over the surface of the record tablet, substantially as described" "in an apparatus for reproducing sounds from a *rotating* record-tablet" (p. 167), is so broad that no claim could be broader. The other claims of the Canadian patent, while not so broad as claim 11, show that defendants' machines are constructed according to the invention of Suess and the evidence shows clearly that Suess and not Berliner invented such machines. The gramophone shown as a whole in Fig. 3 of the patent in suit is, unquestionably, as a whole, Suess' gramophone. From claim 11 of the Canadian patent we learn, on the authority of Berliner himself, that the free movement of the reproducing-stylus over the surface of the rotating record-tablet, substantially as described, was the invention of Suess, who, as he tells us in

the specification of the Canadian patent (p. 158, fol. 474), relied upon the "*control of the stylus by the walls of the record-groove for the movement of the stylus across the face of the disc, there being no positive feeding mechanism for thus moving the stylus.*"

In view of the claims of the Canadian patent and especially claim 11, it is not possible to hold that claims 5 and 35 in suit can cover a reproducing-stylus mounted to have a free movement over the surface of the rotating record-tablet by reason of the control of the stylus by the walls of the record-groove, and without any positive feeding mechanism for thus moving the stylus. Since Judge Townsend has found, and found correctly, that the Canadian patent "discloses and broadly claims the invention covered by the claims here in suit," as construed by the courts in the prior suit, it necessarily follows that, in the light of the new evidence of the Canadian patent, a new construction must be given to claims 5 and 35 here in suit. It is unreasonable to hold that what Berliner claimed in Canada as the invention of Suess, he subsequently claimed in the United States as his own invention. The court must, therefore, examine the specification of the patent in suit for the proper interpretation and construction of claims 5 and 35. As above shown, under Point One, Berliner states in the patent in suit that "*one feature*" of his invention relates to improvements in recording, while the "*other features*" of his invention have reference to the construction of the details of both the recorder and the reproducer of the gramophone. There are no other features to his invention, if his statement of his invention is to be taken as the guide. It is clear, therefore, that unless the improvements in the reproducer described and claimed in the patent in suit are to be

read into claims 5 and 35, those claims are invalid as claiming something which Judge Townsend has correctly found Berliner previously claimed to be the invention of Suess. But under such limited construction of claims 5 and 35, necessary for their validity, defendants do not infringe, since the reproducer or reproducing diaphragm and stylus of defendants' machines has none of the elements constituting the improvements in the reproducer described and claimed in the patent in suit.

(*i*). *Defendants use the reproducer of Suess' gramophone, shown in the Canadian patent, which reproducer has none of the features of the invention of the patent in suit. Defendants' machines embody the invention of Suess only.*

Before Berliner made his application on March 30, 1892, for the patent in suit, in order to cover, among other things, the improvements in the details of construction of his reproducer or reproducing diaphragm and stylus, other forms of reproducers were known and used and had been described by Berliner in previous letters patent granted to him in the United States and foreign countries. *An inspection of figure 1 of the Suess Canadian patent* (stipulated to be the same as Fig. 1, of U. S. patent 427,279) *shows that Suess did not use the reproducer or reproducing diaphragm and stylus of the patent in suit shown in figures 6 and 7 thereof.* Suess used another form of reproducer somewhat similar, for instance, to that shown in figure 2 of Berliner's prior expired, basic patent in the United States, No. 372,786. *The combination of such a reproducer with means for mounting the same so that the reproducing stylus might have a free movement over the surface of the rotating record tablet was,*

therefore, the invention of Suess and not the invention of Berliner. This fact is established by claim 11, and by other claims (2, 3, 5, 7, 12, 13) of the Suess Canadian patent. It appears from an inspection of complainants' exhibits of defendants' machines that they embody the said invention of Suess. In view of the Suess Canadian patent, all that claims 5 and 35 of the patent in suit can possibly be held to include is a reproducer vibrating and constructed as shown in figures 6 and 7 of the patent in suit. Obviously, the reproducers employed on the machines constituting complainants' exhibits of defendants' machines are totally unlike the reproducers of the patent in suit. *Defendants' reproducers are like the reproducer shown in the Suess Canadian patent which has none of the features constituting the improvements in the details of the construction of the reproducer of the patent in suit.*

> (*j*). *The same patent solicitor, acting for Berliner, made the application for the Berliner-Suess Canadian patent and the application for the patent in suit. It is not reasonable to hold that he first claimed the invention for Suess in Canada and then claimed the same invention for Berliner in the United States.*

It is also significant that Joseph Lyons, who acted as solicitor for Berliner in obtaining his United States patent, also acted as solicitor for Berliner in obtaining the Canadian patent as assignee of Suess. The Court now having before it Berliner's early United States patents upon which Suess' gramophone was an improvement and being able, therefore, to see that Suess made a radical departure from Berliner's early gramophone, and it appearing from the Suess Canadian patent that

Berliner himself asserted that the free movement of a reproducing stylus across the face of the rotating disc by reason of the pressure exerted by the walls of the record and without any feeding mechanism was broadly the invention of Suess, how is it possible to construe claims 5 and 35 so as to cover complainants' exhibits of defendant's machines which are like the Suess apparatus of the Canadian patent, including the reproducer or sound-box thereof, and which do not include any of the improvements of Berliner in the details of construction of his reproducer, which improvements are shown in figures 6 and 7 of the patent in suit.

That Suess was the inventor of machines such as complainants' exhibits of defendants' machines will still more clearly appear from a consideration of the defense of abandonment which constitutes the next defense interposed.

> (*k*). *Berliner's Canadian patent No. 55,079, identical with the patent in suit, was applied for and issued after the issue of the Berliner-Suess Canadian patent; hence, the Canadian patent office, as well as Berliner, considered that claims 5 and 35 did not cover the broad invention of the earlier Berliner-Suess Canadian patent, but were limited as above stated.*

Complainants, in rebuttal, put in evidence a copy of a Canadian patent, No. 55,079, issued to Berliner Feb. 24, 1897, on an application filed December 7, 1895 (T. case, pp. 330-333; L. & C. case, pp. 314-317). This Canadian patent is identical with the patent in suit (T. case, p. 333; L. & C. case, p. 317). It was applied for more than two years after the issue of the Berliner-Suess Canadian patent on Feb. 11, 1893. The fact that Berliner applied for and obtained Canadian patent

No. 55079 after the issue of No. 41,901 shows that neither Berliner nor the Canadian patent office thought that the invention of claims 5 and 35 in suit had been disclosed or claimed in the earlier patent No. 41,901 issued, Feb. 11, 1893, to Berliner, assignee of Suess. Since the patent in suit and Canadian patent No. 55,079 are identical and are both later than the Suess Canadian patent, how is it possible reasonably to construe claims 5 and 35 of the two identical Berliner patents to cover exactly what was described, claimed and patented in the earlier patent as the invention of Suess? Clearly claims 5 and 35 must be limited as above stated; to hold otherwise, is to nullify the clear intent and meaning of the Canadian patent office and of Berliner and to give to claims 5 and 35 a breadth and scope to which clearly they are not entitled.

POINT SEVEN.

Unless claims 5 and 35 of the patent in suit are limited by Berliner's improvements in the details of construction of his reproducer, abandonment of the invention by Berliner is clearly proved.

(a) The Berliner-Suess Canadian patent is incontrovertible proof of abandonment by Berliner.

The incontrovertible proof of abandonment is Berliner's application in Canada upon an assignment from Suess of the right to secure a patent broadly containing claims covering a reproducer and stylus mounted to have a free movement across the face of the rotating record tablet by reason of the pressure exerted by the walls of the

record and without any positive feeding mechanism. If Berliner prior to the date of the Canadian application had any claim or basis of claim to the invention, he clearly abandoned the invention and any claim that he might have had therefor when, as the assignee of Suess, he made his application in Canada for a patent containing the broadest possible claims therefor.

> (*b*) *Berliner, having elected to claim the invention in Canada as the invention of Suess, became estopped, under the authorities, from subsequently claiming the invention as his own.*

When Berliner made the Canadian application as the assignee of Suess, he was in a position where he could not keep silent and thereafter claim the invention, which, as he then asserted, belonged to Suess. "A party cannot occupy inconsistent positions; and where one has an election between several inconsistent courses of action, he will be confined to that which he first adopts. Any decisive act of the party done with a knowledge of his rights and of the fact, determines his election and works an estoppel"; Bigelow on Estoppel, p. 578 (ed. of 1872); Smith's Leading Cases, vol. 2, p. 735 (Am. ed. 1873).

In *Consolidated Fruit Jar Co.* v. *Wright*, 94 U. S., 92, the Supreme Court held that Mason at the time of his application for the patent there in question, had abandoned his invention to the public. The public was in possession of the invention in question from sources entirely independent of Mason before Mason applied for his patent, that is to say, Mason having made his invention and having communicated it to others, the public had thereby come into possession of the invention. Such action on Mason's part was held to constitute an abandonment. On the question of estoppel, the Supreme Court said (p. 96):—

"He who is silent when he should speak must be silent when he would speak if he cannot do so without a violation of law and injustice to others."

"The supineness of the patentee is unexplained and inexcusable. *A principal akin to equitable estoppel applies.*"

By reason of Berliner's applications in the United States and Canada as the assignee of Suess, and especially by reason of the broad claims of the Canadian patent, Berliner asserted, *and the assertion was in accordance with the truth*, that Suess was the inventor of gramophones such as complainants' exhibits of defendants' machines. This, it is confidently asserted is more than mere abandonment; it is a concession and admission that Berliner himself had no right to claim the invention.

(c). *Other evidence in the records, taken with the Berliner-Suess Canadian patent, further proves abandonment by Berliner. Berliner never claimed in any patent the special features shown in Figure 10 of patent No. 564,586, because they were not his invention.*

In view of the Canadian application by Berliner as the assignee of Suess, however, other facts appearing from the evidence before the court conclusively show that under the rules laid down by the Supreme Court above referred to, abandonment by Berliner is further proven.

When Berliner filed his application on November 7, 1887 in the United States for patent No. 564,586, he made figure 10 a part of the drawings thereof, and at p. 4, lines 90-127 he described the movement of the truck 55 and stylus 29 across the face of the disc 54. But he made no claim for the special features shown in figure 10 and described in the part of the specification referred to. If such was

his invention, why didn't he claim it? He stated that the modified form of reproducing apparatus shown in Fig. 10 embodied the main features of his invention which main feature he did claim. In his corresponding English, German and French patents he did not show said Fig. 10, but described and claimed all of said main features. Berliner never claimed Fig. 10 in any patent. Judge Hazel, in his opinion (p. 71, fol. 211), says;—

> "As already appears, the patent in suit was issued upon a later application than patent No. 564,586. Why the broad claims of the former were not made a part of the earlier application and specification does not appear."

Judge Hazel did not have before him, nor did the Circuit Court of Appeals have before it, the Suess Canadian patent. The Suess Canadian patent and the other evidence now before the court show clearly why Berliner made no specific claim in his application filed November 7, 1887, for the construction shown in figure 10 thereof. It was not his invention. Thus it appears that although Berliner illustrated and described the *construction of figure 10* referred to, *he never claimed it*, either in the application filed November 7, 1887 or in any other application and before filing his application for the patent in suit on March 30, 1892, he expressly admitted in the Canadian application filed May 5, 1891, (p. 169, fol. 507), that the broad invention and the invention limited by *all the details* which go to make up complainants' exhibits of defendant's machines belonged to Suess.

> *(d) In the Electrical World for November 12, 1887, more than four years before the application for the patent in suit was filed, Berliner published a description of the special features of the apparatus shown in Figure 10*

of patent No. 564,586. After that date Berliner never again described or referred to such impractical apparatus.

As a further evidence of Berliner's intention not to claim and to abandon all claim on his part, if he had any, to such invention, the article published in the Electrical World of November 12, 1887, offered in evidence, should next be considered. A copy of that article forms one of defendants' exhibits (pp. 243-244). That article Berliner testifies was prepared by him (p. 230, fol. 690). In that article Berliner described various means for making audible and enlarging the vibrations of the reproducing stylus (p. 244, bottom of 1st column). He then said (p. 244, top of 2nd column);—

> "This suggests the plan of mounting a reproducing diaphragm and stylus on a carriage moving on rails, and permitting the point of the stylus not only to vibrate, but also to push the carriage across the revolving disc, and thereby follow the volute of the sound record."

Berliner does not say that the suggestion belonged to him. The suggestion is the same as that shown in figure 10 of patent No. 564,586 above referred to. The publication in the Electrical World, however, was held by Judge Hazel to be too *indefinite*. In his opinion, with which the Circuit Court of Appeals agreed, Judge Hazel said (p. 72);—

> "The publication in the 'Electrical World' is not entitled to the probative weight claimed by the defendant. The rule is that the prior publication, in order to anticipate, must fully and clearly describe the invention so as to enable the skilled in the art to completely understand it and reproduce the apparatus without assistance from the patentee. Badische Ainlin & Soda Fabrik v. Kalls, 94 Fed., 163: Cohn v.

Corset Co., 93 U. S. 366. *The prior publication, based upon the article mentioned, is not within the rule stated.*"

Thus, in the application filed November 7, 1887, and in the Electrical World for November 12, 1887, Berliner described a carriage on wheels. The description in the Electrical World Judge Hazel held to be clearly *insufficient* to enable any one skilled in the art to construct an apparatus for the reproduction of sound. After the publication of the article in the Electrical World for November 12, 1887, no one ever heard a further suggestion for a reproducing apparatus consisting of a carriage on wheels.

> (c) *In his lecture before the Franklin Institute on May 16, 1888, Berliner acknowledged that the freely swinging, pivoted arm adapted, with the aid of the record-groove, to guide the reproducing stylus across the face of the record, was the very ingenious adaptation of Suess.*

When Berliner gave his lecture before the Franklin Institute on May 16, 1888 (pp. 245-273) he distinctly stated that Suess was the inventor of the only practical method of moving the reproducing stylus across the face of the disc by means of the walls of the record groove and without any feed mechanism.

In that lecture Berliner said (p. 270, fols. 808-809);

> "In the description of Nov. 12, 1887, I *advanced the idea* of mounting the sounder on a carriage and rails, and have the record-groove itself be the screw which was to guide the point of the stylus across the disk from periphery to center. This has been improved upon by Mr. Werner Suess, the gentleman here with me to-night and who is the mechanician of our little

shop in Washington. He suggested to mount the sounder on a pivot at some distance from the disk and then let the reproducing groove guide the sounder across the disc over an arc of flat amplitude. This happy idea *is embodied* in the present apparatus, and *is a very ingenious adaptation indeed.*"

(*f*) *In the Electrical World for August 18, 1888, nearly four years before the application for the patent in suit was filed, Berliner published a complete description of the perfected gramophone, with a perfect illustration thereof, embodying the invention of Suess, which invention included all the features of the defendants' machines and all the features shown and claimed in the Berliner-Suess Canadian patent. Still Berliner made no claim in any patent for such features.*

When next we hear from Berliner with reference to his gramophone, in the Electrical World for August 18, 1888, Berliner falsely puts himself before the public as the inventor of a gramophone including the Suess invention. A copy of the article on Berliner's gramophone appearing in the Electrical World for August 18, 1888, containing an illustration of what Berliner called his gramophone is one of defendants' exhibits (p. 274). *This article in the Electrical World for August 18, 1888, was not in evidence in the suit before Judge Hazel.* A comparison of the gramophone illustrated in the Electrical World for August 18, 1888, with the gramophone shown in the drawings, and covered by the *claims*, of the Suess Canadian application shows that the gramophone illustrated in the article in the Electrical World for August 18, 1888, is *Suess' gramophone.* Berliner's statement made on May 16, 1888, in the lecture before the Franklin Institute is conclusive proof of the fact,

and, of course, the fact that Berliner made the Canadian application as the assignee of Suess is the incontrovertible proof of the fact. Defendants' expert, Mr. Leeds, says (p. 119, fol. 356):—

> "The improved Berliner gramophone illustrated in the Electrical World of August 18, 1888, is obviously the gramophone of Werner Suess, and is substantially identical with the gramophone illustrated in the said Canadian patent and in the corresponding United States patent No. 427,279 to Berliner as the assignee of Suess."

The article in the Electrical World for August 18, 1888, published broadcast and was intended to publish broadcast knowledge of the gramophone there shown. This was nearly four years before Berliner made his application for the patent in suit. If Berliner had up to that time ever thought of making claims which would cover the form of the gramophone there shown embodying Suess' improvements, it is inconceivable that he would have had the article in the Electrical World for August 18, 1888, published and have waited four years nearly before making any claim thereto in any patent and before filing his application for the patent in suit.

> *(g) In Berliner-Suess United States patent No. 427,279, issued May 6, 1890, on an application filed August 6, 1889, nearly three years before the application for the patent in suit was filed, Berliner published a full description and illustration of the perfected gramophone shown in the Electrical World for August 18, 1888, and still made no claim that the features thereof here in controversy were his invention.*

Next, Berliner as the Assignee of Suess, applied, in the United States, on August 6, 1889, for Suess' improvements on the Berliner gramophone

of Berliner's early patent No. 372,786, of November 8, 1887, and No. 382,790, of May 15, 1888, and obtained patent No. 427,279, of May 6, 1890, which sets forth in figure 1 the Suess gramophone shown in the article in the Electrical World for August 18, 1888. Why the claims of the United States patent were limited by a counterweight and a system of links does not appear, but it is probable, as shown in defendants' affidavits (aff. Hicks, p. 89-90, fols. 267-268) that there was a prior application made by Berliner or Suess which was abandoned before the application for the patent which was issued, No. 427,279, was made. However, from patent No. 427,279 the gramophone such as complainants' exhibits of defendant's machines was again published to the world and still no claim for the invention thereof had been made by Berliner.

(b) On May 5, 1891, about a year before the application for the patent in suit was filed, Berliner, as the assignee of Suess, applied for the Berliner-Suess Canadian patent, disclosing and claiming therein as the invention of Suess, all the features of the gramophone here in controversy, as Judge Townsend has found. Still Berliner had made no claim in any patent that he was the inventor of such features.

On May 5, 1891, as appears from the certified copy of the petition of Berliner, Berliner filed an application for the Canadian patent for Suess' invention and made the broad claims therefor, all heretofore referred to. This was nearly four years subsequent to the making of his application on November 7, 1887, and about a year prior to his making the application for the patent in suit. The claims of the Canadian patent

are a climax to the other facts showing that the invention belonged to Suess and that if Berliner had any claim whatever to the invention, he had irrevocably abandoned it and had taken a position so inconsistent with any claim on his part for the invention that he could not thereafter be heard to claim it.

> *(i) When, on March 30, 1892, Berliner filed the application for the patent in suit, he had irrevocably abandoned any right which he may have had to claim as his invention the features of the gramophone here in controversy.*

When Berliner filed his application for the patent in suit on March 30, 1892, the world was in possession of a gramophone such as that shown in the Suess Canadian patent, and had been in possession thereof since August 18, 1888, at least, when Suess' machine was disclosed to the world in its perfected form in the article in the Electrical World of that date. It is respectfully submitted that in consideration of the facts and circumstances above referred to, no clearer case of abandonment could be made out.

> *(j) The new evidence in the suits at bar conclusively shows that the apparatus shown in Figure 10 of patent No. 564,586 was impracticable, and never went into use. If it was the invention of Berliner, he abandoned it.*

It has been stated above that Berliner never made any claim to the form of apparatus consisting of a carriage on wheels shown in figure 10 of the application filed November 7, 1887, for patent No. 564,586 and described in the Electrical World for November 12, 1887. Defendants' affidavits show that such apparatus never went into use (aff. Leeds, p. 121, fol. 362; aff. Moeller, p.

139

123, fol. 367; aff. Ensign, p. 107, fol. 319, p. 110, fols. 330-332). Berliner himself states that he never had but one model of such an apparatus and that that model is lost (p. 239, fols. 716-717). As early as May 16, 1888, as Berliner says in his lecture before the Franklin Institute, he was using the Suess apparatus, and in the Electrical World for August 18, 1888, the Suess apparatus is shown, and in the Suess United States and Canadian patents it is the Suess apparatus that is shown, and in the patent in suit and in figure 3 thereof it is the Suess apparatus that is shown, and the only part of figure 3 of the patent in suit which Berliner could claim is the special form of the reproducer shown in detail in figures 6 and 7 of the patent in suit. The mere inspection of figure 10 of patent No. 564,586 shows to any one skilled in the art, that such an apparatus is impractical. Berliner knew that it was impractical. If it was his invention he abondoned it. He does not show it or refer to it in the patent in suit, and he never constructed or invented an apparatus that was practical, except those forms of reproducing apparatus which operate by mechanical feed screws. Not till the autumn of 1894, Mr. Berliner testified (p. 240, fol. 719) were talking machines sold, "in which a feed screw for the purpose of propelling the reproducing sound box across the record was dispensed with." This was subsequent to the date of Suess' invention and the machines sold were the Suess machines. Defendants' experts have in their affidavits conclusively shown that the apparatus of figure 10 of patent No. 564,586 applied for November 7, 1887, is impractical. To avoid unnecessary repetition, the court is respectfully referred on this point to the affidavits of Ensign (pp. 106-111, fols. 318-332), Leeds (pp. 119-121, fols. 357-362), Moeller (p. 122, fols. 365-367) and Irish (p. 288, fol. 862).

Among the many reasons given by defendants' experts showing that the apparatus of Fig. 10 of patent No. 564,586 is impractical, the following may be mentioned; the weight of a tube, 33, or of a horn would throw the stylus, 29, out of the record groove; the lateral movements of the stylus would cause the truck, 55, to move laterally and the diaphragm would not vibrate and the sound would not be reproduced; the revolving disc would cause a swaying of the truck and suspended sound-box and the stylus would be forced out of adjustment with the record-groove; the lack of vertical adjustment would either prevent the stylus from reaching down into the record-groove or the bottom of the record-groove would force the stylus up and the truck, 55, would be lifted from the rail, 56, and fall; the revolving disc always rises and falls, the rise or fall increasing toward the circumference, and, because of the lack of vertical adjustment, the stylus would leave the record groove when the disc falls and would be struck by the bottom of the record-groove when the disc rises, throwing the truck off the rail; record-grooves are of different depths and record tablets are of different thicknesses, by reason of which, and because of the lack of vertical adjustment, either the stylus would not reach into the record groove or would be struck by the bottom of the record groove; for this and other reasons enumerated by defendants' experts, the arrangement shown in Fig. 10 is a mere laboratory experiment and not a practical or operative device.

Since the hearing of the motions for preliminary injunction, complainants have examined their expert, Mr. Rudolph M. Hunter. As his testimony consists of opinion or argument, only, it may be permissible to quote his opinion with reference to the importance of the vertical adjustment of the

reproducing stylus which is secured in defendants' machines by Suess' freely swinging, pivoted arm;—

"XQ 104 In your answer to Q3 you say, speaking of the reproducing machine, that:

'The capacity for *vertical adjustment* of the arm enables the stylus to maintain its contact with the groove of the record tablet, notwithstanding considerable possible variation in the level of the tablet during its rotation.'

Do you consider this capacity of importance, and if so, kindly give your reasons.

A I consider it important because if the record tablet should buckle or the turn table should run untrue, as it frequently does, because of the warp nature of the castings, this capacity of *vertical adjustment* enables the stylus to maintain the same relative pressure upon the surface of the record tablet, and all times to maintain the positions properly in the groove. *If there were no vertical adjustment these defects in the record or the turn table would frequently cause the stylus to jump out of the groove; or on the other hand would force the record tablet tightly against the stylus and deface the groove.*

XQ 106 Do you regard the vertical adjustment, then, essential to the successful reproduction of sound and to a commercial machine of the gramophone type?

A I do not consider it essential, but in the ordinary manner of manufacture incident to this class I consider it an exceedingly desirable feature.

XQ 107 *It is essential to the successful reproduction of sound that the reproducing stylus do not leave the record groove?*

A *Yes.*

XQ 108 *And it is also essential for such purpose that the record groove be not forced against the reproducing stylus as described by you in your previous answer?*

A *Yes, as such action would destroy the rec-*

ord. But of course, sound would be reproduced even while the record was being destroyed.

XQ 109 *But not very successfully, would it?*

A *No.*

XQ 126 *And this lack of vertical adjustment you consider a serious disadvantage?*

A *I consider it a very serious disadvantage."*

(k). The freely swinging, pivoted arm with the horn and reproducing diaphragm and stylus mounted thereon are features of the Suess invention, and such features are embodied in defendants' machines. Such a horn could not possibly be used in the apparatus shown in Figure 10 of patent No. 546,586, and for other reasons set forth in the affidavits of defendants' experts, the apparatus shown in said Figure 10 is impracticable.

Suess in his Canadian and United States patents says that "With the view of intensifying the sound emitted by the reproducer, and more especially of directing the same to the listener or listeners, I use a funnel-shaped tube on the contracted end of which the reproducing diaphragm or stylus are mounted, while the open flaring end of the tube is directed to the listener or listeners." This tube or horn is included in the construction of complainants' exhibits of defendants' machines and such a horn could not possibly be used in the apparatus shown in said figure 10, and for the serious reasons stated in the affidavits the apparatus shown in said figure 10 is a laboratory experiment and impractical. The evidence upon this point is *new evidence*. There was no evidence upon the point in the prior suit.

We can easily understand, therefore, why Berliner abandoned completely all claim to any part of

the improvements shown in the Suess gramophone, and why in the Canadian patent he asserted that Suess was entitled to the broad claims therefor.

> *(l) An impracticable apparatus is not, under the authorities, an anticipation of a successful apparatus.*

In *Gordon* v. *Warder*, 150 U. S., 47, 50, the Supreme Court held that although the specification of a prior patent did contain a paragraph stating "that it might be advantageous in some case, to make the binder adjustable in respect to the cutting apparatus, no means were there provided or pointed out whereby such a desirable result could be obtained," and that, therfore, such prior patent could not be considered an anticipation of the patent involved in that suit. So in *Killeen* v. *Buffalo Furnace Co.*, 140 Fed. 33, 36, Judge Hazel said;—

> "The Killeen patent was not anticipated. The patent to Hartman, dated June 27, 1893, No. 500,386, upon which reliance is placed by defendant *has never been put into practical use.* According to the expert witness for complainant, *the Hartman apparatus is wholly impracticable.*"

Referring to Berliner's description in the Electrical World for Nov. 12, 1887, of the apparatus shown in Fig. 10 of the application filed five days before on November 7, 1887, Judge Hazel said;—

> "The publication in the 'Electrical World' is not entitled to the probative weight claimed by the defendant. The rule is that the prior publication, in order to anticipate, must fully and clearly describe the invention so as to enable the skilled in the art to completely understand it and reproduce the apparatus without assistance from the patentee. Badische Ainlin & Soda Fabrik v. Kalls, 94 Fed., 163; Cohn v.

Corset Co., 93 U. S. 366. *The prior publication, based upon the article mentioned, is not within the rule stated.*"

(*m*) *Abandonment of an invention may be evinced by the conduct of the inventor at any time before or after the patent is granted.*

"An abandonment of an invention to the public may be evinced by the conduct of the inventor *at any time*" before or after the patent is granted (Elizabeth v. Pavement Co., 97 U. S., 126, 134; Bell v. Daniels, 1 Bond, 212, 219; Ransom v. Mayor, 1 Fischer, 253, 273; Holmes Electric P. Co. v. Met. B. A. Co. 30 Fed. 254). *Abandonment once made cannot be recalled* (same cases.)

Abandonment is "a question of fact and may be established by the patentee's intention to abandon or by inferences consistent therewith (*Rifle and Cartridge Co.* v. *Arms Co.*, 118 U. S. 22; *Planing Machine Co.* v. *Keith*, 101 U. S. (479)". So said Judge Hazel in the prior suit (p. 72).

POINT EIGHT.

Berliner Patent in suit, No. 534,543, of February 19, 1895, expired February 11, 1899, before this suit was begun, with the expiration of the term of six years for which the prior Berliner-Suess Canadian Patent No. 41,901, of February 11, 1893, was granted.

(*a*). *Judge Townsend found that the Berliner-Suess Canadian patent "discloses and broadly claims the invention covered by the claims here in suit," and "that if this patent expired, as claimed in 1899, the patent in suit expired at the same time." Judge Townsend was in great doubt as to the effect upon the*

patent in suit, of the expiration of the Canadian patent in 1899, but resolved the doubt on this and other points in favor of complainants to permit an appeal to be taken.

Not only does Judge Townsend say in his opinion that this Canadian patent "discloses and broadly claims the invention covered by the claims here in suit" (T. case, p. 340, fol. 1019; L & C case, p. 324, fol. 971), but he also says (T. case, p. 341; L & C case, p. 325);—

> "But the Canadian patent in terms describes and claims the broad generic invention of Berliner covered by the claims here in suit, as will be seen from the following claims:
>
> '5. In an apparatus for reproducing sounds from a record tablet, the combination with a reproducer mechanism consisting of a sound conveying tube and a diaphragm and stylus mounted at one end of the tube; of a freely swinging supporting frame for the said reproducer mechanism, substantially as described.
>
> '7. In an apparatus for reproducing sounds from a record tablet, the combination with a reproducer mechanism consisting of a sound conveyer, and a diaphragm and stylus mounted at one end thereof; of a supporting frame for the said reproducer, loosely pivoted to swing freely both laterally and vertically, substantially as described.
>
> '11. In an apparatus for reproducing sounds from a rotating record-tablet, a reproducing stylus mounted to have a free movement over the surface of the record tablet, substantially as described.'
>
> "I think, therefore, that if this patent expired as claimed in 1899 the patent in suit expired at the same time, upon the authority of the decisions cited above."

As appears from Judge Townsend's opinion, he was, in view of the authorities hereinafter cited, in great doubt as to the effect upon the patent in suit of the expiration of the Canadian patent on February 11, 1899. In order to permit an appeal to be taken and a determination of the questions at the earliest possible moment by the Appellate Court, he said (T. case, pp. 342-343, fols. 1026, 1029; L & C case, pp. 326-327, fols. 978, 981);—

> "I have concluded to resolve the doubt raised on this point in favor of complainant."

Judge Townsend further said (T. case, p. 343; L & C case, p. 327);—

> "I . . . . have reached the conclusion that, *except as to the Sucss Canadian patent* No. 41,901, defendants have failed to introduce any new matter which would, in my judgment, have led the courts to reach a different conclusion if it had been before them in the original suit. But . . . . *if the expiration of the Sucss Canadian patent is a complete defense* . . . . yet I am constrained to grant the injunction in order to permit an appeal and a determination of the questions at the earliest possible moment."

(*b*). *Assuming, as Judge Townsend found, that the Berliner-Sucss Canadian patent "discloses and broadly claims the invention covered by the claims here in suit," the patent in suit expired with the expiration of the six year term for which the Canadian patent was granted, on Feb. 11, 1899.*

Unquestionably the Canadian patent covers "in an apparatus for reproducing sounds from a rotating record tablet, a reproducing stylus mounted to have a free movement over the surface of the record tablet, substantially as described" (see p. 167, claim 11). For the movement of the stylus over

the surface of the rotating record tablet as described, Suess states that he relies upon the "control of the stylus by the walls of the record groove for the movement of the stylus across the face of the disc, there being no positive feeding mechanism for thus moving the stylus" (p. 158, fol. 474). Other claims and other parts of the specification of the Canadian patent likewise show that Suess was the inventor of machines such as complainants' exhibits of defendants' machines, and, therefore, claims 5 and 35 of the patent in suit must be limited by the special form of reproducer illustrated in figures 6 and 7 of the patent in suit, which reproducer has never been used by either defendant (Aff. Irish, p. 287, fols. 861-862; aff. Leeds, p. 296, fol. 886). Should the Court for any reason be of opinion that claims 5 and 35 of the patent in suit are not limited by the special form of reproducer shown in figures 6 and 7, and that notwithstanding the Canadian patent claims 5 and 35 are broad enough to cover complainants' exhibits of defendants' machines, in such case it necessarily follows that claims 5 and 35 are for the same invention as that patented by the Canadian patent, since the gramophone of the Canadian patent is the gramophone embodied in complainants' exhibits of defendants' machines. Assuming then that claims 5 and 35 protect the invention of the Canadian patent; since the Canadian patent was a prior patent to Berliner, it follows that the patent in suit expired on February 11, 1899, with the expiration of the term of six years for which the Canadian patent was granted.

(*c*). *The invention of the Berliner-Suess Canadian patent was, under the Statute and decided cases, patented and caused to be patented by Berliner, the patentee of the patent in suit.*

In order that a United States patent shall, under §4887, be limited by a prior foreign patent, it is not necessary that the foreign patent be taken out by the inventor and patentee of the United States patent, but it is sufficient if he causes the foreign patent for the same invention to be issued.

The language of §4887 is very broad. It reads as follows:—

> "No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, *by reason of its having been first patented or caused to be patented* in a foreign country, unless the same has introduced into public use in the United States for more than two years prior to the application. But every patent granted for *an invention which has been previously patented* in a foreign country shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years."

All that is necessary is that the invention be first patented or caused to be patented in a foreign country by the patentee or inventor of the United States patent. In *Hobbs* v. *Beach*, 180 U. S., 383, 397, the Supreme Court stated that §4887 "evidently means that the patentee shall not be debarred from *his* patent by reason of *his* having first patented or *caused his* invention to be patented in a foreign country." In *Wilcox Co.* v. *Industrial Co.*, 110 Fed. 210, 214, Judge Gray said "We do not think that §4887 of the Revised Statutes applies to a patent taken out by another than the patentee of the patent whose term is sought to be shortened and *without his acquiescence or consent*."

Berliner as assignee of Suess took out the Cana-

dian patent, and if claims 5 and 35 of the patent in suit are broad enough to cover the invention of the Canadian patent, since the Canadian patent is a prior foreign patent to Berliner, the patent in suit expired with the Canadian patent on February 11, 1899.

> (*d*) *Under the patent act of Canada, a Canadian patent "expires," within the meaning of §4887 of the Revised Statutes, at the expiration of the term for which the fee to the Government has been paid, unless a further fee for a "further term" is paid. The patent does not lapse and is not forfeited, but its term expires.*

The material parts of the patent Act of Canada is one of defendants' exhibits (pp. 181-188, fols. 542-562).

According to § 22 of the Patent Act of Canada (p. 184) and of § 39 thereof (p. 187), the applicant has the option of paying the fee for eighteen, twelve or six years. The term of the Canadian patent cannot exceed eighteen years (§ 22 p. 184). In other words, eighteen years is the *limit* of the duration of *any term* of a Canadian patent, but at the option of the applicant the patent may be issued for a shorter term of six years or of twelve years. Sub-division 2 of § 22 of the Patent Act of Canada provides (p. 185);—

> "2. If a partial fee only is paid, the proportion of the fee shall be *stated in the patent* and the patent shall, *notwithstanding anything therein or in this act contained*, cease at the end of the *term* for which the partial fee has been paid, unless, before the *expiration* of the said *term*, the holder of the patent pays the fee required for the *further term* of six or twelve years."

§ 20 of the same act (p. 550) provides;—

> "20. Every patent granted under this act * * * shall grant to the patentee and his legal representatives, for the *term therein mentioned*, from the granting of the same, the exclusive right" etc.

In accordance with these provisions of the Canadian act, the grant of the Canadian patent contains the following provision (p. 156, fol. 467);—

> "The partial fee required for the *term* of six years having been paid to the Commissioner of Patents, this Patent shall cease at the end of six years from date, unless at, or before the *expiration* of the said *term*, the holder thereof pay the fee required for the *further term* or *terms* as provided by law."

The certificate of the Canadian Patent Office states (p. 169, fol. 507);—

> "that the said patent *expired* upon the 11th day of February, 1899, by reason of the non-payment of the fee for the second *term* of six years."

The grant (p. 156) of the Berliner-Suess Canadian patent "for the period of eighteen years from the date of these presents . . . . provided, that *the grant hereby made is subject to the conditions contained in the acts aforesaid*," means, as stated in the act, that "the patent shall, *notwithstanding anything therein or in this act contained*, cease at the end of the *term* for which the partial fee has been paid, unless before the *expiration* of the said *term*, the holder of the patent pays the fee required for the *further term* of six or twelve years." Clearly the Canadian patent *expired*, under these provisions at the "*expiration of the said term*", *six years*, for which alone it was granted at the *time of its issue*. Not having been prolonged, renewed or extended, it never had any other term.

Eighteen years was the limit of time to which it might have been prolonged, but no *further term*, beyond the original term of six years, having been obtained, the patent had but one term of six years and "*expired*" at the "*expiration of the said term.*"

Thus the provisions of the Canadian Patent Act clearly show that a patent may be issued for the term of six years, for the term of twelve years, or for the term of eighteen years, and that in case of a patent issued for the term of six years, the patent will expire by the "*expiration of the said term,*" unless a further fee is paid for a "*further term.*" There is *no obligation* to pay the further fee for the further term and there is *no forfeiture or lapse* of the patent if the further fee for the further term is not paid. If the further fee for the further term is not paid, the granted term "*expires*" and the patent, in the language of the Act, will "cease at the end of the *term* for which the partial fee has been paid, unless before the *expiration* of the said *term* the holder of the patent pays the fee required for the further term of six or twelve years." The certificate above quoted says "the said patent *expired.*" For the lapsing and forfeiture of patents through the non-performance of a condition subsequent or the like, the Canadian Patent Act makes special provision under the separate head of "Forfeiture of Patents" (§ 37, pp. 186-187).

(*c*) *Judge Townsend erred in holding that the legal term of the Canadian patent did not expire but lapsed or became forfeited in 1899. The Bonsack case, cited by Judge Townsend in support of his ruling is directly opposed thereto, and the Welsbach case, cited by him in support of his ruling, in no way involved the question at issue.*

Judge Townsend correctly stated the rule of law

when he said (T. case, p. 342; L & C case, p. 326);—

> "The rule in such cases as I understand it is that the duration of the United States patent is limited by the duration of the legal term of the foreign patent and that it is not limited by any *lapse* or *forfeiture* of any portion of said term by means of any *condition subsequent*.
>
> "*Pohl* vs. *Brewing Co.*, 134 U. S., 386.
>
> "In *Bate Refrig. Co.* vs. *Sulzberger*, 157 U. S., 1, the Supreme Court says as follows:
>
> "'But the American patent will be granted upon the condition that, if you obtain the foreign patent first, your invention shall be free to the American people whenever, by reason of the *expiration of the foreign patent*, it becomes free to the people abroad.'"

He erred, however, in considering that the legal term of the Canadian patent did not *expire* but *lapsed* or became *forfeited*. Judge Townsend based his ruling upon the decision of Judge Simonton in *Bonsack Machine Co.* v. *Smith*, 70 Fed., 383, and of the Circuit Court of Appeals for the Second Circuit in *Welsbach Light Co.* v. *Apollo Co.*, 96 Fed. 332. It is not surprising that Judge Townsend reached his conclusion as he says, "*with some hesitation* (T. case, p. 342; L & C case, p. 326), because his conclusion is directly contrary to Judge Simonton's decision in the *Bonsack* case, and the question decided in the *Welsbach* case was entirely different from the question here involved, as will be seen from the following statement of the decisions in those two cases.

Before taking up the decisions in the two cases mentioned, attention should be directed to the word "*permitted*" used by the Supreme Court in *Bate Refrig. Co.* v. *Sulzberger*, 157 U. S. 1, 36, just before the part quoted, as above stated, by Judge Townsend. The Court said;—

> "the American patent expired with the for-

eign patent, and thereby the American public became entitled to use the invention from the time the foreign public were *permitted* to use it."

As pointed out by Judge Simonton, in the *Bonsack* case as will presently be shown under subdivision (*f*), an inventor "*permits*" the foreign public to use his invention, when by his voluntary act he does not avail himself of the privilege of prolonging or renewing the term of the foreign patent, but permits the patent to expire through lapse of time at the end of the original term thereof. In the case of a *lapse* or *forfeiture* through *breach of a condition* subsequent, the inventor is *deprived* of his foreign patent and does not, by his voluntary act, *permit* the foreign public to use the invention.

> (*f*) *In the Bonsack case it was squarely held that a Canadian patent for which the fee for a five year term only had been paid and which was not prolonged by payment of a further fee for a further term before the expiration of the original five year term expired with the expiration of the original five year term and did not lapse or become forfeited.*

In *Bonsack Machine Co.* v. *Smith*, 70 Fed. 383, Judge Simonton held that a United States patent expired with the expiration of the five year term of a Canadian patent. At that time, under the Canadian Patent Act, the duration of a Canadian patent could not exceed fifteen years, but the applicant at his option could obtain a patent for the term of five years, or for the term of ten years, or for the term of fifteen years by paying the fee required, and he could, before the expiration of the five year or the ten year term, obtain an extension for another period or term of five years by paying a further fee. That was under § 17 of the Canadian Patent Act which is quoted by Judge Blatchford in *Bate*

v. *Hammond*, 129 U. S., 151,165. Although the duration of the terms was changed at the time the Canadian patent to Berliner was issued from five, ten and fifteen years to six, twelve and eighteen years, nevertheless, the substance of the provisions is identical under each act, and it is clear that in each case if at the end of the first term a further fee is not paid and a further term secured, the patent ceases through the *expiration of the term* and not by forfeiture or lapsing through the non-performance of a condition subsequent. Judge Simonton, in *Bonsack Machine Co.* v. *Smith*, *supra*, held that under the decision of the Supreme Court in *Pohl* v. *Anchor Brewing Co.*, 134 U. S., 381, the word "expire" means "cease to exist because of the termination of the duration of the original grant, and not to mean cease or determine by reason of some penalty or forfeiture for the non-performance of some condition subsequent." Referring to the cases cited by the Supreme Court to show that the words "expiration of term" mean "expiration by lapse of time" (134, U. S. 381), Judge Simonton in the *Bonsack* case also said that "in those cases it was held that the words 'expiration of term' do not mean expiration of term through a forfeiture by breach of a condition, but mean expiration by lapse of time." Accordingly Judge Simonton held that the Canadian patent having been granted for five years and having expired at the end of the five years, and not having been renewed for a further time had expired, not by forfeiture, but by lapse of time, and that in consequence, the United States patent expired with the expiration of the five year term of the prior Canadian patent. There is no case holding the contrary, and Judge Simonton's decision is the last reported decision upon the point so far as defendants' coun-

sel has been able to ascertain. It is impossible to distinguish between the Canadian Act as it existed when Judge Simonton rendered his decision and the Canadian Act as it existed when the patent in suit and the Canadian patent were issued. Although there is a change in the lengths of the terms and a slight change in phrascology, the substance is exactly the same, and in each case at the end of each term there is an expiration of the patent by reason of the expiration of the term and not a forfeiture which is provided for upon different grounds under separate provisions of the acts (pp. 186-187).

In pages 392-395, Judge Simonton exhaustively considers and discusses; first, what is the *term* of a Canadian patent; second, what is the meaning of the word "*expire*" in § 4887 of the Revised Statutes; and, third, when does a Canadian patent, under the Patent Act of Canada, *lapse* or become *forfeited*. Judge Simonton's conclusion was; first, that although a Canadian patent could be *prolonged* for successive terms of five years each, not to exceed in the aggregate fifteen years, yet "*each duration of five years is a term independent*. This clearly appears from the language of the act of 1872, and that of the act of 1883 in *pari materia*" (p. 393); second, that the word, "*expire*", as used in § 4887 of the Revised Statutes, means expiration of the term by *lapse of time* and not through a *breach of a condition*, resulting in a *lapse* or *forfeiture* (p. 392), and he pointed out that in *Bate* v. *Hammond*, 129 U. S., 151, the Canadian patent there in question did not "expire" at the end of the original five year term because the patentee, having exercised "the privilege of renewing and extending the term", the original term of five years was converted into a continuous term of ten years and then of fifteen years,

and the patent could not be said to "expire" until the expiration of the fifteen years (p. 394); and, third, that where, by the law of Canada, a patent is granted for five years and the privilege of renewing and extending the term is not exercised and the five year term expires, such an expiration of the five year term is not, under the law of Canada, a breach of a condition resulting in a lapse or forfeiture, but *an expiration of the granted term*, because the conditions of forfeiture are not incurred as they would have been if a patentee had failed to put his invention into operation within two years or had introduced a patented machine from abroad within twelve months, and because the patentee had never put himself under any obligation by contract or otherwise to pay the additional sum of money or fee as a condition precedent to the exercise, entirely of his own volition and option, of the privilege of renewing and extending the five year term (pp. 394-395). So Judge Simonton concluded that the patentee of the Canadian patent had held his patent five years *"until the term fixed by law had expired by its own limitation"*; that in the *Pohl* case, and this marks the distinction, the prior German patent was forfeited because the patentee failed to fulfill a positive *duty* enjoined upon him by statute or by contract, to wit, the *obligation* to pay the taxes; and that the language of the Supreme Court in *Bate* v. *Sulzberger;*

> "If you have a foreign patent your patent shall cease to protect you, when, by reason of the expiration of the foreign patent your invention becomes free to people abroad"—

applied, since the patentee of the Canadian patent in question—

> "Knowing the condition on which he held his United States patents, he, of his own volition,

allowed the new term to *expire* in 1891, not to *lapse* nor become *forfeited*. By his own act he made his invention free to people abroad. It became free thereupon to the people of this country. He lost the protection of Section 4887."

It is difficult to understand how Judge Townsend could have reached his conclusions in the suits at bar, even "with some hesitation" upon Judge Simonton's decision in the *Bonsack* case. If the decision in the *Bonsack* case was correct, and it will be shown that it accords with all decisions upon the point, the Berliner-Suess Canadian patent *expired* and did *not lapse* or become *forfeited* in 1899, and the patent in suit expired therewith.

> (*g*) *In the Welsbach case the only question involved was whether, where a prior French patent had lapsed before the grant of the home patent, but after the filing of the application therefor, the home patent was invalid upon the ground of abandonment or other ground arising out of those facts only. The question whether the prior French patent had lapsed or had expired was not involved, for, concededly, it had lapsed.*

In *Welsbash Light Co.* v. *Apollo Co.*, 96 Fed., 332, in which defendants' counsel in the suits at bar filed a brief upon the question involved on behalf of the *Rex Incandescent Light Company*, the question, and the *only* question, was whether, where a prior French patent had lapsed *before* the *grant* of the home patent, but *after* the filing of the *application* therefor, the home patent was invalid under the authority of *Huber* v. *Nelson Mfg. Co.*, 148 U. S., 270. An examination of the briefs of Messrs. Choate, Bennett and Wetmore, filed in the Circuit Court of Appeals, shows that the argument

proceeded principally upon the question whether the decision of the Supreme Court in the *Huber* case rested upon *abandonment* or whether that decision was broad enough to make invalid any home patent granted after the lapse of a prior foreign patent, although the application for the home patent had been filed before the prior foreign patent had lapsed. The Circuit Court of Appeals held that the *Huber* case rested upon abandonment and that the home patent having been *applied for* before the lapse of the prior foreign patent, abandonment was not shown.

Clearly in the Welsbach case, upon which Judge Townsend also relied, *the question here presented was not involved.* The question here is whether the Canadian patent *expired* in 1899, which was four years after the grant of the patent in suit, or whether the Canadian patent *lapsed* or became *forfeited* at that date. If there was a mere lapse or forfeiture then the decision of the Supreme Court in *Pohl* v. *Anchor Brewing Co.*, 134 U. S., 386, settles the question; but if there was, *by lapse of time, an expiration of the term* for which the Canadian patent was granted, and Judge Simonton so held in the *Bonsack* case, then the decision of the Supreme Court in *Bate* v. *Sulzberger*, 157 U. S. 1, applies and the patent in suit expired with the expiration of the term of the Canadian patent in 1899. It is clear, therefore, that Judge Townsend overlooked the question here involved. His examination of the authorities was brief, he says, and this, undoubtedly, accounts for his incorrect statement of the points decided in the *Bonsack* and *Apollo* cases above referred to.

(*h*) *The distinction under § 4887 of the Revised Statutes, between patents granted for a short term and not prolonged before the ex-*

piration of the short term for a further term by reason of which the short term and the patent expire by lapse of time, and patents granted for a fixed term subject to forfeiture or lapsing as a penalty upon breach of a condition subsequent during the term for which the patent was granted is well settled by authority in the patent law of this country. Judge Townsend erred in not recognizing this distinction and in not holding under the doctrine of stare decisis that the Canadian patent expired in 1899 with the expiration of the six year term for which it was granted, and which was the only term it ever had.

It is respectfully submitted that it is impossible upon the facts before the court, in view of the express provisions of the Canadian statute, to hold that the Canadian patent lapsed or became forfeited in 1899 and did not expire by lapse of time, within the meaning of § 4887 of the Revised Statutes. As will be seen from the cases hereinafter cited, the courts have uniformly held, and as Judge Simonton said, this marks the *distinction*, that *where a prior foreign patent is granted for a stated number of years upon the payment of a fee fixed for a term of that number of years, with a right to renew or prolong the term for a further number of years and up to a number of years beyond which the patent cannot be prolonged, in such cases, if the patentee does not exercise his right to renew or prolong the patent for a further term or a further number of years, the patent expires by lapse of time and carries with it a United States patent subsequently granted for the same invention. Where, however, a prior foreign patent is granted for a fixed term stated in the original grant and without provision for renewal or pro-*

longation of the term, and the patentee, by reason of the contract with the government under which the patent is granted becomes obligated to perform certain conditions such as the payment of an annual tax or to work his invention within a fixed period after the grant of the patent, or is prohibited from introducing the patented article into the country granting the foreign patent, in such case, if the patentee does not pay the annual tax which he is under obligation to pay or otherwise commits a breach of the conditions under which the patent was granted, the patent does not expire by lapse of time, but lapses and becomes forfeited by reason of the breach of condition. In *Pohl* v. *Anchor Brewing Co., supra*, the prior foreign patents were French and German patents granted each for the term of fifteen years upon condition that the patentee should pay the annual taxes required. Because the patentee failed to pay the annual taxes, the French and German patents lapsed and became forfeited because of the breach of condition; and, since there was no expiration by lapse of time of the terms for which the patents were granted, the Supreme Court held that § 4887 of the Revised Statutes did not apply and that the home patent did not expire at the time when the French or German patent lapsed and became forfeited, the reason being that there was no expiration of the term by lapse of time.

In the suits at bar, however, the Canadian patent clearly expired by reason of expiration through lapse of time. The term of the Canadian patent, the only term which the Canadian patent ever had, expired by lapse of time. This, as the Court will see from the authorities hereinafter cited, brings the case within the statute.

In *Western Electric Co.* v. *Citizens' Tel Co.*, 106 Fed. 215, quoted *supra* under Point Two, p. 60,

Judge Severens held in accordance with the decision of the Supreme Court in *Commercial Mfg. Co. v. Fairbank Co., infra*, that a United States patent expired with the expiration of a three year term of a prior Italian patent. According to the law of Italy, the duration of a patent could not in any case exceed fifteen years (Pat. Laws of the World, Carpmael, 1885, p. 288, Art. 11); and "patents granted for less than fifteen years may be *prolonged* for one or more years; the duration, however, of the prolongation added to the duration of the original patent shall in no case exceed fifteen years" (Carpmael, p. 289, art. 12). It is believed that Judge Severen's decision is the last decision involving the principle relied upon.

In *Electric Accumulator Co.* v. *Brush Electric Co.*, 52 Fed. 130, 139, quoted *supra* under Point Two, p. 63, the Circuit Court of Appeals for the Second Circuit assumed under the authority of *Commercial Mfg. Co. v. Fairbank Co., infra*, as Judge Severens held, that, where an Italian patent was previously granted "for the term of three years from September 30, 1882 and *was not prolonged*" (p. 139) and was in force when U. S. patent No. 337,299 was issued (p. 139), the United States patent would have expired with the expiration of the three year term of the Italian patent, if the Italian patent had been granted for "any one of the inventions" for which the home patent was granted (p. 139).

Judge Coxe, in the same case in the court below, stated the question involved as follows (47 Fed. 48, 52);—

> "Did patents Nos. 337,299 and 266,090 expire with the Italian patent? The Italian patent was * * * issued for a term of *three years* from September 30, 1882. It ex-

pired September 30, 1885, never having been *prolonged, renewed or extended.*"

Upon these facts, the only question considered open by Judge Coxe and the Circuit Court of Appeals was whether the home patents and the Italian patent were for the same invention. The question of identity of invention was, therefore, exhaustively examined by both courts, and it appearing, as the Circuit Court of Appeals said, that "the Italian patent is not the same in its essential particulars with *any one* of the inventions which are claimed in 337,299, and the home 'patent would not be infringed by a structure made in accordance with the provisions of the foreign patent' " (52 Fed. 139), it was held that the home patent did not, *for this reason only*, expire with the Italian patent.

In *Edison Co. v. United Co.*, 52 Fed. 300, the Circuit Court of Appeals for the Second Circuit, held (head note 5) that "a prior Canadian patent, issued for 5 years, and extended for the further period of 10 years, should be regarded as having a continuous term for the entire period, and as not limiting the United States patent to any shorter term", following *Bate* v. *Hammond*, 129 U. S. 225, where the Canadian patent had been kept alive for the full period of 15 years and where as the Supreme Court said later in the *Pohl* case (134 U. S. 381,385) the court limited itself to the precise question involved in view of the fact that the Canadian patent did *not* expire, and that its term was kept continuous by renewals, until the end of the 15 years. Nevertheless the court *again assumed* (52 Fed. 312), that had the renewal of the Canadian patent become impossible at the end of the original term of five years, as contended by defendants, by reason of the lapse of a certain Swedish patent, the United States patent

would have expired with the expiration of the 5 year term of the Canadian patent. It cannot reasonably be contended that the Court proceeded on any other theory or principle, since if such was not the theory of the court, it would not have exhaustively examined, in order to decide, the question whether the Canadian patent was affected in duration by the Swedish patent which did not exist when the Canadian patent was granted but was issued after the grant of the Canadian patent. The court expressly said (p. 312) that "*the soundness of the defendant's contention depends on the meaning under the Canadian law, of the phrase 'where a foreign patent exists,' as used in this (the Canadian) statute.*"

As above pointed out under Point Two, p. 59, in the case of *Commercial Mfg. Co. v. Fairbank Co.*, 135 U. S. 156, which came before the Supreme Court shortly after the decision in *Bate* v. *Hammond*, 129 U. S., 151, and immediately after the decision in *Pohl v. Anchor Brewing Co.*, 134 U. S. 386, and in which Judge Blatchford wrote the opinion as he did in the *Bate* and the *Pohl* cases, and could not by any possibility have overlooked the point necessarily involved, it was held that a United States patent expired with two prior Austrian and Bavarian patents originally granted for short terms of one and two years, and then "*prolonged*" and then permitted at the end of three years to expire with the expiration of the terms for which they had been "*renewed*" or "*prolonged*," but long before the expiration of the time for which the patents could have been prolonged. "The conclusion of the Circuit Court," with which the Supreme agreed, "was that the plaintiff's patent *expired* by the *expiration* of the Bavarian and Austrian patents."

Under Point Two, sub-division (*i*), p. 59, in con-

sidering the case of *Commercial Mfg. Co.* v. *Fairbank Co.*, reference was made to the record on appeal in that case (pp. 484-486 and 487) where these facts appear. According to the Austrian law in force at the time (See Carpmael, *Patent Laws of the World*, London, 1885, p. 23), it was provided, by § 25, that "the longest duration of privileges is fixed at fifteen years," and, by § 27, that "every patentee whose privilege has been granted for a shorter period than the longest (§ 9c) may claim its *prolongation* for one or more years within the fixed longest period," and by § 9c, "that number (of years) cannot exceed fifteen, except by a special grant of the Emperor."

Gramme Electric Co. v. *Arnoux*, 17 Fed. 838, decided by Judge Blatchford, is to the same effect. At p. 840, Judge Blatchford, in holding that a home patent expired with a prior Austrian patent at the end of the tenth year of prolongation of the latter, said that:

> "*A capacity of being prolonged so as to have a duration of fifteen years is not equivalent to having a term of fifteen years when the patent is granted for one year and then is prolonged so as to expire at the end of ten years.*"

Judge Blatchford's opinion in the *Gramme* case was cited with approval in *Bate* v. *Sulzberger*, 157 U. S. 1, 31, upon the point of the meaning of "previously patented." In *Pohl* v. *Anchor Brewing Co.*, 134 U. S. 381, 385, the court said that the question involved in that case was not the same as that decided in *Bate* v. *Hammond* and was not controlled by the decision in that case. In *Bate* v. *Hammond* the Canadian patent had been kept alive and, therefore, it did not expire. Where, however, the term is permitted to expire by *lapse of time*, following *Oakley* v. *Schoomaker*, 15 Wend. 226; *Beach* v. *Nixon*, 9 N. Y., 35 and *Farnum* v. *Platt*, 8 Pick. 339, and is

not forfeited by breach of a condition subsequent, the Supreme Court said in the *Pohl* case and squarely held in the *Commercial Mfg. Co.* case, and the lower Courts following those decisions have held, as above shown, that the United States patent expires with the expiration of the term for which the prior foreign patent was actually granted and extended, although when the foreign patent expired, the patent might have been extended under the foreign law for a further term. Although in the earlier decisions, among them one by Judge Townsend, there was considerable conflict and confusion upon this question, there is no authority contrary to Judge Simonton's decision in *Bonsack Machine Co. v. Smith*, *supra*, and the recent decisions of the courts above quoted, show that the rule is now uniformly applied as above stated, in accordance with the meaning above explained of the expression "expiration of term" by "lapse of time." The *term* of a lease *expires*, by lapse of time and limitation, if the privilege of renewal is not exercised. In such case, it would be absurd to say that there was a forfeiture by breach of a condition.

The *distinction* between patents, such as French and German patents, which *lapse* because of the breach of a condition subsequent, in the non-payment of annual taxes, according to the *contract* under which the patent is granted imposing an obligation upon the patentee, and patents which *expire* by lapse of time, such as Austrian, Bavarian, Italian and Canadian patents, because granted for a limited period and not prolonged, renewed or extended by the patentee *at his option*, in the exercise not of a duty but of a privilege, is clear and *well settled* in the patent law of this country. Judge Townsend erred in holding that the patent in suit did not expire in 1899 with the Canadian patent because he overlooked this well settled distinction upon which defendants, under

the rule of *stare decisis*, had a right to rely in the investment of their capital and in the conduct of their business, without being subjected to the *disastrous results* of some new interpretation of the law, set forth with great "*doubt*" and "*hesitation*" in order to grant an injunction destructive of their property and of their rights to permit an appeal to be taken.

POINT NINE.

The Berliner-Suess Canadian Patent No. 41,901, of February 11, 1893, could not, under the Canadian Patent Act, be prolonged beyond May 6, 1905, because the same invention having been patented by Suess on May 6, 1890, by French Patent No. 205,491, "under any circumstances, if a foreign patent exists, the Canadian patent shall expire at the earliest date on which any foreign patent for the same invention expires." Therefore, even if the Canadian patent did not expire in 1899, it did expire on May 6, 1905, with the expiration of the term of the prior French patent and with it the patent in suit expired, before the making of the motions for preliminary injunction.

Letters-Patent of France to Werner Suess, No. 205,491, of May 6, 1890, are enumerated in the answers (p. 31, fol. 91). "Said Suess French patent is identical in all respects, including the specification, drawings and claims, with U. S. letters-patent to Suess, No. 427,279" (aff. Hicks, p. 80, fol.

238). *This is not denied.* The specification and claims of the French patent are a literal transaction of the specification and claims of the U. S. patent. The drawing are identical. The Suess French patent bears the same date, May 6, 1890, as the date of the Suess U. S. patent, No. 427,279 (p. 233, fol. 698). The Suess French patent was in evidence in the prior suit (p. 79, fol. 237), but the Berliner-Suess Canadian patent was not in evidence in the prior suit (p. 81, fol. 243). According to the Law of France, the longest duration of a French patent was fifteen years (p. 176, fol. 527), and the term of the patent runs from the day of the deposit of the application, which is the day of its date (p. 178, fol. 533).

In the prior suit it was stipulated, as shown by the evidence in the suits at bar (p. 238, fol. 713; p. 80, fol. 238), as follows;—

> "It is hereby stipulated and agreed by counsel for *complainant* that Suess' French patent No. 205,491 appears to be the same as U. S. patent No. 534,543, and may be treated as such subject to correction."

The same stipulation is found at page 273 of the record on appeal in the prior suit. Under that stipulation the French patent was not printed in the record on appeal in the prior suit, because it was to be treated as being the same as U. S. patent 534,543, the patent here and there in suit. Among defendants' exhibits in the prior suit, there are enumerated, "certified copy, drawings and specification Suess French patent No. 205,491 (not printed). NOTE—see stipulation, p. 273)" (Index, p. II). A certified copy of the drawings and specification of Suess' French patent No. 205,491 was offered in evidence in the prior suit and marked "Defendants' Exhibit, Suess French Patent" (record on appeal, p. 244).

As it appears from the evidence in the suits at bar (p. 80, fol. 238), so it appears from the evidence in the prior suit that Suess' U. S. patent No. 427,279 and Suess' French patent No. 205,491, "are identical in substance, and it will, therefore, only be necessary to compare the subject matter of the claims mentioned (5 and 35 of the patent in suit) with one of these patents, for example, the U. S. patent" (record on appeal, p. 256). As in the suits at bar (p. 233, fol. 698), it also appears from the record on appeal in the prior suit, that the date of the French patent, May 6, 1890, is the same as the date of the Suess U. S. patent No. 427,279 (record on appeal, p. 268). An examination of the original exhibits filed in the prior suit in the office of the clerk of the Circuit Court for the Southern District of New York, shows that the certified copy of the Suess French patent in evidence in that suit supports the stipulation and evidence above referred to. The introductory paragraph, translated, reads as follows;—

> "Descriptive memorandum annexed to patent of invention for fifteen years, taken May 6, 1890 by Mr. Werner Suess represented by the firm Marillier and Robelet, Paris, 42 Boulevard Bonne-Nouvelle, which has been delivered by decree of the Ministry of Commerce, of Industry and of the Colonies under date of September 1, 1890, for 'Improvements relating to Gramophones.' Patent No. 205,491."

The Circuit Court of Appeals for the Second Circuit, in *Edison Co.* v. *United Co.*, 52 Fed. 300, passed upon the meaning of the provision in the Canadian Patent Act, that "*if a foreign patent exists, the Canadian patent shall expire at the earliest date on which any foreign patent for the same invention expires*," and held, as appears from head-note 6 (52 Fed. 300), that it "refers only

to foreign patents which exist before the issue of the relevant Canadian patent."

But, as above shown under Point Two, p. 54, the House of Lords of England, construing the same words in the Canadian Patent Act as it existed when the Berliner-Suess Canadian patent was granted on Feb. 11, 1893, subsequently held, in *Dominion Cotton Mills Co.* v. *General Engineering Co.*, L. R. App. Cas. (1902), p. 570, that a Canadian patent must expire with a foreign patent for the same invention existing *at any time* during the continuance of the Canadian patent. "Their Lordships" could "find no limit as to time except that the foreign patent must both *exist* and *expire after* the Canadian patent has been granted and before it has ceased from any other cause."

The Canadian Act as it existed at the time of the decision of the Circuit Court of Appeals is set out in the opinion (52 Fed. 312). The Canadian Act as it existed at the time of the decision of the House of Lords, is as follows;

> "8. Any inventor who elects to obtain a patent for his invention in a foreign country before obtaining a patent for the same invention in Canada, may obtain a patent in Canada, if the same be applied for within a year from the date of the issue of the first foreign patent for such invention; and, if within three months after the date of the issue of a foreign patent, the inventor gives notice to the commissioner of his intention to apply for a patent in Canada for such invention, then no other person having commenced to manufacture the same device in Canada during such period of one year, shall be entitled to continue the manufacture of the same after the inventor has obtained a patent therefor in Canada, without the consent or allowance of the inventor; *and, under any circumstances, if a foreign patent exists,*

> *the Canadian patent shall expire at the earliest date on which any foreign patent for the same invention expires.*" 55-56 V., c. 24 s. 1, *Statutes* of *Canada*, 1892, Vol. 1-2, p. 95.

This provision, 55-56 V., c. 24, s. 1, was in force at the time the Berliner-Suess Canadian patent was issued on February 11, 1893 (p. 156, fol. 468; p. 181, fols. 181-188). The Canadian patent was applied for May 5, 1891 (p. 169, fol. 507) within a year from the date of the prior French patent, May 6, 1890. The House of Lords, in the *Dominion Company* case, *supra*, said (p. 572);—

> "This act came into operation on July 9, 1892, and applied to all Canadian patents *granted* after that date."

In *Western Electric Co.* v. *Citizens' Tel. Co.*, 106 Fed. 215, Judge Severens, speaking with reference to the expiration of prior foreign patents, said (p. 218);—

> "It may be that the court ought to take notice of such a fact, it being within the range of information conveyed by encyclopedias and other repositories of facts of general interest."

As above shown, all the essential facts are before the court. The above defense seems absolute. Judge Townsend's decision was given in order that the questions of law involved, especially the questions of expiration arising under § 4887 of the Revised Statutes, should be determined at the earliest possible moment by the Appellate Court on appeal. The evidence conclusively shows, without contradiction, that the Suess French patent is identical in all respects, including the specification, drawings and claims of U. S. letters-patent to Suess No. 427,279, of May 6, 1890 (p. 80, fol. 238). Furthermore, by reason of *complainant's* stipulation in the prior suit, the Suess French patent is to be re-

garded as being the same as the patent in suit and was treated as such under the stipulation in the prior suit. The motions in the suits at bar rest absolutely upon the record, and the decision reached, in the prior suit, and the court, of course, is at liberty to examine the record in the prior suit as filed in the clerk's office in the Circuit Court and in the Circuit Court of Appeals, to ascertain what was before the courts in the prior suit. The question in the suits at bar is, according to familiar law, whether any *new* evidence is presented, the Berliner-Suess Canadian patent, which, had it been presented to the Courts in the prior suit as part of the evidence therein, would have led the courts to reach a different conclusion. Clearly, had the Berliner-Suess Canadian patent been part of the evidence in the prior suit, the courts would necessarily have been led to hold in that suit that, in view of the prior Suess French patent, the Suess Canadian patent expired on May 6, 1905, if it did not expire in 1899.

There remains but little to be said upon this conclusive defense. Referring to claims 1-5 of the Suess French patent No. 205,491, of May 6, 1890, identical with claims 1-5 of the Berliner-Suess United States patent No. 427,279, of the same date, and comparing them with the claims of the Berliner-Suess Canadian patent, it appears that claim 1 of the French patent is, word for word, the same as claim 6 of the Canadian patent; that claim 2 of the French patent is identical with claim 8 of the Canadian patent; that claim 3 of the French patent is identical with claim 9 of the Canadian patent; that claim 4 of theFrench patent is identical with claim 4 of the Canadian patent; and that claim 5 of the French patent is identical with claim 10 of the Canadian patent. As above shown, the drawings and specification of the French patent are

identical with the drawings and specification of the United States patent, and, therefore, identical with the drawings and specification of the Canadian patent as a comparison of the United States and Canadian patents will show. The stipulation in the suits at bar shows that the drawings of the Canadian patent are identical with the drawings of the United States patent (T. case, p. 555, fol. 1663; L & C case, p. 541, fol. 1621). In the suits at bar, as in the prior suit, the useless printing of duplicate copies of identical exhibits was dispensed with to save time and expense (T. case, p. 557; L. & C. case, p. 543). The only difference, therefore, between the Suess French and Canadian patents is that certain claims of the Canadian patent are not contained in the French patent. Without any question the structure described, illustrated and claimed in the French patent would infringe all of the claims of the Canadian patent not contained in the French patent, and of course, the structure described, illustrated and claimed in the French patent would infringe the claims of the Canadian patent which correspond, word for word, to the claims of the French patent. The identity of invention is established, therefore, under the test laid down by the Supreme Court in *Commercial Mfg. Co.* v. *Fairbank Co.*, 135 U. S. ,176, and other cases cited *supra* under Point Two sub-division (*g*), p. 55. Moreover, as shown by the authorities cited under Point Two, especially under sub-division (*m*) thereof, p. 69, as stated by Judge Brown in the *Sawyer Spindle Co.* case, 133 Fed. 238, 241, "the rules which are applied to determine the question of double patenting when United States patents are involved" are "also applicable when the question is whether the invention has been first patented in a foreign country." Therefore, under the decision of the Supreme Court in *Miller* v. *Eagle Mfg. Co.*, 151

U. S. 186, quoted under Point Four, sub-division (*h*), p. 102, it is clear that, after the granting of the French patent, a second patent could not be granted for the claims of the Canadian patent not contained in the prior French patent, since the claims of the French patent *necessarily involve* the features, and *all* of the features, of the claims (1, 2, 3, 5, 7, 11, 12 and 13) of the Canadian patent not contained in the French patent. As Judge Wallace said in *Thomson-Houston Co.* v. *Hoosick R. Co.,* (C. C. A.), 82 Fed., 461, 465-467, quoted *supra* under Point Four, sub-division (*j*), p. 109, reversing Judge Townsend on the point here under discussion "the matter sought to be covered by the second patent" would be "*inseparably involved* in the matter embraced in the former patent, and this, under the authorities, renders the second patent void, *Miller* v. *Mfg. Co.* 151 U. S., 198." As shown, *supra,* under Point Two, sub-divisions (*h*) p. 58 and (*p*) p, 77, *the broadening or the narrowing of the invention or the claims of a home patent will not save the home patent.*

The decision of Judge Brown in *Sawyer Spindle Co.* v. *Carpenter,* 133 Fed. 238, 241, quoted, *supra,* under Point Two, sub-division (*m*), p. 69, is directly in point. Judge Brown there said;—

> "Two *patents* and two *claims* may be regarded as for the *same invention,* though one claims a *special machine,* and the other claims broadly a genus which includes the former *Otis Elevator Co.* v. *The Portland Co.,* 127 Fed. 557 (C. C. A.); *Miller* v. *Eagle Mfg. Co.,* 151 U. S. 186; *Robinson on Patents* §464,465, vol. 2, p. 45. When this is the case, though the American claim may be broader than that of the prior British patent, it is still true that what is claimed under the generic claim *has already been patented in a foreign country.*"

The point is so clear that the Suess French and Canadian patents cover one and the same invention and that the subject matter of the claims of the Canadian patent, not contained in the French patent, is inseparably involved in the structure and in the claims of the French patent, that it would be useless to do more than to request the court to inspect the drawings and read the claims and specification of the French patent, identical with U. S. patent 427,279, in order to ascertain the elements thereof and thereby see how impossible it would be to make a structure according to the specification and claims of the French patent which would not infringe every claim of the Canadian patent and which would not involve every feature and element, essential and not essential, of the invention of the Canadian patent.

Beyond all question, therefore, if the Canadian patent describes and broadly claims the invention of the claims here in suit, as Judge Townsend found, and if the claims here in suit are not to be limited by the details of construction of the reproducer shown in Figs. 6 and 7 of the patent in suit, it follows that *the patent in suit expired with the Berliner-Suess Canadian patent;* and that, if the Berliner-Suess Canadian patent did not expire in 1899, as argued under Point Eight, *it necessarily expired on May 6, 1905, with the expiration of the term of the prior French patent and carried with it the patent in suit.* As the patent in suit expired, under any view, before the making of the motions for preliminary injunction, the Circuit Court erred in the granting of the motions, and the orders appealed from should be reversed, upon the assignments (21, 22, 34 and 35) of errors.

POINT TEN.

Berliner patent in suit No. 534,543 was anticipated by English patent No. 1644, of 1878, to Edison, as to claims 5 and 35, if those claims are to be broadly construed and not limited by the special form of reproducer shown in Figures 6 and 7.

Although this English patent to Edison was in the record in the prior suit against the American Graphophone Company before Judge Hazel and the Circuit Court of Appeals, the defense now presented to the court was not raised. The defence is supported by the affidavit of defendants' expert, Mr. Goss (p. 297). In the prior suit this defence was not referred to in the evidence, nor in the briefs, oral arguments of counsel or opinions of the courts. It was not presented, considered or passed upon and should now be decided according to its merits and not dismissed without examination as was done by Judge Townsend merely because the lengthy patent out of which the defence arises was in the record. If counsel in the prior suit was not aware of the defence or did not appreciate its importance, that is no reason why it should not now be sustained on the *new evidence* in these suits, *if the defence is good and valid.* "Comity has no application to questions *not considered* by the prior court, or, in patent cases, to alleged anticipating devices which were not laid before that court. As to such the action of the Court is purely original." (*Mast, Foos & Co. v. Stover Mfg. Co.*, 177 U. S. 485).

Figs. 1 and 2 of the Edison patent No. 1644 of 1878 were cited merely in support of the conten-

tion that the Bell and Tainter patent No. 341,214 was an anticipation of claims 5 and 35 of the patent in suit. Counsel for the American Graphophone Company on p. 16 of their brief submitted to Judge Hazel said, with reference to this Edison English patent;—

> "(1.) In Edison's British patent, No. 1644 of 1878, figs. 1 and 2 (D. R., p. 134), is shown a machine of the disc type in which the reproducer is carried by an elongated arm pivoted to a stationary support. The propulsion of the stylus is effected by a pin engaging a spiral-groove 3 (fig. 2), which performs the function of a feed-screw. It is clear that when Bell & Tainter brought into existence the freely-mounted reproducer, free to be guided *by the record-groove itself, there* could be no possible novelty or invention in the use of an elongated reproducer-arm pivoted on a fixed support, as in this Edison patent, and having a range of movement on its pivot sufficiently ample to cover the entire width of the record."

It is clear that the attention of Judge Hazel and of the Circuit Court of Appeals was not directed to figures 34 and 37 of Edison British patent No. 1644 of 1878, or to that part of the specification (p. 8, lines 47-53; p. 9, lines 11-14) describing figures 34 and 37 as follows;—

> "Fig. 34 is a perspective view showing a double phonet, there being a spiral line of indentations on each side of the revolving disk *d*, one phonet coming into action as the other finishes; in this case the spirals should be in opposite directions, *so that the disk continuing to revolve in the same direction moves one phonet from the center outwards*, and *then the other phonet is connected and moved back towards the center;* this may be used as a toy."

> "Fig. 37 represents the phonograph or phonet upon a *pivoted arm, so that it may swing across* or *at right angles* to the line of

> movement of the intended (indented) material or phonogram. In this case the line of indentations may be lengthwise of the belt, or across the same in the arc of a circle."

Here then, in Figure 34, we have the rotating record tablet having spiral grooves thereon constituting the sound record and the spiral groove of the sound record without any feeding mechanism whatever, causes the reproducing stylus mounted on an arm that swings toward and from the center of the disc to move across the face of the record. At p. 2, lines 7-11, Edison says: "the phonograph is on an arm that swings toward and from the center of the disc, and is guided by grooves or other convenient mechanism. The phonet device takes the place of the phonograph device when the sounds are to be reproduced." In figure 34 we have the phonet mounted on an arm that swings toward and from the center of the disc and guided by the grooves of the *sound record itself* across the face of the disc and not by anything else whatever. On p. 2, line 55, it is said that the phonogram may be made in the form of a *disc*, and that the marks constituting the record may be straight lines, spiral, *zigzag* (which is the common term for a record having lateral undulations) or in any other convenient form. Here then, we have a complete anticipation of claims 5 and 35 of the patent in suit under the broad construction thereof contended for by complainants. The subject matter of this defense arising out of figure 34, has been so fully stated by defendants' expert, Mr. Goss, in his affidavit and exhibit thereto annexed (pp. 297-308), and the point is so clear from an inspection of figure 34 of the said Edison British patent and of the model which is herewith submitted to the court as an illustration of the operation of figure 34, that it is unnecessary to say anything further

in support of this defense. The use of a swinging arm capable of moving laterally and vertically or in other words, having a universal joint (English patent No. 1644 of 1878, p. 4, lines 45-48), and carrying at its free end a phonet or reproducer with a reproducing stylus in engagement with the walls of the record groove, and the vibrating and propelling of the reproducing stylus across the face of the disc by the walls of the groove of a rotating record table is old, as appears from Edison's very early patent No. 1644, of 1878 of Great Britain, as well as from the Suess Canadian patent already discussed. All that Berliner did was to invent certain improvements in the very details of the construction of his recorder and of his reproducer. He constructed a lever bent at right angles at about its middle carrying a stylus at its free end and attached to the diaphragm and the diaphragm casing, as already described. Unless claims 5 and 35 of the patent in suit are limited by that feature, that is by his special form of reprducer, the claims are anticipated and are invalid. Edison in his first United States patent No. 200,521, of February 19, 1878, in figure 3, also shows the production of a *zigzag* record and *lateral* undulations of the point of the recording stylus. This he describes at p. 2, top of second column, saying:

> "I do not wish to confine myself to reproducing sound by indentations only, as the transmitting or recording device may be in a *sinuous* form, resulting from the use of a thread passing with paper beneath the pressure-rollers *t*, (see Fig. 3), such thread being moved *laterally* by a fork or eye adjacent to the roller *t*, and receiving its motion from the diaphragm G, with which such fork or eye is connected, and thus record the movement of the diaphragm by the impression of the thread in the paper *to the right and left* of a straight line, from which indentation the receiving-dia-

phragm may receive its motion and the sound be reproduced, substantially in the manner I have already shown."

In English patent No. 6027, of 1886 to Johnson, p. 2, lines 23-31, it is said;—

> "The reproducing stylus *should be mounted so that it can readily be guided by the record.* This may be accomplished in different ways as for example by mounting the head of the reproducing instrument upon a joint which admits of a *lateral movement*, or the style may be so mounted as to be capable of a lateral movement, independently of a diaphragm and other parts of the reproducer—By this latter arrangement the style can accommodate itself to the record without having to put in motion the larger mass of the head of the reproducer. It therefore responds more quickly—Both arrangements will be illustrated."

Clearly the idea of guiding the reproducing stylus by the record was old, and Edison disclosed the principle as applied to a machine operating precisely as complainants' exhibits of defendants' machines operate. This he did in figure 34 and the description thereof above quoted, as well as in figure 37 and the description thereof above quoted from English patent No. 1644, of 1878.

The apparatus shown in figures 34 and 37 of English patent No. 1644 of 1878 are claimed by Edison in the first and tenth claims thereof, which read as follows;—

> "First. The combination with the *diaphragm* and *point* of a *flat* receiving surface and means for revolving the receiving surface, and *causing the point to follow a volute or spiral line*, substantially as represented in Figs. 1, 2, 6, 7, 8, 9, 10, 15 and *34*.
>
> "Tenth. The mechanism for producing a phonogram, and employing the same in a phonet, substantially as described, and illustrated in Figs. 32, 33, 35, 36 and *37*."

These claims clearly set forth the elements of claims 5 and 35 of the patent in suit, unless claims 5 and 35 are limited by the special form of reproducer shown in figures 6 and 7, which reproducer is not used by defendants. For comparison claims 5 and 35 are set forth;—

> "5. The method of reproducing sounds from a record of the same which consists in vibrating a stylus and propelling the same along the record by and in accordance with the said record, substantially as described.
>
> "35. In a sound reproducing apparatus consisting of a traveling tablet having a sound record formed thereon and a reproducing stylus shaped for engagement with said record and free to be vibrated and propelled by the same, substantially as described."

The apparatus disclosed by figures 34 and 37 of the Edison English patent and protected by the first and tenth claims thereof would unquestionably infringe claims 5 and 35 of the patent in suit if claims 5 and 35 are not limited as above stated; hence they would anticipate, under the well settled rule that "that which infringes if later, would anticipate if earlier", (American Co. v. Streat, 83 Fed. 700, 703, and cases cited).

Fig. 34 of Edison's English patent, the *fundamental* patent in the art, shows a more practical device, than does Fig. 10 of Berliner patent No. 564,586 upon which alone complainants rely. As shown, *supra*, under Point Seven, subdivision (*j*), p. 139, the device of Fig. 10 was impractical and a mere laboratory experiment, which never went into use. Defendants' machines are Suess machines, which differ more from Fig. 10 of the Berliner patent than from Fig. 34 of the Edison patent.

POINT ELEVEN.

In the prior suit between complainants and the American Graphophone Company, decided by Judge Hazel and the Circuit Court of Appeals, complainants, by contract, promised the defendant, The American Graphophone Company, a license under the patent in case defendant should lose, and promised also by the same contract to waive all claim for past royalties and damages. The prior suit was not, therefore, a suit in which Berliner patent in suit No. 534,543, of February 19, 1895, was fairly in controversy. The Circuit Court of Appeals has held defendant was guilty of laches in its search for defenses in that suit.

The proposition of this point admits of no question whatever.

The motions for preliminary injunction in the suits at bar were argued on April 13, 1906. Counsel for the American Graphophone Company in the prior suit, Mr. Mauro, was present at the argument and followed the proceedings. Judge Townsend's opinion, resolving the doubt in favor of complainants in order to permit appeals to be taken, was filed April 26, 1906. Immediately after the argument of the motions before Judge Townsend and before Judge Townsend had had an opportunity to examine the questions and render his decision thereon, counsel for the American Graphophone Company seized upon one of the defenses, to the

exclusion and prejudice of the other defenses, which defendants had interposed before Judge Townsend, and having served his papers on April 18, 1906, moved in the Circuit Court of Appeals, in the prior suit of these complainants against the American Graphophone Company, for permission to apply to the Circuit Court for leave to file a bill in the nature of a bill of review. The ground of the motion was the expiration of the patent in suit by reason of the expiration of the Berliner-Suess Canadian patent in 1899. The only other ground upon which the motion was based was that defendant, the American Graphophone Company, would, in view of the Berliner-Suess Canadian patent and other matters, be able to show that Berliner caused the Suess French patent of May 6, 1890, to be granted upon the application of the said Suess. Upon the oral argument of the motion in the Circuit Court of Appeals and in his affidavit filed in support of the motion, counsel for the American Graphophone Company (*mirabile dictu*) said (p. 9, printed papers on the motion);—

> "*It is to the interest of the defendant, the American Graphophone Company, that the patent in suit should be sustained and enforced against other manufacturers of talking machines.*"

The Circuit Court of Appeals immediately on April 24, the day after the hearing of the motion, *denied the motion on the ground of laches* (145 Fed. 350).

In view of this holding of the Circuit Court of Appeals and of the facts above and hereinafter set forth, it is respectfully submitted that it will establish a most dangerous precedent to hold that, in a case where, by *contract* between complainant and defendant, it is to the interest of the defend-

ant to lose and to have the patent sustained and enforced against other persons, and where the Circuit Court of Appeals has found and held that defendant was guilty of laches in its searches for defenses, the patent was fairly in controversy and that the decision at final hearing in such a suit, even though affirmed on appeal, can be used as a basis for a motion for preliminary injunction against other defendants. If such is to be the practice established in patent litigation, by the affirmative action of the courts in approval thereof, the wrong and injustice which will accrue inevitably to innocent parties will be without measure. Although Judge Townsend says in his opinion that in the prior suit "*apparantly* every material defense was presented and discussed", the holding of the Circuit Court of Appeals, that the defendant was guilty of laches in its search for defences, and the serious new defenses urged in the suits at bar prove the contrary; and although Judge Townsend further states that "the contention that by reason of a certain contract between the parties 'the prior suit was not a suit in which the Berliner patent in suit * * * was fairly in controversy' is not deserving of notice," still, it is respectfully submitted that the contention is one deserving of very serious notice by this court and deserving also of the holding by this court that Judge Townsend erred in not denying the motions for preliminary injunction because of such contention lest, as above stated, a most dangerous precedent be established in patent litigation to the injury of innocent third parties who will be at the mercy of complainants and defendants agreeing in their own interest to conduct a suit in which both parties are interested in having the patent first sustained and then enforced by summary proceedings, at their joint expense, on mo-

tions for preliminary injunction against others whose opportunities to defend are necessarily limited and prejudiced.

The agreement dated December 8, 1903, between the Victor Talking Machine Company and the American Graphophone Company is one of the defendants' exhibits (p. 224). The provisions for the license by the Victor Company to the Graphophone Company in case, at final hearing, one or more of the Berliner patents mentioned, including the patent in suit, as to any broad claim or claims thereof, be sustained by the court, and for the waiver of past royalties and damages are to be found in paragraph 2 of the contract (p. 226). Although provision is made in the contract for the future payment of royalties, the amount of the royalties is not named (p. 226, fol. 677), and the contract contains a similar provision for the payment of royalties by the Victor Company to the Graphophone Company in case any patent of the Graphophone Company should be sustained at a final hearing (p. 227, par. 5). More surprising than the foregoing provisions, however, is that contained in paragraph 3 (p. 226), which provides that in case one or more claims of said Berliner patents "be sustained, as provided in paragraph 2, the said Graphophone Company shall thereafter, whenever so requested in writing by the Victor Company, assist in the prosecution of its suit brought and to be brought under the said Berliner patents against other parties, by furnishing its own counsel at its own expense, court costs to be divided, each party paying one-half", etc.

Clearly under this agreement it was to the interest of the American Graphophone Company, as its counsel has stated under oath, to lose and not to win the suit. By losing, the Graphophone Company would secure a license under a patent which

would be sustained at final hearing and which by agreement between the Victor Company and the Graphophone Company would be enforced at their joint expense against all other competitors.

We now understand why the foregoing defenses were not discovered or interposed. This was the cause of the *laches*. There was no incentive compelling counsel for the American Graphophone Company to search out and to present the defenses to the patent in suit. That they did not search out and present the defenses to the patent in suit clearly appears, and the lack of incentive so to do is shown positively by the agreement of December 8, 1903.

When counsel for the Talk-O-Phone Company and the Leeds & Catlin Company became aware of the existence of the agreement of December 8, 1903, through his presence at the argument at final hearing before Judge Hazel in June, 1905, he moved on behalf of the Talk-O-Phone Company and the Leeds & Catlin Company before Judge Hazel for leave to address the court with reference to the contract of December 8, 1903, and set forth in an affidavit verified June 8, 1905, (p. 216) the circumstances showing that a decision in a suit prosecuted pursuant to the terms of such a contract could not be a basis for relief by way of preliminary injunction against any other person thereafter to be sued by the Victor Company upon said Berliner patent in suit. Leave to address the court was denied. The proposed orders upon said motion, the affidavit of Louis Hicks verified June 8, 1905, presented upon said motion, and the correspondence with reference to the settlement of the order thereon are set forth at pp. 214-224 of the records and are verified in the affidavit of Hicks (p. 81, fol. 241).

Under such circumstances, and upon the showing made in the suits at bar, defendants should have

been afforded an opportunity to present their defences at final hearing before the granting of injunctions, and the Circuit Court erred in not so holding.

POINT TWELVE.

Defendants machines do not infringe claims 5 and 35 of the patent in suit when those claims are properly construed in view of the prior art disclosed by defendants in opposition to the motions.

The Talk-O-Phone Company manufactures talking-machines only and does not and never has manufactured sound records (aff. Hicks, p. 97, fol. 289; aff. Ensign, p. 99, fol. 295; aff. Irish, p. 283, fols. 849-850). The Leeds & Catlin Company manufactures sound records only and does not and never has manufactured talking-machines (aff. Leeds, p. 116, fol. 347; aff. Irish, p. 284, fols. 850-851; aff. Leeds, p. 292, fols. 875-876).

The Leeds & Catlin Company, moreover, has not been engaged in the purchase and sale of talking-machines with the exception of a few taken from the Talk-O-Phone Company in the settlement of an account (aff. Irish, p. 284, fol. 851; aff. Leeds, p. 292, fol. 876). Complainants allege and show by a moving affidavit, however, that the Leeds & Catlin Company sold one of these talk-o-phones. This raises the question of infringement with reference to the machines as to both defendants, although obviously the question is of small importance as far as the Leeds & Catlin Company is concerned, but of great importance as far as the Talk-O-Phone Company is concerned. The machines to be considered, however, are of the Talk-O-Phone Com-

pany. As fully explained under the preceding points of this brief, and especially under Point Six, dealing with the Suess Canadian patent, these talk-o-phones are constructed according to the gramophone of the Suess Canadian patent. As pointed out in defendants' affidavits (aff. Irish, p. 287, fols. 861-862; aff. Leeds, p. 296, fol. 886), defendants have never made, sold or used talk-o-phones provided with reproducers such as the reproducer of the patent in suit shown in figures 6 and 7. That the reproducers used in connection with the talk-o-phones are like the reproducer of the gramophone of the Suess Canadian patent and are not like the reproducer of the patent in suit is obvious furthermore from a mere inspection and comparison. Since claims 5 and 35 must either be limited so as to cover a method or apparatus employing the special reproducer of the patent in suit, shown in figures 6 and 7, or otherwise be held invalid, in view of the Suess Canadian patent and of Edison's English patent No. 1644 of 1878, and the other evidence referred to above in this brief, it follows that defendants' machines do not infringe either claim 5 or claim 35 of the patent in suit, assuming, contrary to the fact, that the patent in suit has not expired.

POINT THIRTEEN.

Complainants delayed the prosecution of these suits, took no testimony and defendants were entitled, at the time of the motions to dismissals of the bills upon the pleadings under the rules of the Circuit Court.

These suits were begun in the summer of 1904, defendants appeared and interposed demurrers to

the bills (aff. Hicks, pp. 76-77, fols. 228-229). Complainants unreasonably delayed in bringing the demurrers on for hearing against the repeated protests of defendants' counsel, as appears from the correspondence between Mr. Pettit, complainant's counsel, and Mr. Hicks, defendants' counsel, set forth in the record (pp. 198-211). This appears particularly from the letters of April 21, June 14, November 20, and November 22, 1905 (pp. 200-203). The demurrers were argued before Judge Holt, who held that the points raised should be passed upon at final hearing. Complainants then delayed in entering the order overruling the demurrers and did not enter the order until requested so to do by defendants' counsel (p. 205, fol. 643). Thereupon, defendants promptly filed their answers on December 21, 1905 (p. 77, fol. 229), but complainants neglected to file their replications on the January, 1906, rule day. Defendants' counsel was assured that the replications would be filed as of the January, 1906, rule day, and for that reason, over the telephone, consented, on request of complainant's counsel, for a delay of one or two days after the January, 1906, rule day for the filing of the replications. The replications, however, were not filed until the February, 1906, rule day (p. 45, fol. 133), and since that date no testimony whatever had been taken by complainants in either suit (aff. Hicks, p. 77, fol. 230).

This is a case where the rules of the court should be strictly enforced, since it clearly appears that complainants p. cuted their suit against the American Graphophone Company under the agreement of December 8, 1903, and studiously avoided bringing the suits against these defendants to final hearing, although repeatedly informed that defendants were prepared to show the invalidity of the patent in suit (p. 204, fols. 610-611).

Rule 109 of the equity rules of the Circuit Court provides;—

> "When no proceedings are taken by either party within thirty days after replication, for the examination of witnesses out of court, either party may set the cause down for hearing upon the pleadings."

Under this provision the cause was properly before the court for hearing upon the pleadings. Defendants were entitled to have the causes heard upon the pleadings. More than three months had elapsed since the January, 1906, rule day, and nearly three months had elapsed since the replications were actually filed on the February, 1906, rule day. The making of a motion for preliminary injunction under such conditions when the entire testimony, under the rules, could have been taken and presented to the court for final hearing and decision upon the merits was preposterous, when the repeated protest of the defendants against such procedure, as set forth in the correspondence referred to, is considered.

It is very clear why complainants delayed the prosecution of these suits against these defendants. Complainants were aware that defendants had been ready to show the invalidity of the patent in suit. Complainants were prosecuting their test case against a defendant whose interest it was to lose, and complainants so regulated their proceedings as to expedite the cause against the American Graphophone Company and to delay the trial of these suits against these defendants.

POINT FOURTEEN.

Sound records having lateral undulations existed before the date of the invention of the patent in suit and were patented by Berliner in several forms in divers patents which have expired. Such records are capable of use with machines of various constructions. The proposition that the making and selling of such sound records can be an infringement of the patent in suit is untenable.

As pointed out with reference to the record in the opening of Point Thirteen, the Talk-O-Phone Company does not and never has manufactured sound records. The Leeds & Catlin Company does and has manufactured sound records of various kinds, including disc sound records having zigzag or lateral undulations. The threatening circular letter of complainant company (p. 211, fols. 632-633) and of complainant's counsel (pp. 212-213) indicate that it is complainants' contention, and that it is complainants' purpose to state to the trade, that all disc sound records are infringements of claims 5 and 35 of the patent in suit. In view of the great injury which has been caused to defendants by reason of complainants threatening letters to the trade, and because the contention is entirely without foundation, it becomes important, especially for the Leeds & Catlin Company, that this point be passed upon by the court, should the court for any reason hold that the patent has not expired, and that claims 5 and 35 are entitled to a construction broad enough to cover defendant's machines.

What then are the facts shown by the evidence

with reference to disc sound records? At the outset we have Edison's English patent No. 1644 of 1878, speaking of the zigzag form of a record (p. 2, line 55) and disclosing disc sound records in figures 2 and 34, for example, which figures 2 and 34 also show the use of disc sound records in connection with machines involving as to figure 34, the identical mode of operation of defendant's machines and involving as to figure 2 the identical mode of operation, except in so far as that mode of operation may be limited by the use of the spiral guide groove 3. Likewise, in Edison's first United States patent No. 200,521 of February 19, 1878, disc sound records and records with lateral undulations are described as follows (p. 2);—

> "It is obvious that many forms of mechanism may be used to give motion to the material to be indented. For instance, a revolving plate may have a volute spiral cut both on its upper and lower surfaces, on the top of which the foil or indenting material is laid and secured in a proper manner. A two-part arm is used with this disk, the portion beneath the disk having a point in the lower groove, and the portion above the disk carrying the speaking and receiving diaphragmic devices, which arm is caused, by the volute spiral groove upon the lower surface, to swing gradually from near the center to the outer circumference of the plate as it is revolved, or *vice versa*."

When Bell & Tainter invented the graphophone their sound records were disc sound records. In patent 341,214 of May 4, 1886, applied for June 27, 1885, one of the fundamental patents in this art, the sound record shown is a disc sound record (p. 3, lines 24-29). Indeed, all disc sound records having lateral undulations are made to-day in accordance with the invention of patent No. 341,214 for cutting or engraving in wax or a wax-like sub-

stance. In Berliner's patents No. 372,786 of November 8, 1887 and No. 382,790 of May 15, 1888, disc sound records having lateral undulations formed the subject matter of the specifications and claims. Since these patents have expired, the disc sound records with the lateral undulations have become public property. Futhermore, Berliner patent No. 564,586, applied for November 7, 1887, has, without question, expired with English patent No. 15,232 of November 8, 1887, and with the corresponding first German and French patent to Berliner for the same invention. In all these patents, No. 564,586, and the corresponding English, German and French Berliner patents, Berliner described his disc sound record having lateral undulations and furthermore he described his gramophone, not only for the recording, but also for the reproducing of such disc sound records. Figure 1 of patent No. 564,586, shown also in the corresponding English, German and French patents is a reproducing machine as well as a recording machine, and such a machine is public property for the recording of sound and for the reproduction of sound from disc sound records. There are also Berliner's English patent No. 7204 of 1888, for a disc sound record, which has expired, French patents to Berliner, three in number, all of which have expired, and German patents to Berliner, three in number, all of which have expired.

In patent No. 385,886 to Tainter, of July 10, 1888, the sound record is shown as a disc (p. 2, line 129). At p. 3, lines 7-19, it is said;—

> "While it is preferred to use a tablet of this description and to form the record by cutting or engraving therein, as described in patent aforesaid (341,214), it is obvious that the machine is also adapted to operate in connection with a recorder that produces a record by indenting in a pliable substance or *by removing*

*part of a thin film of lamp black** or in any other practical way. The construction of the recorder and reproducer is or may be such as described in previous patents, and, therefore needs no particular description here."

* This is Berliner's disc sound record having lateral undulations made according to his patents which have expired.

It would be tedious and unnecessary further to deal with the patents of the prior art showing that disc sound records having lateral undulations existed before the date of the invention of the patent in suit, and that various machines had been invented and constructed before the date of the invention of the patent in suit and used in connection with such disc sound records. Under the following point, it will be shown that the talk-o-phones operating with the aid of mechanical feed devices cannot possibly be construed as infringements of claims 5 and 35 of the patent in suit and that such talk-o-phones are likewise adapted for use with disc sound records having lateral undulations. In the affidavit of Leeds (pp. 293-296), it is fully shown that the contention of the moving affidavits that disc sound records having lateral undulations can be used only on machines made according to claims 5 and 35 of the patent in suit is untrue and that the contention of the moving affidavits that machines made according to claims 5 and 35 can be used only with disc sound records having lateral undulations is likewise untrue. Mr. Leeds points out the different kinds of records and talking machines that have been made and put upon the market and are upon the market to-day, and shows that disc sound records having lateral undulations existed long prior to the date of the invention of the patent in suit, and that Berliner himself secured patents covering disc sound records and machines for repro-

ducing sound from the same, and that all of Berliner's said patents have expired. To the same effect in the affidavit of Mr. Irish (pp. 285-288, fols. 853-862), and the affidavit of Mr. Ensign (p. 114).

The Leeds & Catlin Company manufactures and sells for export and exports hundreds of thousands of disc sound records having lateral undulations and does not sell in connection therewith machines of any kind (aff. Leeds, p. 294, fol. 882). Under no circumstances could such manufacture and sale infringe claim 5 or claim 35 of the patent in suit (*Bullock Co.* v. *Westinghouse Co.*, 129 Fed. 105). Since the records are adapted for use on machines of different kinds, as above shown, not covered by the patent in suit, the manufacture and sale thereof in the United States cannot be held to be an infringement, (*Edison Co.* v. *Peninsu'ar Co.*, 101 Fed. 831). Moreover, Berliner's expired patents covering such records cannot be prolonged.

POINT FIFTEEN.

The Talk-o-phones operating by mechanical feed devices do not infringe claims 5 and 35 of the patent in suit.

As complainants, in the Circuit Court, refused to contend that the talk-o-phones, operating by mechanical feed-devices, are an infringement of claims 5 and 35, this point is of importance only in so far as it bears upon the prior art.

Berliner in his testimony in the suit against the American Graphophone Company (p. 241, fol. 723) said;—

> "The two claims, 5 and 35, refer to any apparatus in which the record groove both propels and vibrates the reproducing stylus or sound box, and it practically means *to the ex-*

> *clusion of a feed screw* for that purpose, or of any other device outside of the record groove itself, by which the sound box or the reproducing stylus may be propelled across the record surface."

Such is the testimony of the moving affidavits. That is what Suess states in his Canadian and United States patents when he says: "I rely upon this control of the stylus by the walls of the record groove for the movement of the stylus across the face of the disc, there being no positive feeding mechanism for thus moving the stylus."

The construction and operation of the talk-o-phones with mechanical feed devices are described in defendant's affidavits (aff. Hicks, pp. 96-97; aff. Ensign, pp. 111-112, fols. 333-336, p. 114, fol. 342; aff. Irish, p. 286, fols. 857-858; aff. Leeds, p. 293, fol. 878, p. 295, fol. 883). A copy of the description and claims upon an application for a patent therefor on behalf of the Talk-O-Phone Company is one of defendants' exhibits (p. 275). And the machines, Exhibits A and B, show the talk-o-phones with the mechanical feed devices, which, as Mr. Irish states in his affidavit, have been advertised by the Talk-O-Phone Company at an expense of from $22,000 to $23,000. Mr. Ensign summarizes the differences between complainant's machines and talk-o-phones with mechanical feed devices. He says (p. 114, fol. 342);—

> "The Talk-O-Phones with the mechanical feed devices (Exhibits A and B) are *recording* as well as *reproducing* machines. They will *record* sound upon the usual tablets and will reproduce sound from the record of the same after recording. Thus it appears that the movement of the stylus across the face of the record in such Talk-o-phones depends *solely upon the mechanical feed device.* Complainants' machines will *not record* but will *only* reproduce, thus showing that complainants'

machines depend entirely upon the record groove for the movement of the stylus across the face of the record."

Clearly any contention on complainants' part that the talk-o-phones with mechanical devices are an infringement of claims 5 and 35 of the patent in suit could not have been made in good faith. Complainants' letters threatening the trade make such contention (p. 213, fol. 637-638) and such letters have caused great injury to the Talk-O-Phone Company (aff. Irish, p. 284, fol. 852, p, 288, fol. 864).

Without question the talk-o-phones with mechanical feed devices do not infringe either claim 5 or 35 of the patent in suit, and in view of the wrongful, misleading and threatening letters which complainants have been sending to the trade with respect to such talk-o-phones in connection with the patent in suit, it is respectfully submitted that defendants should be protected by the court therefrom.

Mechanical feed devices are shown in the following patents of the prior art, all of which have *expired*;—

No. 1644 of 1878 to Edison (English,
No. 191,464 of May 29, 1877, to Pickering,
No. 200,521 of February 19, 1878, to Edison,
No. 213,554 of March 25, 1879, to Edison,
No. 219,939 of Sept. 23, 1879, to Hall,
No. 227,679 of May 18, 1880, to Edison,
No. 238,929 of Mch. 15, 1881, to Legge (Fig. 2)
No. 277,349 of May 8, 1883, to Rogers,
No. 283,665 of Aug. 21, 1883, to Rogers,
No. 287,166 of Oct. 23, 1883, to Reynolds,
No. 295,219 of Mar. 18, 1884, to Absterdam,
No. 341,214 of May 4, 1886, to Bell & Tainter,
No. 341,288 of May 4, 1886, to Tainter,
No. 372,786 of Nov. 8, 1887, to Berliner,

No. 375,579 of Dec. 27, 1887 to Tainter,
No. 382,790 of May 15, 1888 to Berliner,
No. 385,886 of July 10, 1888, to Tainter,
No. 564,586 of July 28, 1896, to Berliner (expired),
No 6027 of 1886 to Johnson (English)
No. 15,232 of 1887, to Berliner (English)
No. 7204 of 1888, to Berliner (English)
No. 45,048 of 1887, to Berliner (German)
No. 186,827 of 1887, to Berliner (French).

As set forth in the affidavits above referred to the talk-o-phones with mechanical feed devices are constructed in accordance with Figs. 6-10, especially, of Edison's English patent No. 1644 of 1878.

CONCLUSION.

It appearing that the patent in suit expired before either of these suits was begun and that the claims in suit are invalid or not infringed, the motions for preliminary injunction should have been denied and the bills dismissed. The orders should, therefore, be reversed with directions to dismiss the bills.

That the Circuit Court upon the hearing of a motion for preliminary injunction has the power, not merely to deny the motion, but also to dismiss the bill, appears from the following cases: *Harriman v. Northern Securities Co.*, 197 U. S., 244,286, where such action of the Circuit Court as well as of the Circuit Court of Appeals was cited with approval; *Castner* v. *Coffman*, 178 U. S., 168; *Mast, Foos & Co.* v. *Stover Mfg. Co.*, 89 Fed., 333,337 (affirmed 177 U. S., 485), where the power of the

Circuit Court of Appeals under such circumstances was asserted and exercised, and where the Court said that "it is not consistent to say that the decision of an inferior Court must be pronounced on one basis and reviewed on another." See, also, De Laval Co. v. Vermont Co., 109 Fed., 813, and Streat v. American Co., 115 Fed., 634.

It is, therefore, respectfully submitted that, for the reasons stated in the foregoing points, the orders appealed from should be reversed with directions to dismiss the bills.

LOUIS HICKS,
Counsel for Defendants-Appellants.

No. [redacted] 80.

Office Supreme Court, U.
FILED.
MAY 13 1907
JAMES H. McKENNEY
CLERK

IN THE

Supreme Court of the United States.

October Term, 1906.

LEEDS & CATLIN COMPANY,
Petitioner,

v.

VICTOR TALKING MACHINE COMPANY, and UNITED STATES GRAMOPHONE COMPANY,
Respondents.

RE PETITION FOR WRIT OF CERTIORARI, RE MOTION FOR PRELIMINARY INJUNCTION.

Brief on Behalf of Respondents in Opposition to the Petition.

HORACE PETTIT,
Solicitor and of Counsel for Respondents,
604 Stephen Girard Building, Philadelphia.

International, 236 Chestnut St.

IN THE

Supreme Court of the United States.

October Term, 1906.

LEEDS & CATLIN COMPANY,
Petitioner,

v.

VICTOR TALKING MACHINE COMPANY, AND UNITED STATES GRAMOPHONE COMPANY,
Respondents.

RE PETITION FOR WRIT OF CERTIORARI. FROM DECREE GRANTING PRELIMINARY INJUNCTION.

BRIEF ON BEHALF OF RESPONDENTS IN OPPOSITION TO THE PETITION.

To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

These respondents respectfully oppose the granting of the Petition for writ of Certiorari, among other reasons, upon the grounds:

1. That there is nothing in this case which should take

it out of the ordinary rule as to the finality of a decision of the U. S. Circuit Court of Appeals in like cases, or which should warrant the intervention of this Honorable Court to review the decision of the U. S. Circuit Court of Appeals, which is the Court of ultimate appeal in cases of motion for preliminary injunction to restrain infringement of Letters Patent. The main questions involved were questions of fact.

2. That the questions involved in this case, relative to the construction of Sec. 4887 of the Revised Statutes as well as 4886, have been fully settled and determined in a number of cases, both by this Honorable Court and by the U. S. Circuits Courts of Appeal of various circuits; and there is no new question herein presented, or any question which would warrant this Court in making an exception of this case, and in granting the Petition.

3. The claims of the patent in suit have been previously sustained upon final hearing by the U. S. Circuit Court and by the Circuit Court of Appeals, of the second Circuit unanimously in a similar infringement after a most vigorous defense. In this case also the Circuit Court granted the injunction and the Court of Appeals unanimously affirmed the Circuit Court. There was no dissenting opinion.

4. That the decree in this cause is on motion for preliminary injunction, restraining the defendant from infringement of the patent in suit, which was granted in this case by the U. S. Circuit Court, for the Southern District of New York; that this decree of the U. S. Circuit Court, for the Southern District of New York, was unanimously affirmed, upon appeal, by the U. S. Circuit Court of Appeals, for the Second Circuit.

5. That the Defendant Company (the Petitioner herein), after the decision of the U. S. Circuit Court of Appeals, continued the infringement, and was held in con-

tempt, upon motion, by the U. S. Circuit Court, for the Southern District of New York; that the defendant (the Petitioner herein) thereupon appealed, and the order of the Circuit Court, holding the defendant in contempt, was affirmed by the U. S. Circuit Court of Appeals, for the Second Circuit, one judge dissenting. A separate petition for Certiorari has also been presented in the said Contempt Proceedings.

6. That the case has not yet been heard upon final hearing in the Circuit Court; complainants completed their *prima facie* proofs on the 13th day of November, 1906, but defendant (the Petitioner herein) has failed as yet to take any of its proofs on final hearing. The defendant (the Petitioner herein) has therefore its opportunity to again be heard, both in the Circuit Court, and upon appeal in the U. S. Circuit Court of Appeals; that this, therefore, is a Petition for a writ of Certiorari upon the decree in the Preliminary Injunction Proceedings—an interlocutory decree.

7. The Berliner Patent, No. 534,543, issued February 19, 1895, in suit, has been adjudicated and sustained in a prior suit upon final hearing, where the infringing devices were indentically the same, to wit, in the case of Victor Talking Machine Co., *et al.*, *v.* The American Graphophone Co. (140 Fed. Rep., p. 860). This decision was affirmed by the U. S. Circuit Court of Appeals, for the Second Circuit (145 Fed. Rep., p. 351).

8. That there are no questions involved in this case which would warrant the granting of the Petition for writ of Certiorari, under the rules laid down by this Honorable Court in such matters, this being merely an attempt on the part of the Petitioner, the losing party in the Circuit Court and U. S. Circuit Court of Appeals, to exhaust every means to prevent the writ of injunction, most properly granted both by the Circuit Court and the U. S. Circuit Court of Appeals.

This Petitioner, the Leeds & Catlin Company, has filed two petitions, viz.—

(a) A Petition for writ of Certiorari in the Injunction Preceedings.

(b.) A Petition for writ of Certiorari in the contempt proceedings.

These, however, are presented separately under separate covers and will be separately considered by the respondents.

RE PETITION FOR WRIT OF CERTIORARI IN THE INJUNCTION PROCEEDINGS.

The Petitioner herein presents in its Petition 14 points relative to the Injunction Proceedings, upon which it bases the said petition, and in which it claims the U. S. Circuit Court of Appeals, for the Second Circuit, was in error.

These points were considered by the U. S. Circuit Court of Appeals in the Injunction Proceedings, affirming the Circuit Court.

The Appellant's Brief (the Petitioner herein) contained 199 pages, and the Appellant's Brief (Respondents herein) contained about the same number. The matter was most thoroughly and exhaustively before the Court of Appeals. thoroughly and exhaustively before the Court of Appeals. A copy of this Respondents' Brief in the Court of Appeals is hereto annexed.

On September 28, 1905, Judge Hazel, in the U. S. Circuit Court, for the Second Circuit (140 Fed. Rep., p. 860), sustained the patent, after a most exhaustive defense on final pleadings and proofs, in the case of the Victor Talking Machine Co., *et al. v.* the American Graphophone Co. On March 1, 1906, the U. S. Circuit Court of Appeals, for the Second Circuit, affirmed the Court below (145 Fed. Rep., p. 351), in a decision by Judges Lacombe, Townsend and Coxe.

On April 26, 1906, on the motion for Preliminary Injunction in the present cause against the Leeds & Catlin Company, on the same patent and the same claims, the U. S. Circuit Court, for the Southern District of New York, in an opinion by Judge Townsend (146 Fed. Rep., p. 534), granted the Preliminary Injunction. On October 12, 1906, the U. S. Circuit Court of Appeals for the Second Circuit, affirmed the Court below, in an opinion by Judges Wallace, Lacombe and Coxe. (148 Fed. Rep., p. 1022—Per Curiam).

A similar suit was also prosecuted by the same complainants against the Talk-O-Phone Company, on the same claims of the said Berliner patent in the same Courts for a similar infringement, and like decrees were entered against the said Talk-O-Phone Company.

On January 5, 1907, Judge Lacombe, in the U. S. Circuit Court, for the Southern District of New York (150 Fed. Rep., p. 147), held the defendant (this Petitioner) **in contempt** of the writ of injunction previously granted, and on May 2, 1907, the Court of Appeals affirmed the said order of Judge Lacombe, holding the Leeds & Catlin Company **in contempt**—Judge Wallace dissenting.

In this particular case against the Leeds & Catlin Company, the Circuit Court has twice decided in favor of the complainants, and the U. S. Circuit Court of Appeals, in this particular case against the Leeds & Catlin Company, has twice decided in favor of the complainants. In the Injunction Proceedings, Judge Townsend, in the Court below, and Judges Wallace, Lacombe and Coxe, in the Appeal Court, have sustained the patent, and granted the injunction; while in the Contempt Proceedings, Judge Lacombe, in the Circuit Court, and Judges Hough and Coxe, in the Court of Appeals, have held the Leeds & Catlin Company to be in contempt—Judge Wallace dissenting. This is the only dissenting opinion in this long series of litigation, **five judges** deciding for the complainants, and **one judge** filing a dissenting opinion, as to the contempt only.

Re Petitioner's First Point.

The first point raised by the Petitioner (Petition, p. 3.) is, in substance, the contention that where a portion of a device contained in a United States patent has been patented in a prior foreign patent, the home patent expires with the prior foreign patent, although the home patent contains claims covering subject-matter not described or claimed in the foreign patent.

This question was quite fully discussed in the brief filed by the Victor Talking Machine Co., *et al.* in the U. S. Circuit Court of Appeals, on the appeal from the decree granting preliminary injunction, as were all the points raised in this Petition, and a copy of the Appellees' Brief is herewith attached for consideration, in considering this Petition.

The question involved in the Petitioner's first point is considered in the Respondents' Brief in the Circuit Court of Appeals, under the heading "Re Defendant's Points Two and Three"—Brief, pp. 60 to 111.

The facts in this case do not substantiate or warrant the Petitioner's contention under its first point.

The Petitioner contends that the German Patent, No. 53,622, of November 20, 1889, previously granted to Berliner, the patentee of the patent in suit, No. 534,543, issued February 19, 1895, describes and claims the invention of the home patent, in addition to other matter.

The Petitioner's counsel admits, as he must, that the invention patented in the prior German patent is for a sound box, which, at best, is only a detail part of the home patent, No. 534,543; he contends that as it is *an* invention which appears in the home patent in suit, it must, therefore, invalidate the home patent, though the principal invention of the home patent, claimed in claims 5 to 35, is admittedly not shown, or disclosed, in the prior German patent.

The broad claims or principal invention of the home patent, in suit, 5 and 35, read as follows:

"5. The method of reproducing sounds from a record of the same which consists in vibrating a stylus and propelling the same along the record by and in accordance with the said record, substantially as described.

"35. In a sound reproducing apparatus consisting of a traveling tablet having a sound record formed thereon and a reproducing stylus shaped for engagement with said record and free to be vibrated and propelled by the same, substantially as described."

The invention claimed in the above claims was **Mr. Berliner's broad basic invention,** as decided by the U. S. Circuit Court of Appeals, for the Second Circuit, in the Graphophone case, and in this Leeds & Catlin case and the Talk-O-Phone case, as hereinbefore pointed out.

This German patent, No. 53,622, merely describes and claims **a specific form of sound box.** (See Respondents' Appeal Brief, p. 62, etc.)

If this construction of reproducing sound box shown in the German patent is the same, as contended for by the Petitioner, as the construction of reproducing sound box shown in Figs. 6 and 7 of the home patent, in suit.—which however, we deny—it is only at best for a specific construction and minor part disclosed in the home patent, **and could not be considered a prior patenting of the principal invention,** as decided by this Honorable Court in the case of Seamans et al. v. Sellers et al., 123 U. S., p. 276. (See Respondents' Appeal Brief, Injunction Proceedings, p. 80, etc.)

These respondents, however, show in the Appeal Brief (p. 62, etc.) material differences in construction and operation between the two reproducing sound boxes. This German patent, therefore, can in no manner affect the principal invention of the home patent.

MR. BERLINER'S PIONEER INVENTION.

Mr. Berliner's invention, claimed in claims 5 and 35 of the home patent, as decided by the Circuit Court, and the Circuit Court of Appeals, both in the suit against the present defendant, and in the suit against the American Graphophone Co., was **a broad basic invention,** which departed radically from the prior art in talking machines, such as the Edison phonograph and the Graphophone, and produced and made possible a superior and more accurate sound reproducing apparatus, and method of reproducing sound. The reproducing stylus point was vibrated acoustically, and simultaneously propelled, by and in accordance with the sound record, keeping, at all times, the reproducing point in intimate, exact contact with the record of sound in the sound groove, as it was rotated past the stylus point from the beginning of the groove near the periphery to the end near the center. Mr. Berliner's invention very much simplified the method of reproducing sound, besides giving superior results, and gave to the world a device which has become one of the greatest commercial successes of the age, revolutionizing, in a large measure, the talking machine art.

The patent in suit will be found at pages 452 to 462 of the Record.

The Petitioner's contention, in substance, is that if only a detail part of any specific device shown, or claimed, in the home patent, no matter how minor, or unimportant, is previously patented in any foreign patent, the **principal invention** of the home patent will thereby become invalidated upon the expiration of said foreign patent.

It is respectfully submitted that there is absolutely no warrant for such a proposition, and that the case of Seamans, *et al.*, *v.* Sellers, *et al.*, (123 U. S. p. 276), not only does not sustain the Petitioner's contention, but clearly

shows that the principal invention must be in both the home patent and the prior foreign patent, in order to bring it within the statute, Sec. 4887.

CONSIDERATION OF AUTHORITIES.

The attention of the Court is called to the consideration of authorities set forth in Respondents' Appeal Brief, p. 82, etc.

The Petitioner's contention is contrary to the spirit of Sec. 4887.

In this connection, the attention of the Court is called to Respondents' Appeal Brief, p. 99, etc.

The Circuit Court of Appeals, for the First Circuit, in Westinghouse Electric Co. *v.* Stanley Improvement Co., (138 Fed. Rep., p. 823) considers the decision in the case of Seamans *v.* Sellers, *supra*, and points out how this case has been misinterpreted in some respects.

Defendant's counsel appears to rest his whole contention, in this connection, not upon the spirit of the decision in Seamans *v.* Sellers, but upon a misconstruction of a short sentence by Mr. Justice Bradley therein, viz:—

> "A patent cannot be construed as running partly from one date and partly from another."

The attention of the Court is respectfully called, in this connection, to a consideration of this point in Respondents' Appeal Brief, p. 104 to 111.

It is obvious that the main invention of a domestic patent cannot be invalidated, under our system of claims, by the mere fact that a detail, minor portion, separately claimed in the U. S. patent, may have been previously patented abroad.

Manifestly, Sec. 4887 contemplated that the **principal** invention of the home patent must have been previ-

ously patented abroad, in order that the U. S. patent for it should expire with the foreign patent.

Under the laws of the United States, certain claims may be invalid, by reason of anticipation or other reasons, while the remaining claims may be perfectly valid for the full period of the grant of the U. S. patent.

The attention of the Court is called to a *misleading statement* contained in the Petition (p. 5), where it says:

> "Moreover the patent in suit states that while one feature of the invention has reference to improvements in the method of recording, a feature not involved in any way in this suit, the other features of the invention have reference to the construction of the detail of both the recorder and reproducer of the gramophone (p. 1, lines 17—35 of the patent in suit)."

That this statement is misleading, is clear from a reading of the paragraph preceeding, p. 1, line 17, etc.; the preceeding paragraph, which is the first and primary statement of invention in the patent, says, (p. 1, line 8, etc):

> "My invention has reference to improvements in the method of and apparatus for recording *and reproducing sounds*—"

The method of reproducing sound, referred to, is made an important claim of the patent, to wit, claim 5, while the apparatus is made a most important claim in claim 35.

The Petitioner would apparently have the Court believe, from this statement, that the main invention was one of *recording*, and that all the other features had reference to the construction of *details*, which is manifestly not so.

While the method of recording may be one of the features of the patent, the method of and apparatus for reproducing, such as claimed in claims 5, and 35 are the most essential features of the patent. **The specific constructions of recording and reproducing sound boxes, shown**

in Figs. 4 to 7 of the home patent (Record, p. 455) are details, and if they had been previously patented in a foreign patent, as claimed by the Petitioner, this fact could not, as herein submitted, affect the life of the principal invention of the patent, not previously patented abroad.

In the Petitioner's construction of Sec. 4887, its counsel, in his endeavor to invoke the operation of the statute in this case, has been playing with words, and contends that if "*an* invention of the home patent has been previously patented abroad, no matter how minor the part of the invention may be, the statute operates."

The statute, however, only applies to "*an invention which has been previously patented in a foreign country*". The statute does not say that if a *part* of an invention has been previously patented, the whole patent must become void. The relative pronoun "*which*," manifestly provides that only that invention or that portion of the invention which has been previously patented abroad shall expire with the foreign patent. It says "*an invention which*". Therefore, the condition precedent is that the invention which shall expire with the prior foreign patent is *the invention which has been patented* in the prior foreign patent. It is, consequently manifest that the *principal* invention of a home patent, which has never been patented in a prior foreign patent, could not expire with the prior foreign patent.

What has been said regarding the prior German patent, No. 53,622, also practically applies to the prior French patent, No. 207,090, which is shown at page 73 of Respondents' Appeal Brief, and considered on pages 71, etc., of the said brief. The French patent is for a construction of reproducing sound box, and also a construction of recording sound box, which Petitioner contends is the same as in Figs. 4 to 7 of the home patent.

RE PETITIONER'S SECOND POINT.

(Petitioner's Brief, p. 6.)

The Petitioner's second point, as well as the first and several others, is confused and misleading; it can have no application to the facts of the present case.

This question is discussed under Point Four, page 111, of the respondents' brief in the Circuit Court of Appeals.

Under this point, the Petitioner contends that the home patent expires with the legal term of a prior foreign patent to the same inventor, where the claims relied upon in the home patent include all the fundamental features of the principal invention of the prior foreign patent, and where the said claims of the home patent embody a mere modification of the principal invention of the prior foreign patent.

Even if this contention were true, the facts of the case at bar do not, and cannot, warrant the application of such a rule to this case.

The Petitioner relies for this contention upon three prior foreign patents to Berliner, viz., English patent No. 15,232, November 8, 1887 (Record, pp. 516 to 527); French patent No. 186,827, of November 8, 1887 (Record, pp. 123 to 124); and German patent, No. 45,048, of November 8, 1887 (Record, pp. 132 to 144).

For the purposes of the consideration of this point, it may be assumed that the drawings of the German and French patent illustrate the same construction as illustrated in the English patent, No. 15,232.

As found by the United States Circuit Court of Appeals, there is nothing in any of these prior foreign patents, either in the drawings, specifications or claims, which illustrates and describes the invention of the claims in controversy of the Berliner patent in suit.

In the consideration of this point, the attention of the Court is particularly called to respondents' brief on appeal, pp. 111 to 129.

The drawings of the British patent, No. 15,232, illustrate, for the purposes of this case, in Figs. 1 to 7, the same devices and constructions as shown in the drawings of the Berliner United States patent, No. 372,786, a prior Berliner patent not in suit. Figs. 8 to 16 of this British patent show, sustantially, the same device as illustrated in Figs. 1 to 9 of the Berliner United States patent, No. 564,586, filed November 7, 1887, and the description of the British patent describes these constructions illustrated.

The only drawing, Fig. 10, of No. 564,586, which in any manner illustrates the apparatus or method of claims 5 to 35 of the patent in suit **was never introduced** into the British patent, No. 15,232, and the corresponding French and German patents, but was manifestly purposely left out and entirely omitted, as well as all description of Fig. 10 and any and all description of the subject-matter of claims 5 and 35. Neither are there any claims in any of these foreign patents, of course, for the method or apparatus of claims 5 and 35 of the patent in suit, and could not be, as there is nothing in the specifications or drawings of any of these patents upon which to base such claims.

Fig. 10 of the Berliner U. S. Patent, No. 564,586, with the description thereof, was the only thing in the application for that patent, filed November 7, 1887, which had any bearing upon the claims of the patent, in suit. The U. S. Circuit Court of Appeals in the case of the Victor Talking Machine Co. *et al. v.* American Graphophone Co. (145 Fed. Rep., 350), held that the date of Mr. Berliner's invention of claims 5 and 35 of the patent, in suit, No. 534,543, was November 7, 1887, as one form of the invention was disclosed in Fig. 10 of the application for the Patent, No. 564,586, which was pending at the time the Berliner Patent, in suit, was pending and issued subsequently to the patent in suit. This disposed of the question of alleged public use

by Mr. Berliner in May, 1888, as it was thus shown, as held by the U. S. Circuit Court of Appeals, that Mr. Berliner, at the time of the alleged public use, had an application in the Patent Office pending, which illustrated and described the invention.

Fig. 10, of No. 564,586, and the description thereof was the only thing in the application for the Berliner patent, No. 564,586, as before stated, which illustrated or described the invention of claims 5 and 35 of the patent in suit.

The British patent, No. 15,232, of 1887, as well as the German and French patents for the same invention, as before stated, was made up partly of the Berliner United States patent, No. 372,786, and with a part of the drawings of the Berliner application for patent No. 564,586.

There is, however, absolutely nothing in the specification, drawings or claims of the British patent, No. 15,232, of 1887, or in the corresponding German or French patents, which illustrates or describes, directly or indirectly, the method of claim 5 or the apparatus of claim 35 of patent No. 534,543 in suit.

The only drawing, Fig. 10, and the only description of patent No. 564,586 which in any way relates to claims 5 and 35 of the patent in suit, never was a part of this British, French or German patent.

This subject is quite fully treated on pages 112 to 117 of Respondents' Appeal Brief.

The questions herein involved are mainly questions of fact; the United States Circuit Court and Court of Appeals have found the facts, and have held that Petitioner's application of the law does not apply.

Re Claim 9 of the British Patent, 15,232, of 1887.

Petitioner's counsel contends (pp. 10 and 11 of Petition), that even though Fig. 10, and the description

thereof, of United States patent No. 564,586, is not contained in the British, French or German patents, claim 9 of th British patent is substantially the same as claim 8 of the United States patent, No. 564,586, and that it is for the invention illustrated in Fig. 10.

(1.) Claim 9 of the British patent manifestly cannot relate to Fig. 10 of United States patent, No. 564,586, as there is no illustration of this figure in the British patent, or any description of any such construction. There is nothing whatsoever in the British patent upon which to base such a construction of claim 9.

(2.) The language of claim 9 of the British patent shows that the construction claimed therein relates to a combined **recorder and reproducer** such as shown in Fig. 8 thereof; the construction claimed in claim 8 of the United States patent, No. 564,586, is such a construction of **recorder and reproducer** as shown in Fig. 1 of No. 564,586. **Claim 8 of the United States patent, No. 564,586, does not relate or refer to the construction shown in Fig. 10.**

A careful reading of claims 9 of the British Patent, and 8 of the U. S. Patent, No. 564,586, show that they relate to a *combined recorder and reproducer*, and are manifestly different from claim 35, or claim 5 of the patent, in suit. Claim 9 of the British Patent and claim 8 of the U. S. Patent, are printed on pages 8 and 9 of the petition.

Claim 9 of the British patent reads as follows:

"9. In a gramophone, the combination of a sound receiving diaphragm or other sonorous body; with a pivoted stylus controlled by a diaphragm, and controlling the same, and a support adapted to carry a phonautographic record sheet or a copy of such record, in solid resisting material, traveling in the plane of vibration of the point of the stylus, substantially as described."

Claim 9 of the British patent requires, among other things, that the pivoted stylus shall be **"controlled by a diaphragm, and controlling the same."**

A pivoted stylus controlled by a diaphragm must be in a **recording** machine where the diaphragm controls or operates the stylus to record the sound waves; a pivoted stylus **controlling** the diaphragm must be in a **reproducing** machine, as the record when made pulsates the stylus point which controls or operates the diaphragm. Therefore, the use of the conjunction "and" in the terms "a pivoted stylus **controlled** by a diaphragm **and controlling** the same," indicates that the combination called for in the claim is a combined **recording** and **reproducing** machine, such as shown in Fig. 8 of the British patent. The construction in Fig. 10 of the United States patent, No. 564,586, is a **reproducer** only; it is not a combined recorder and reproducer.

The requirements of claim 9, "a *support* adapted to carry a phonautographic record sheet or a copy of such record, in solid resisting material, *travelling* in the plane of vibration of the point of the stylus," requires that the *support* shall travel or be propelled past the fixed reproducing point in the plane of vibration of the point of the stylus, in addition to the rotary movement of the plate 13, as shown in Fig. 8 of the British Pateat. (See Respondents' Brief, pp. 114 to 117, 120 to 126.) Respondents' expert shows that the word "travelling" in claim 8 of No. 564,586, refers to the "support adapted to carry a phonautographic recording surface or a copy of such record in solid resisting material."

Claim 9 of the British Patent, also requires that the support be adapted to carry both (1) "a phonautographic record sheet, or (2) a copy of such record in solid resisting material." This is a requirement that the device shall be capable of carrying both of these elements, viz., a phonautographic record sheet when the device is to be used as a recorder, or a copy of such record in solid resisting material

when the device is to be used as a reproducer. It is, therefore, clear again that the construction claimed refers to an apparatus which can be used either as a *recorder*, or a *reproducer*, such as shown in Fig. 8 of the British Patent. The apparatus, such as Fig. 10 of the U. S. Patent, No. 564,586, could not be intended to be included in this claim, as it is *not a recorder*, but can be used for *reproducing* purposes only. The device shown in Fig. 8 of the British Patent and in Fig. 1, of the U. S. Patent, is a *combined recorder and reproducer* such as claimed in claim 9 of the British Patent and Claim 8 of the U. S. Patent.

The *support* referred to in claim 9 is manifestly the *support* referred to in the specification of the British patent, pages 5 and 6, etc. (Record, pp. 520, etc.), and marked with the numeral 7, in Fig. 8 of the drawing. This support 7 is shown as a bearing for the bevelled gears 14 and 9, and as carrying the record on a flange, 10. The support 7 is positively *traveled* in a rectilinear, or straight line, by the screw threaded shaft 6 passing through the fixed nut 5, which support thus carrying the record, travels in the plane of vibration of the point of the stylus, the record or copy of the same being at the same time rotated while the support carrying it is thus traveling in the rectilinear line. This is clearly shown in Fig. 8 of the British patent described on pages, 5, 6 and 7 thereof. (Record p. 520, etc.) The flange upon which the record plate is placed, is marked 10, and the British specification states, page 6, line 30, etc., "and in the manner hereinbefore described the support 7 will receive a rectilinear motion, while the flange 10, upon bevel gear 9, *will both rotate and move in a straight line*. For every complete revolution of bevel gear 14, support 7, and bevel gear 9 with its connected flange 10, will be moved in the line of a diameter, a distance equal to the pitch of the screw threads upon the shaft 6; and it will now be understood, that if a plate 13, is fixed to flange 10, and a fixed

pencil or stylus be lightly pressed upon the plane surface of said plate, a spiral line will be drawn upon the plate."

The specification says, page 6, line 31, "the support 7, will receive a rectilinear motion—." It also says, page 6, line 33, "support 7, and bevel gear 9 with its connected flange 10, will be moved in the line of a diameter—."

This is the *support* referred to in claim 9, which is adapted to carry the record, or copy of the record, and which in operation is "traveling in the plane of vibration of the point of the stylus." In other words, is receiving the "rectilinear motion" and moving "in a straight line", or is "moved in the line of a diameter," as stated in the specification, while the record, or copy of the same, is being rotated.

This is the only logical and possible construction which can be given to this claim 9, viz.: That it is intended to cover and include the record and reproducing apparatus, such as illustrated in Fig. 8 of the British patent and in Fig. 1 of the United States patent, No. 564,586, where the support has a positive rectilinear motion, while the record carried by it is given, at the same time, a rotary motion, so that in recording "a spiral line will be drawn upon the plate," and in reproducing, the support carrying the rotating record will be, at the same time, positively traveling in a straight line in the plane of vibration of the point of the stylus.

The invention illustrated and described in Fig. 10 of the United States patent, No. 564,586, filed November 7, 1887, was expressly omitted from the British, French and German patents, filed November 8, 1887.

While it is true that the Court of Appeals, by reason of Fig. 10, and a description thereof, being in 564,586, gave Mr. Berliner, as the date of his invention of claims 5 and 35, of the patent in suit, November 7, 1887, the date of filing of the application for patent No. 564,586, yet the Court of Appeals did not give to his inven-

tion of claims 5 and 35 any earlier date than November 7, 1887. It is clear that in order to have included Fig. 10, and description thereof, in these European patents, Mr. Berliner would have to have had to have invented the invention of Fig. 10, **at least ten days or two weeks prior to November 8, 1887**, the date of filing of these applications for patents in Great Britain, France and Germany, in order to have prepared a description of the invention here, where he lived and resided, and to send it across the ocean to London, Berlin and Paris. There is nothing to show that Mr. Berliner had invented the invention shown in Fig. 10 prior to November 7, 1887, the date of filing of the United States case, and nothing to show that he had invented it at the time that the descripion and drawings for the British, French and German applications were prepared and forwarded to London, which must have been, as before stated, at least ten days or two weeks prior to November 8, 1887, the date of the foreign applications.

As Fig. 10 and description thereof were not contained in these foreign applications, it may fairly be assumed that it may not have been invented at the time that the drawings and descriptions were sent from here to London for filing these foreign cases, which must have been at least some time during the latter part of October, 1887.

The Court of Appeals never held that claim 8 of the patent, No. 564,586, or claim 9 of the British patent, was for the construction shown in Fig. 10, as might be inferred by a somewhat misleading statement contained at the top of page 11 of the Petition.

This question was raised in the Court of Appeals by the Petitioner, and the Court of Appeals refused to sustain the contention. Claim 8 cannot, therefore, be read on Fig. 10 of patent No. 564,586, but only on Fig. 1, and the only construction illustrated and described in the British patent upon which claim 9 can be read is that illustrated in Fig. 8.

It is respectfully submitted that the case of Miller v. Eagle Mfg. Co., 151 U. S., p. 186 (referred to on page 11 of the Petition), has no application to the facts of the present case. If it had any application, and if Petitioner's contention were sound, which it is not, it could merely affect the patent No. 564,586, the second patent, and not No. 534,543, the patent in suit; but as claim 8 is manifestly for a different invention, it can have no application.

The Petitioner, on page 12, again considers the case of Seaman, *et al.* v. Sellers, *et al.*, 123 U. S. 276, hereinbefore referred to, and which is fully considered in Respondents' Brief, particularly at pages 82, etc., and 104, etc.

The Petitioner contends (bottom of page 12), that both the Circuit Court and Circuit Court of Appeals "arbitrarily set aside the clear provision of Sec. 4887 as to the limitation of a home patent by a prior foreign patent and the clear provisions of Sec. 4886 as to public use or sale in this country for more than two years prior to the filing of an application for a patent—"

This statement is unwarranted. What the Courts did find in this case is that the facts did not warrant the application of Section 4887 so as to abridge the term of the claims of the patent in suit, and as to Section 4886, the facts show that there was no public use or sale in this country as to invalidate the patent under the provisions of that section. As to the question of alleged public use, see Respondent's Appeal Brief, p. 128, etc.

Re Petitioner's Third Point.

(Petition, p. 16.)

This point is discussed on page 128 of Respondents' Appeal Brief.

Judge Hazel, in sustaining the claims 5 and 35 of the patent in suit, in the case of these complainants

against the American Graphophone Co. (140 Fed. Rep., 860), held that the Franklin Institute Lecture of May 16, 1888, did not constitute a public use under the authorities, such as to invalidate the patent under Section 4886. Upon the appeal of that case, the Court of Appeals (145 Fed. Rep., 351) affirmed the Court below, but on the question of alleged public use it also held that Berliner was entitled to carry the date of his invention, of claims 5 and 35, back to November 7, 1887, the date of filing of the application for patent No. 564,586, which was pending on March 30, 1892, the date of filing of the application of the patent in suit, and that, therefore, the question of alleged public use could not arise.

This, therefore, was *res adjudicata* at the time the suit against the Leeds & Catlin Company was brought.

This would also apply to the affidavits of Martin and Wetzler, produced by the Petitioner in this case, which are manifestly at best insufficient and inadequate proof, and also to the publication in the Electrical World, August 18, 1888, which was manifestly not a public use. Nor could have been the alleged explanation of Mr. Berliner of the invention to Messrs. Martin and Wetzler, in his bedroom at the Union Square Hotel, at New York, about March 18, 1888, even if the facts alleged by Martin and Wetzler were true.

The petitioner contends again that claim 8 of the patent, No. 564,586, related to Fig. 10, and is the same as claims 5 and 35.

As shown by the decision of Judge Hazel, and also of the Court of Appeals, affirming his decision, the construction shown in Fig. 10, described in Patent No. 564,586 was not *claimed* in that application. Both the Circuit Court and the Circuit Court of Appeals have, therefore, in a finding of fact, found that claim 8, of 564,586, did not refer to, or cover, the construction shown in Fig. 10, and was, therefore, manifestly for a different construction.

This question was quite fully before the Court of Appeals in this case, as set forth in Petitioner's Appeal Brief under Point 4, Subdivision E, page 94, etc., and the Court has considered of no importance this alleged new evidence of Martin and Wetzler as to what Mr. Berliner showed them in his bedroom in August, 1888.

There is no authority for Petitioner's contention that the pending application previously filed must *claim* the invention as well as illustrate and describe it. The effect of the decisions is that if the first application contains a disclosure of the subject-matter claimed in the second application, the rule of continuity applies. Walker on Patents, states (4th Ed., p. 84.)

> "An application which described a particular invention, takes date on the date of its filing, whether or not it claimed that invention at that time."
>
> See Edison v. American Mutoscope Co., 110 Fed. Rep., 662.
>
> Graham v. McCormick et al., 11 Fed. Rep., 859.

In the latter case, it was held that the two applications should be regarded as a continuous proceeding, and that the fact that the invention was not claimed in the first application made no difference.

In the case of Smith v. Dental Vulcanite Co. (93 U. S., 486), this Court held:

> "If, then, as we think it must be held, the proceeding to obtain the patent was a continuous one from 1855 until it was granted; if the application of 1855 is not severable from the proceedings of 1864, there is no foundation whatever for the allegation that the invention was abandoned to the public, and that it was in public use or on sale for more than two years before the inventor's application."

That the Court of Appeals in the Graphophone

case, as well as in the case at bar, was right in holding that the date of invention of claims 5 and 35 of the patent in suit could be carried back to the date of filing of the prior pending application for the Berliner patent, No. 564,586, is manifest from the numerous authorities.

Robinson on Patents, paragraph 580, note 4, states:

> "That where a second application is made for part of an invention *disclosed* in a former and still pending application, the latter is a continuation of the former so far as the question of two years' public use is concerned. See Graham *v.* McCormick, 11 Fed. Rep. 859."

Also in another note under this paragraph, it is stated:

> "That when applications are continuous they take the date of the original on questions of novelty and abandonment. See Henry v. Francestown Soapstone Stove Co., 2 Bann. & A., 221."

In Volume 22 of the Am. & E. Enc. of L. (2d Ed.), page 340, in discussing the time and continuance of the use or sale prior to the date of the application of patent which will defeat the patent, it is stated:

> "In the case of successive applications which may be considered as one proceeding, the public use or sale must have existed two years before the date of the first application in order to defeat the patent."

In support of this proposition, several authorities are cited, which will now be referred to:

In Stirling Co. v. St. Louis Brewing Assn., 79 Fed. Rep., 80, the application of the patent in suit was filed June 5, 1894, and the invention was shown to have gone into public use over two years prior to that date, and the record showed that an application for patent for the same subject-matter, so far as regards the claim in con-

troversy was concerned, was filed December 22, 1893, and the Court gave to the patent in suit the benefit of the filing date of the earlier application and states:

> "On these facts I hold that, so far as regards the defense of two years' public use, the claims sued on relates back to the first application, and hence, that the defense of public use is not made out. Godfrey v. Eames, 1 Wall., 317, 325; Smith v. Vulcanite Co., 93 U. S., 486, 500; Graham v. McCormick, 5 Ban. & A., 244, 248, 11 Fed., 859."

International Tooth Crown Co. v. Richmond et al., 30 Fed. Rep., 775, heard before Judges Wallace and Shipman, is to the same effect. In this case the application upon which the patent in suit was granted, was filed December 20, 1880, and there had been a public use of the invention over two years prior to that date, but the same inventor had filed a prior application for patent on January 9, 1879:

> "Which had never been abandoned for substantially the same invention."

As in the case at bar, the first application contained some matters foreign to the subject of the second application, and the Court held that it disclosed the invention of the claims of the patent in suit, and held that:

> "Both applications are to be considered as parts of one continuous proceeding, and the two years within which the invention could not be publicly used without invalidating the patent did not begin to run until January 9, 1879. Godfrey v. Eames, 1 Wall., 317; Smith v. Goodyear, etc., Co., 93 U. S., 500; Graham v. Geneva Lake, etc., Co., 11 Fed. Rep., 138."

In another case of Howe against Newton, 12 Fed. Cas., Case No. 6771, before Justice Clifford and Judge Lowell, it was decided that two applications pending at the same time in the Patent Office, and embodying the

same invention, are continuous, and that the public use for two years prior to the date of the second application would not defeat the patent, as the date to be given the second application was, so far as relates to the defense of public use, the date of the original application.

In the case of Henry v. the Francestown Soapstone Stove Co., 2 Ban. & A., 221, and 11 Fed., Case No. 6382, it was stated that:

> "It has frequently been held that the date of filing the application on which the patent was granted is not the date on which the time of use or sales is to be reckoned, but that the time is to relate back to the date of *any* copending application."

In Bell v. Daniels, 3 Fed. Cas., Case No. 1247, it was held that where a second application was filed before abandonment of the first application, that the two years during which the invention might be used before the application without working abandonment, or in other words, public use, must be dated from the first application. It was held that where the first application, or first two prior applications, were not abandoned, that so far as the defense of public use was concerned, the date of the application upon which the patent eventually was patented dates back to the first application.

As in the case at bar, where the subject-matter of the claims in question of the second application was embraced in the first application, it was held in Graham v. McCormick et al., 11 Fed. Rep., 859, that:

> "The subject-matter of the second application was embraced in the first, and the invention now in controversy was described in the specifications and the drawings which constitute part of the first application, and we think it may be said that the continuity of the proceeding which originated in the first application was not broken up to the time when the patent for the invention in suit was granted in 1868. See also Blandy v. Griffiths, 3 Fish., 616."

In the Circuit Court of Appeals for the Eighth Circuit, in Hayes-Young Tile Plate Co. v. St. L. Transit Co., 137 Fed. Rep., 80, Judge Sanborn held as follows:

> "In cases in which the first application has not been abandoned, subsequent applications and amendments constitute a continuance of the original proceeding, and the two years' public use or sale which may avoid the patent, must be reckoned from the presentation of the first application, and not from the filing of subsequent applications or amendments. U. S. *v.* American Bell Telephone Co., 167 U. S. 224, 17 Sup. Ct. 809, 42 L. Ed. 144; Colgate *v.* Western Union Tel. Co., Fed. Cas. No. 2,995; Miehle *v.* Read, 96 O. G. 426; Thomson-Houston Electric Co. *v.* Winchester Avenue R. Co. (C. C.) 71 Fed. 192, 73 O. G. 2155; Godfrey *v.* Eames, 1 Wall. 317, 17 L. Ed. 684; Smith *v.* Goodyear Dental Vulcanite Co., 93 U. S. 486, 23 L. Ed. 952; Cain *v.* Park, 14 App. D. C. 42, 86 O. G., 797, 798; *Ex parte* Stewart, 4 O. G., 665; Stirling Co. *v.* St. Louis Brewing Ass'n (C. C.), 79 Fed. 80; Dederick *v.* Fox (C. C.), 56 Fed. 714, 717; Ligowski Clay-Pigeon Co. *v.* American Clay-Bird Co. (C. C.) 34 Fed. 328, 333."

The attention of the Court, in passing, is here called to a misleading and unwarranted statement which occurs in several places in the Petition (p. 121), where it is stated that Mr. Berliner, in the prosecution of the Werner Suess-Canadian application, filed May 5, 1891, "asserted under oath" that Werner Suess was the inventor of the subject-matter of claims 5 and 35 of the patent in suit. While Mr. Berliner was the assignee of Werner Suess, of the Canadian application, he nowhere made such an oath, nor is any such oath of record in this case.

Petitioner's counsel contends (Petition, p. 22) that claims 5 and 35 of the patent, in suit, are limited to details of improvement, such as illustrated in the sound boxes of Figs. 6 and 7 of the patent, in suit; this, however, is a mere argument, unwarranted in fact; the finding of the fact by

both the Circuit Court and the Circuit Court of Appeals in this suit, as well as in the Graphophone case, is unanimously to the contrary.

Manifestly, the alleged two years' prior public use, and alleged abandonment, have not been proven, and the Petitioner has absolutely failed of proof in this regard.

Re Petitioner's Fourth Point.

Under this point, the Petitioner contends that claims 5 and 35 of the patent in suit are invalid, because Berliner became the assignee of the Werner Suess application for patent filed in Canada about May 5, 1891, upon which Letters Patent of Canada, No. 41,901, were granted February 11, 1893. This was for substantially the same invention as patented to Werner Suess in the United States, No. 427,279, filed August 6, 1889, but included one or two broader claims than those contained in the Suess U. S. application. Petitioner's attorney says, on page 21, that Berliner, in this Canadian application, "asserted under oath" that this was the sole invention of Werner Suess. This is not true, as Mr. Berliner, in the Suess Canadian application, made no such oath.

Berliner's relation to the Suess swinging arm invention and the Suess application is fully shown in the following consideration of this Suess Canadian patent.

The Suess Canadian Patent Considered.

The drawings of the Canadian Patent are identical with the drawings of the Suess U. S. Patent, 427,279 (Stipulation, Record, p. 540). The specification is printed on pages 157 to 168 of the Record. It states:

> "My invention has reference to improvements in the reproducing apparatus, adapted for use in the method of recording and reproducing sounds *heretofore invented and published by Emile Berliner.*"

It will be remembered that Mr. Berliner's invention of claims 5 and 35 was "PUBLISHED," as stated in the Suess-Canadian specification, in the *Electrical World* of November 12th, 1887 (Record, p. 255), which publication was known to Mr. Suess, as he was present on May 16th, 1888, when Mr. Berliner delivered his Franklin Institute lecture in Philadelphia, describing this, his, Berliner's invention, when he, Berliner, stated, referring to the *Electrical World*, "In the description of November 12th, 1887, I advanced the idea of mounting the sounder on a carriage and rails and have the record groove itself to be the screw which was to guide the point of the stylus across the disc from periphery to centre."

Mr. Berliner then stated that this had been improved upon by Mr. Werner Suess, who was present with him there that evening, at the time of the delivery of the lecture, by pivoting the arm carrying the reproducer on a suspended rail, as illustrated, for instance in Fig. 10 of Patent No. 564,586.

This publication of the *Electrical World* of November 12th, 1887, also stated, on page 243 of the Record.—

> "If now the engraved record is rotated with uniform speed, and the stylus be held in the groove, the end of the stylus will be forced to follow the undulations of the groove, and any vibratory surface attached to the stylus will be vibrated positively in both directions in strict accordance therewith; and will therefore reproduce the exact sounds which originally produced the record."

The *Electrical World* further states (Record, p. 244), after describing one way to mount the phonautogram:

> "Another way is to mount the phonautogram on a circular wooden resonant box, which simply rotates without progressive motion, and to press an ivory point into the groove. In this case the hand which holds the ivory easily follows the groove and the point

is led along the volute of the record, and vibrates the sound box by undulatory shocks.

"This suggests the plan of mounting the reproducing diaphragm and stylus on a carriage moving on rails, and permitting the point of the stylus not only to vibrate, but also to push the carriage across the revolving disc, and thereby follow the volute of the sound record.

"Mr. Berliner believes that it is more than likely that the gramophone is destined to fulfill many of the expectations which were placed ten years ago on the phonograph, and which are partly realized by the graphophone"——

Mr. Suess, in making this statement in the specification of his Canadian application, which was sworn to by him on April 13th, 1891, specifically recognizes Mr. Berliner as the inventor of this invention which had been thus published, among other places, in the *Electrical World*, November 12th, 1887, and a description of which invention was also published in the *Journal* of the Franklin Institute in June, 1888, the lecture having been delivered May 16th, 1888. (See Record, pp. 245 to 273.) It will be noted on page 273 of the Record that at the conclusion of this interesting paper before the Franklin Institute, the well-known electrical inventor, Dr. E. J. Houston, moved a vote of thanks to Mr. Berliner "for his interesting and valuable communication."

The "main features" of the Suess Canadian relate to details of construction.

The attention of the Court is directed to this Suess Canadian application (assigned to Mr. Berliner), a careful reading of which will show that Mr. Suess did not claim to be the inventor of this broad invention, but *admitted Mr. Berliner's prior invention*, and, in effect, stated that the features of his, Suess', present invention in this Canadian application related to certain detail improvements.

Among other improvements, the specification notes,

first, that as the weight of the intensifying horn is carried by the reproducer, it should be supported and balanced, so that the recording stylus "will bear with light, but sufficient pressure upon the record tablet."

His other feature is a lazy tongs construction of frame for making the stylus travel in a straight radial line.

The means which he shows for counterbalancing is illustrated in Fig. 1 of the Suess U. S. Patent, No. 427,279 (Record, p. 446), of which the Canadian drawings are a copy. The means for making the path of the stylus travel in a straight radial line are shown in Fig. 3 of the drawings, having a lazy-tongs construction.

The specification then describes in detail the constructions illustrated in the drawings.

The specification contains no broad statement of invention whatever, and is confined to the details referred to.

Claim II, while broadly worded, if valid at all, must, in view of the admission in the specification of Mr. Berliner's invention, and in view of the statement that the main features of the Suess invention refer to certain details be narrowly interpreted. Claim II, which is the most broadly worded claim of the patent, reads as follows:

> "11. In an apparatus for reproducing sounds from a rotating record tablet, a reproducing stylus mounted to have a free movement over the surface of the record tablet, substantially as described."

The words "substantially as described," it is submitted, should be understood as limiting this claim, if it is valid at all, to the lazy-tongs construction illustrated in Fig. 3 for making the reproducing stylus travel in a straight radial line across the record tablet.

Claim 5 reads:

> "5. In an apparatus for reproducing sounds from a record tablet, the combination with a reproducer mechanism consisting of a sound conveying tube and

> a diaphragm and stylus mounted at one end of the tube, of a freely swinging supporting frame for the said reproducer mechanism, substantially as described."

In view of the statement that the main feature of the invention, other than the counterbalancing feature, was the mechanism for making the path of the stylus across the face of the record disc as nearly as practicable a straight radial line, the words of the claim, "of a freely swinging supporting frame for the said reproducer mechanism, substantially as described," evidently refer to the lazy-tongs construction shown in Fig. 3 of the drawings.

Even if it referred broadly to the pivoted swinging arm, it would not conflict with claims 5 and 35 of the patent in suit, as those claims have no such restrictions, or requirements, in them.

Claim 7 of the Canadian Patent reads:

> "7. In an apparatus for reproducing sounds from a record tablet, the combination with a reproducer mechanism consisting of a sound conveyer, and diaphragm and stylus mounted at one end thereof, of a supporting frame for the said reproducer, loosely pivoted to swing freely both laterally and vertically, substantially as described."

The same comment directed to claim 5 also applies to claim 7.

Claim 12, which need not be quoted, specifically includes "a swinging lever system," referring to the lazy-tongs construction of Fig. 3 of the drawings, as does also claim 13 include "a lever system," referring to the same construction.

It is, therefor apparent that this Canadian Patent was not intended for any broader invention than the Suess U. S. Patent, No. 427,270, and did not describe any broader invention than that patent; the Court of Appeals in the Graphophone Case, affirming the Circuit Court, held in this connection:

> "The primary object of Suess, an employee of Berliner, however, was merely to construct a suitable pivotal support for the diaphragm and stylus, so as to assist such device in its passage across the record. It is expressly stated in the specification of the Suess Patent that the invention relates to improvements in the reproducing apparatus of Berliner, and that the construction and mounting of the stylus form no part of the invention."

We submit that Judge Townsend in the Court below was right in granting the preliminary injunction, though he was apparently mistaken in his conclusion where he stated (Record, p. 325), "The Canadian Patent in terms describes and claims the broad generic invention of Berliner, covered by the claims here in suit."

Petitioner's counsel apparently bases his whole contention relative to this Suess Canadian Patent upon claim 11.

It is upon the basis of this claim, or these claims, notwithstanding the true and proper interpretation of the specification which should be given to them, Petitioner contends that the fact that these claims (interpreted as Petitioner interprets them), were inserted in the Canadian Patent, conclusively proves that, as Berliner was the assignee of this application, *Berliner thereby admitted that Suess, and not he, was the inventor of claims* 5 *and* 35.

It is respectfully submitted that there is no warrant in this Canadian patent for this assumption, but that the evidence is conclusive, as adjudicated by the Court in the Graphophone case, that Berliner was the inventor as early as November, 1887, and there is no evidence in this case to affect that decision.

The fact that Berliner subsequently applied for and secured his Canadian patent, No. 55,079, for his invention in suit, containing claims 5 and 35, corresponding in all material respects in drawings, specification and claims to the patent in suit, No. 534,543 is, we submit, further conclusive evidence that neither Berliner nor

the Canadian Patent Office considered that the Suess-Canadian patent contained his invention of the patent in suit, otherwise he would not have subsequently patented it in Canada, as he did.

The Berliner Canadian patent, No. 55,079, was applied for by him December 7, 1895, and issued February 24, 1897 (Case, pp. 330 to 333). It is admitted that this Canadian patent is identical with the patent in suit (Case, p. 333).

On page 25 of the Petition, after quoting from page 1, lines 17 to 36 of the patent in suit, it is stated by the Petitioner that, "This is the patentee's expressed declaration of the features of improvements contained in the patent, *and no other declaration whatever* of any other feature of improvements is to be found elsewhere in the patent."

That this is a very misleading statement, and not warranted by the facts, is shown by reference to the patent in suit, p. 1, lines 8, etc., where it is stated:

> "My invention has reference to improvements in the method of and apparatus for recording and reproducing sounds, the improvements being more particularly directed to the construction of that kind of sound recording and reproducing apparatus which I have called 'gramophone,'—"

The argument of Petitioner's counsel in connection therewith goes for naught.

It is apparent, from a careful reading of the patent in suit, that the patentee has expressly stated, among other things, that his invention has reference to improvements in **the method of and apparatus for reproducing sounds,** both of which he afterwards specifically claims, the method by claim 5, and the apparatus in claim 35.

The attention of the Court, as to this attempt of the Petitioner to misconstrue the patent in suit, is called

to Respondents' Appeal Brief, p. 47, etc. The statement made in the Petition, in this respect, is unfair, unwarranted and misleading.

Neither the Circuit Court nor the Court of Appeals have held that the patent included features not enumerated by Berliner, as stated at the bottom of page 25 and the top of page 26 of the Petition, but the Courts have, in their decisions, consistently followed the patent and given to it the proper, reasonable and fair construction.

The Petitioner's contention that the Suess-Canadian patent, No. 41,901, granted February 11, 1893, anticipates the patent in suit is without foundation.

As shown by the decision of Judge Hazel in the Graphophone case, affirmed by the Court of Appeals, and as shown by the Suess patents themselves, Suess merely devised certain improvements upon the Berliner gramophone in suit, and Suess never laid claim to antedating Mr. Berliner's invention in suit. As before pointed out, the Suess-Canadian patent specifically states:

> "My invention has reference to improvements in the reproducing apparatus, adapted for use in the method of recording and reproducing sounds *heretofore invented and published by Emile Berliner.*"

All this had been passed upon and decided in the Graphophone Case and was *res adjudicata*, and did not need to be again reviewed in the suit against Leeds & Catlin by the same Court.

Mr. Berliner's position was consistent, as stated in his Franklin Institute lecture of 1888, that he was the inventor of the recording and reproducing apparatus, and that Suess was the inventor of a minor improvement, to wit, the pivoted swinging arm, described and claimed in the Suess United States patent, No. 427,279.

Petitioner's contentions to the contrary are, we submit, futile and without foundation.

Re Petitioner's Fifth Point.

The Fifth Point raised by the Petitioner (Petition, p. 28) is substantially similar to that raised by the Fourth Point, just considered. The Petitioner contends, under the Fifth Point, that Berliner, in becoming the assignee of the application for the Suess Canadian patent, No. 41,901, granted February 11, 1893, filed May 5, 1891, abandoned his claim to the invention of claims 5 and 35.

This point is fully answered and considered in Respondents' Appeal Brief, under Point Seven, page 136, etc. The cases cited by the Petition do not support its proposition.

The Suess Canadian patent, in the specification and drawings, was as narrow and as restricted as the Suess United States patent, No. 427,279, which the Court, in the Graphophone case, decided was for an improvement on the Berliner invention, and not for the broad claim of the Berliner invention.

In fact, if anything, the Canadian specification even more specifically admits Berliner's broad invention, as heretofore pointed out, as it states:

> "My invention has reference to **improvements** in the reproducing apparatus, adapted for use in the method of recording and reproducing sounds **heretofore invented and published by Emile Berliner.**"

This is a broad and far-reaching statement.

It is sworn to by Suess, and if the Petitioner's contention is true, that it is acquiesced in by Berliner because he was the assignee, this statement also would naturally be acquiesced in by Berliner.

The only means shown and described in the Suess Canadian Patent for traveling the reproducing stylus in a straight radial line, is the "lazy-tongs" construction shown in Fig. 3 of the drawings. When the straight arm shown in Fig. 1 of the drawings, was used with the counterbal-

ancing weight, the reproducing stylus did not travel in a straight radial line, as shown in the Canadian specification (Record, pp. 161 and 162), where it states, fol. 483:

> "As the rotation of the tablet is continued, the convolutions of the record groove will cause the stylus to be slowly drawn across the tablet, turning the entire support of the reproducing apparatus on its pivot bearing, the said stylus moving along a *slightly curved path* over the said tablet."

Fig. 1 showed the improvement relative to the adjustable counterbalancing weight.

The only construction for making the reproducer travel in a straight radial path, is that shown in Fig. 3, with an articulated frame so arranged that the stylus will travel in the path of the straight dotted line shown in the lower portion of Fig. 3. The specification states, in describing this (Record, p. 163, fol. 488):

> "The outer ends of the links 50 are pivoted to opposing corners of an articulated frame 51, composed of links 52, of equal length, connected together at the ends by pivot pins 53, 54, 55 and 56, respectively, the pins 54 and 55 also connecting the link 50 to the frame at the points before mentioned.
>
> "The pin 56, also pivotally connects one end of a link 57 to the corresponding corner of the frame 51, the other end of the said link being pivoted to the outer end of the arm 44.
>
> "The frame 51, together with the links 50 and 57, constitutes a well-known mechanical movement, by which a curvilinear movement is converted into a rectilinear movement, provided the various links have the proper relative lengths; which is supposed to be the case in this instance, and, therefore, no detailed description of the operation thereof is deemed necessary."

If these claims 5, 7 and 11 should be broadly interpreted, as contended for, the mere fact that this Canadian

patent contains such claims could not possibly prove abandonment by Berliner of his invention of claims 5 and 35, merely because he happened to be the assignee of the application and patent.

The **specification** was **not executed, or sworn to, by Berliner,** but by Werner Suess. The fact that the application was conducted in the interests of Berliner, by reason of the assignment to him by Suess, certainly cannot be construed to operate, on such grounds as these, as an abandonment by Berliner of his invention.

Berliner had long previously placed himself indisputably upon record as the inventor of claims 5 and 35, and was so recognized by the scientific public. **The great scientific institute of this country, the Franklin Institute, recognized his invention and honored him with an invitation to address the society upon the subject in May, 1888.**

Further, the proofs in this case are conclusive that Berliner was the inventor of the invention as early as November, 1887, and he so declared himself to be such *in the presence of Suess* in his lecture of May 16, 1888, at the Franklin Institute.

Suess never controverted this proposition, but on August 16, 1889, considerably over a year after the Franklin Institute lecture, filed his application for United States patent, No. 427,279, **in which he laid no claim to being the inventor, and in which he restricted his invention to five narrow, limited claims.**

The Suess Canadian patent was filed by Suess, May 25, 1891, over a year and a half after the filing of the application for the Suess United States patent.

The Suess U. S. Patent was also assigned to Mr. Berliner *before issue*, and if Mr. Berliner regarded Suess as the inventor of claims 5 and 35, he would have had such claims incorporated in the Suess U. S. Patent, in order that this most important invention should be protected properly.

As hereinbefore shown, Berliner never did consider that the Suess Canadian Patent, of which he was the assignee, covered the invention of the patent in suit, as is manifested by the fact that on December 7, 1895, he applied for a Canadian patent, with the same drawings, description and claims as the patent in suit, No. 534,543, which Canadian patent was issued to him, No. 55,079, on February 24, 1897. (Record, p. 315, etc.)

This, we submit, is conclusive evidence that Mr. Berliner did not regard the prior Suess Canadian Patent as containing the invention of the U. S. Patent in suit, and is conclusive evidence that there was nothing in the Suess Canadian patent which was intended to convey any intention on his part, directly, or indirectly, to abandon the invention of the patent in suit.

Even if there had been an abandonment, which there was not, in Canada, this would have been no evidence of abandonment of the United States rights.

There could be no presumption of abandonment for the further reason that, as shown by the decision of the Court of Appeals in the Graphophone Case, Berliner had an application filed in the United States Patent Office, which included the invention of claims 5 and 35 of the patent in suit, long prior to the date of filing of the Suess Canadian Patent, filed May 5, 1891. I refer to Mr. Berliner's application for U. S. Patent No. 564,586, which was filed November 7, 1887, and which included Fig. 10, and a description thereof. While the said invention was not claimed in that case, Mr. Berliner was at liberty to put in such claims at any time during the pendency of the case. The Courts have properly decided that his second application, the application for the patent in suit, filed March 30, 1892, in this respect dated back to November 7, 1887, the date of filing of his other application. This of itself precludes any presumption of abandonment or estoppel, as contended for by the Petition

under the Fifth Point, as well as under some of the other points.

It is respectfully submitted that the Petitioner's contentions relative to the Suess Canadian patent are without foundation.

RE PETITIONER'S SIXTH POINT.

Under this point, the Petitioner contends that the patent in suit expired with the lapsing of the Suess Canadian Patent, which lapsed at the expiration of the six year term, by reason of the failure to pay the renewal fees. (See Petition, p. 29.)

The attention of the Court is respectfully called to the consideration of this question in Respondents' Appeal Brief —Point Eight—pages 142 to 164, and the authorities therein cited.

Even if the Suess Canadian patent had been for the same invention as claims 5 and 35 of the patent in suit —which we deny—the **term of eighteen years** of this patent, for which it was granted, has not yet expired, and the Berliner patent in suit could, therefore, not be affected.

The fact that the Suess Canadian patent lapsed on February 11, 1899, at the end of six years, by reason of the failure to pay the renewal fees, can have no effect upon the term of the Berliner United States patent, No. 534,543, in suit, under the authorities.

This Suess Canadian patent states that it was granted **"for the period of eighteen years from the date of these presents,"** as appears upon its face. (Record, p. 156.)

It is also stated in the grant:

> "The partial fee required for the term of six years having been paid to the Commissioner of Patents, this patent shall cease at the end of six years from date, unless at or before the expiration

of the said term the holder thereof pay the fee required for the further term or terms, as provided by law."

It is respectfully submitted, under the well settled authorities, that in construing Section 4887, the period of the prior foreign patent to be taken into consideration with the domestic patent, is the *longest possible term of the foreign patent;* is the period of duration expressed in the grant; or, in other words, the duration of the United States patent is fixed when the United States patent issues by the longest possible term of the foreign patent, and shall not be subject to be terminated by the occurrence or non-occurrence of certain facts which would require extraneous proof.

The attention of the Court is directed to the authorities cited in the Respondents' Brief, as noted.

It is respectfully submitted that the decision of this Court in the case of Pohl *et al. v.* Anchor Brewing Co., (134 U. S., p. 381), cited in the Respondents' Appeal Brief, (p. 145, etc.), is conclusive, and in strict accord with the respondents' contention.

Attention is also directed particularly to the decision in the case of Diamond Match Co. *v.* Adirondack Match Co. *et al.* (65 Fed. Rep., p. 803).

It is respectfully submitted that this question is too well settled to occasion any serious discussion.

Re Petitioner's Seventh Point.

Under this point the Petitioner (Petition, p. 30), contends that claims 5 and 35 of the patent in suit are anticipated by the Edison British Patent, No. 1644, of 1878.

This subject is very fully considered in Respondents' Brief, under Point Ten (p. 182 to 185). This defence was not only before the Circuit Court, and Court of Appeals, in this suit against Leeds & Catlin, but also in the suit against the Graphophone Company, and there is abso-

lutely nothing in this Edison British Patent which could be considered as an anticipation of the claims in suit.

In the case of the American Graphophone Company *v.* Leeds *et al.*, 87 Fed. Rep., 874, which was a suit for alleged infringement of the Bell & Tainter patent, No. 341,214, this Edison Patent, No. 1644, of 1878, was very much in evidence. Judge Shipman's adjudication of this patent as a reference in that case, is quite to the point here, especially as he considers Fig. 34, to which Mr. Goss, Petitioner's witness in the present case, has attached so much importance. Judge Shipman says, in referring to this Edison British Patent:

> "This patent contained some of the suggestions and sketches of various sorts and kinds which Mr. Edison had thought of or had made during his experiments upon a subject novel, intricate and scientific, which required manifold and delicate experiments, and in which he took a great interest. Some of his surmises and beliefs in regard to what could be or might be done were thrown into this patent. The defendants' expert, with manifest consciousness of the difficulties in the text, translates the language of the descriptions of Figs. 27, 34 and 37 to mean that Edison had in mind gravity reproducer, or to show that such a reproducer can be inferred from the language. These descriptions are confessedly vague, and it is confessedly different to know the interpretation which the writer placed upon some of the words which he uses."

Re Petitioner's Eighth Point.

This point raised by the Petitioner (Petition, p. 31) is a contention that the claims of the patent in suit were anticipated by the Bell and Tainter patent, No. 341,214, issued May 4, 1886.

This was one of the main alleged anticipations to the claims of the patent in suit in the suit against the American Graphophone Company. Both the Circuit Court, and

the Circuit Court of Appeals, had this defence most fully before them in that case, and after a full argument, by brief, and orally, and after most careful consideration, found the fact that this Bell and Tainter Patent did not disclose the invention of claims 5 and 35, as fully set forth in the decision of Judge Hazel in the Graphophone Case, affirmed by the Court of Appeals in a *Per Curiam*.

Mr. Berliner's invention departed widely from the Bell and Tainter graphophone shown in the patent No. 341,214, and was based on radically different lines, utilizing the vertically undulating record groove. The Bell and Tainter graphophone, of patent No. 341,214, as well as the Edison phonograph of the prior art, required, in the very nature of the devices, that the reproducing stylus, in order to be kept in engagement with the sound record in the spiral groove, should be **positively propelled by a supplemental mechanical feed screw** from the beginning of the spiral record groove to the end thereof; and as the reproducing stylus must at all times, throughout the reproduction, from the beginning to the end of the record groove, be as nearly as possible in intimate contact with the record in the groove which is being reproduced, it is necessary, as far as possible, that the spiral of the supplemental feed screw should be the same pitch as the spiral of the record groove.

Berliner, however, in his invention of the combination of claim 35, operated by the method of claim 5, produced *a radically different reproducing device, and method of reproducing*. Mr. Berliner discovered that the reproducing stylus could be acoustically vibrated and simultaneously propelled by the laterally undulating even depth record groove itself, formed in a disc of hard material, without impairing in any manner the reproduction of the sound waves, and that better and more accurate results could be obtained, among other things, in that the reproducing stylus was, in such a device, always in immediate intimate

contact with the sound record in the groove which it was reproducing, and there was no danger of skipping, or eliminating, any portion of the record groove in the reproduction, as was liable to occur in the Bell and Tainter graphophone, or in the Edison phonograph. It also enabled Mr. Berliner to dispense with the somewhat complicated auxiliary feeding screw; simplified very much the reproducing device, and allowed it to be produced at considerably less expense.

The small rubber neck or universal joint shown in the Bell and Tainter Patent, No. 341,214, referred to in the Petition, was for a different purpose, to allow the reproducing stylus to slide down the sides of the record groove to keep in contact with the record, and in a measure to prevent the stylus from jumping out of the groove, in case of any irregularity between the feed screw and the spiral of the record groove, known as "drunkenness" of the record. In the construction of the Bell and Tainter patent, however, it was not possible to feed and simultaneously vibrate the stylus through the medium of the record groove across the record, which was of the vertically undulating type, and the device could not possibly operate without the auxiliary feeding screw.

All this was most thoroughly considered in the cases before the Circuit Court and Circuit Court of Appeals, and Mr. Berliner was held to have been **the pioneer inventor** of this type of talking machine, and that there was nothing in the prior art to anticipate it, notwithstanding the hardest kind of a fight, and strongest opposition in the Graphophone Case, as well as in the Leeds & Catlin and Talkophone cases.

Re Petitioner's Ninth Point.

The Petitioner's contention, under this point, is that claims 5 and 35 of the patent, in suit, are invalid as being claims for the function of a machine.

There should be no question upon this subject, as claims 5 and 35 have been held to be patentable by Judge Hazel in the Graphophone case, and by the Court of Appeals, consisting of Judges Lacombe, Townsend and Coxe in affirming the decision of Judge Hazel in that case (145 Fed. Rep., 351), and in the Circuit Court by Judge Townsend on motion for preliminary injunction in this case against Leeds & Catlin Company, and in the suit against the Talk-O-Phone Company, and by Judges Wallace, Lacombe and Coxe, in the Court of Appeals, affirming the decision of Judge Townsend (148 Fed. Rep., 1022). Judge Lacombe, subsequently, granted the order holding the Leeds & Catlin Co. in contempt (150 Fed. Rep., p. 147), which order was affirmed by the Court of Appeals by Judges Hough and Coxe, Judge Wallace dissenting, in the contempt proceeding only.

Judge Wallace's intimation in the contempt proceedings that claim 5 "covers merely the function of the machine," and quoted on page 35 of the Petition, is mere *dicta*, and cannot effect the opinion of the Court of Appeals in which he joined in affirming the decision of Judge Townsend in the injunction proceedings against this Petitioner, the Leeds & Catlin Company sustaining the validity of both claims 5 and 35. He does not even state, in the contempt proceedings, as might be inferred from the Petitioner's statement on page 35 of the Petition, that the claim 5 is void, but merely suggests "that it is more than doubtful whether the claim (5) is not void upon its face."

(The Petitioner refers frequently throughout the brief to the certain memorandum alleged to be a copy of an oral decision of the Circuit Court of Appeals printed on pages 41 to 46 of the Petition, which is not a part of the record case, and not certified to. This, it is submitted, should not be considered, no matter which side it benefits.)

Claim 5 reads as follows:—

"5. The method of reproducing sounds from a record of the same which consists in vibrating a stylus and propelling the same along the record by and in accordance with the said record, substantially as described."

We have here the mode or method of producing something, the producing, or rather the *reproducing* of sound. This is entirely distinct from the apparatus which may be used for the purpose of carrying out this method, or mode, of reproducing sound, which apparatus may be constructed in several different ways.

The method consists in phonetically vibrating the stylus by the record undulations, and at the same time, by the same means, advancing, or propelling, the phonetically vibrating stylus across the record tablet throughout the entire length of the sound record to be reproduced.

The term "method" here is not used subjectively, or passively, as applied to the machinery operated on, but *actively*, as a method, or mode, of producing, or rather reproducing, something, to wit, sound.

As herembefore pointed out, it remained for Mr. Berliner to discover, in November, 1887, that a phonetically vibrating stylus, vibrated by and in accordance with a sound record, could be simultaneously advanced, or propelled, throughout the entire record, by using the side walls of a helical groove as the propelling means simultaneously with the communication of the phonetic vibrations, without destroying, or impairing, the phonetic vibrations of the stylus point, and consequently without interfering with the true reproduction of the sound recorded upon the record.

This new method was the result of this discovery.

The method, or art, of carrying out an invention, or discovery, does not necessarily involve any particular means for employing, or using, that method.

AUTHORITIES RE PATENTABILITY OF METHOD.

Perhaps the most pertinent and applicable cases upon the subject are the Telephone cases (126 U. S., 1). Those cases, like the present case, involved the transmission of sound. The claim in controversy in that case was the fifth claim of the Bell patent, which read as follows:

> "5. The method of, and apparatus for, transmitting vocal or other sounds telegraphically, as herein described, by causing electrical undulations, similar in form to the vibrations of the air accompanying the said vocal or other sounds, substantially as set forth."

In other words, this claim was for transmitting sound, telegraphically *by causing electrical undulations*, which undulations were similar in form to the vibration of the air accompanying the sound. Electrical undulations were caused, or produced, by the voice, or otherwise, and transmitted telegraphically on a wire to a distance. Mr. Berliner reproduced recorded sound by causing the phonetically vibrating stylus, vibrated by the record groove, to travel through the entire length of the record groove solely by the impingement of the side walls of the record grove, without destroying, or impairing, the vibrations of the stylus representing the sound waves, and thereby securing the best results by automatically maintaining *the stylus point in absolutely proper co-relation with the record in the record groove, as it traveled throughout the entire length of the record groove*, or as the entire length of the record groove traveled past the stylus point.

The fact that Bell employed electricity in the Telephone case, for causing the sound undulations, in no manner affects the applicability of the decision in that case to the facts of this case, as electricity for transmitting messages was old, the novelty consisting in Mr. Bell's method of using, or training, the electricity to his purposes.

Mr. Chief Justice WAITE, in delivering the opinion in

this case, commenting upon the case of O'Reilly *v.* Morse, 56 U. S., 15 How., 62, said:—

> "In the present case the claim is not for the use of a current of electricity in its natural state as it comes from the battery, but for putting a continuous current in a closed circuit into a certain specified condition suited to the transmission of vocal and other sounds, and using it in that condition for that purpose. We see nothing in Morse's case to defeat Bell's claim; on the contrary, it is in all respects sustained by that authority. It may be that electricity cannot be used at all for the transmission of speech except in the way Bell has discovered, and that, therefore, practically his patent gives him its exclusive use for that purpose, but that does not make his claim one for the use of electricity distinct from the particular process with which it is connected in his patent."

See also American Bell Telephone Company *v.* Dolbear, 15 Fed. Rep., 448.

We do not dispute the proposition that a valid patent cannot be obtained for a process which involves nothing more than the mere operation or function of a piece of mechanism. Any number of cases can be cited by the defendant to this effect.

As said by Mr. Justice GREER, in the case of Corning *v.* Burden, 56 U. S., 15 How., 250:

> "It is when the term 'process' is used to represent the means or method of producing a result that it is patentable, and it will include all methods or means which are not affected by mechanism or mechanical combinations. But the term 'process' is often used in a more vague sense, in which it cannot be the subject of a patent. Thus we say that a board is undergoing the process of being planed, grain of being ground, iron of being hammered or rolled. Here the term is used subjectively or passively as applied to the machinery operated on, and not to the method or mode of producing that operation, which is by mechanical means, and

the use of a machine, as distinguished from a process. In this use of the term it represents the function of a machine, or the effect produced by it on the materials subjected to the action of the machine. But it is well settled that a man cannot have a patent for the function or abstract effect of the machine, but only for the machine which produces it."

This, we think, clearly distinguishes the difference between a patentable method, which actively produces something, and the mere function of a machine, as such.

This present question in this case involves, not so much the citation of authorities as to what is a patentable process, as it does the application of the well-defined decisions of the Supreme Court of the United States, and of the United States Circuit Court of Appeals for the different Circuits, to the method before us.

It is, of course, not esential to the patentability of a process that the process should effect a *chemical* change in substances operated upon.

Melvin *v.* Potter, 91 Fed. Rep., 151.

No test which can be definitely applied to all cases to determine whether or not a process of manufacture is patentable, as such has been authoritively established.

Melvin *v.* Potter, *supra.*

In all cases where this Supreme Court of the United States, and the United States Circuit Court of Appeals, have denied the patentability of a process, as such, the invention claimed was, when analyzed, seen to be something which is subjectively, or passively, operated upon by the function of a machine, or by manual manipulation. Such a case is the celebrated case of Corning *v.* Burden, 56 U. S., 15 How., 252; also the effort to claim a principle is not patentable such as the principle and use of an element for a particular purpose, such as Morse's claim for the electric telegraph in O'Reilly *v.* Morse, 56 U. S., 15 How., 62.

In an improvement in a sewing machine by which the soles and uppers of boots and shoes could be sewed together by a particular kind of stitches, without any welt, the method was held not to be patentable.

McKay *v.* Jackson, 12 Fed. Rep., 615.

Again, a process for stiffening the heels of boots and shoes was not patentable.

Hatch *v.* Moffit, 15 Fed. Rep., 253.

So, also, the process of centering a pulley and grinding the ends of the arms, concentrically with the axis, and boring the center, and securing the rim to the spider, and grinding the face of the rim concentric with the axis of the pulley, and then grinding, or centering, the edges of the rim, was held not to be a patentable process, in an exhaustive opinion by Mr. Justice BROWN, Risdon Iron & Locomotive Works *v.* Medart, 158 U. S., 65.

The attention of the Court is called to this last mentioned case, in which the authorities are reviewed. The process in Locomotive Works *v.* Medart was unquestionably under the authorities, not a patentable process and is clearly differentiated from the method of claim 5, of the patent in suit.

We would call the attention of the Court to a number of the leading authorities, where the processes claimed were held to be patentable.

In the case of Tilghman *v.* Proctor, 102 U. S., 708, the claim was for the manufacturing of fat acids, and glycerine, from fatty bodies, by the action of water at a high temperature and pressure.

In Mowry *v.* Whitney, 81 U. S., 14 Wall. 620, the patent was sustained for an improved process for manufacturing cast iron railway wheels, by retarding their cooling by a second application of heat, until all the parts of the

wheel were raised to the same temperature, and permitting a gradual cooling.

In Cochran *v.* Deener, 94 U. S., 780, the process consisted in manufacturing flour by passing the ground meal through a series of bolting reels clothed with cloth of progressively finer meshes, and, at the same time, subjecting the meal to blasts, or currents, of air. This separated the finer flour from the impurities, so that the finer flour could be reground and rebolted.

In this latter case Mr. Justice BRADLEY defined the process as:

> "A mode of treatment of certain materials to produce a given result. It is an act or series of acts, performed upon the subject matter to be transformed and reduced to a different state or thing. * * * * The machinery pointed out as suitable to perform the process may or may not be new or patentable; whilst the process itself may be altogether new and produce an entirely new result. The process requires that certain things should be done with certain substances, and in a certain order, but the tools to be used in doing this may be of secondary consequences."

In the case of Melvin *v.* Potter, 91 Fed. Rep., 151, the process claimed was that of manufacturing linoleum floor cloth, which consists in forming a granulated linoleum composition into sheets of spongy texture, then cutting the sheets into shapes, arranging the shapes on a flexible back, and pressing them into the foundation.

Judge DALLAS in deciding this case, said, *inter alia*:

> "The question is not whether the mode of operation described and claimed by Melvin is chemical or mechanical, but whether it is in fact a process, or is merely an aggregation of mechanical functions. I find no warrant in the authorities for the assumption that, unless a chemical change be effected by a process, no patentable invention or discovery can be involved in it. It is true that in both Corning *v.* Burden and Locomo-

tive Works *v.* Medart processes involving chemical reaction were contrasted with methods which comprise nothing but successive mechanical steps to produce a merely mechanical change in the substances operated upon. In doing this, however, the courts were illustrating, not defining, the difference between a patentable and an unpatentable process."

In the case of American Fibre Chamois Co. *v.* Buckskin Fibre Co., 72 Fed. Rep., 508, Judge TAFT sustained the patentability of the process of rendering wood fibre paper soft and pliable, by moistening it with a thin water solution of gelatine, and then crumbling and pounding it, and finally drying and smoothing it; holding that it was not a mere mechanical process, or aggregation of functions within the doctrine of Locomotive Works *v.* Medart, *supra;* or within Cochran *v.* Deener, *supra.*

In case of Hake *v.* Brown, 37 Fed. Rep., 783, the patent was sustained for the process of making beveled edge cards in an opinion by Judge WHEELER (Southern Dist. of New York). The method consisted in ornamenting the edges by piling them obliquely, first, so that the slope of the pack will correspond with the desired bevel, compressing them, to hold them in that position, beveling, ornamenting and finishing the whole pack on the sloping edge, which will bevel, ornament and finish the edge of each separate card by each operation, and of successively treating the other sides, and ends of the pack in the same manner, by which means the whole pack was treated as readily as one card.

The first claim was for this *method* of treating cards, and the second for a *card* so treated.

Judge WHEELER, in deciding the case, said, *inter alia*:

"According to the evidence, bevel-edged cards were not new at the date of the orator's invention; neither was beveling in packs new; but arranging cards in oblique packs, and treating one side or end till all the cards were complete on that side or end, as if they

were one card, and treating the other side and ends successively in the same manner, does not appear by the requisite measure of proof to have been known before. By this process the packs can be grooved or embossed and ornamented in a manner to present beveled designs upon the edges of such cards which could not be produced by treating cards separately, and the making of bevel-edged cards of any design is greatly facilitated. This method seems to be ingenious and useful. Such an arrangement of mechanical operations, that produces a new and useful result, or an old result in an easier or better manner, is understood to be patentable. Cochrane *v.* Deener, 94 U. S., 789; Telephone cases, 126 U. S. 1, 8 Sup. Ct. Rep., 778. The first claim of the patent, therefore, appears to be good and valid for the method described.

"There is nothing new about the bevel-edged cards produced by this process, except that they are made in this way. They do not differ from those made in any other way, unless they do in design. The process does not inhere to the product, so that it differs from any like product made in any other way, as was the case with Cumming's invention of rubber plates and teeth, in Smith *v.* Vulvanite Co., 93 U. S., 486; or the driven well, in Eames *v.* Andrews, 122 U. S., 40, 7 Sup. Ct. Rep., 1073. The product itself here is old in the sense of the patent law, and there can be no patent for it, although produced in this new way. McCloskey *v.* DuBois, 8 Fed. Rep., 710, 9 Fed. Rep., 38; McCloskey *v.* Hamill, 15 Fed. Rep., 750. The second claim of this patent, therefore, appears to be invalid."

In the case of Kirchberger *v.* American Acetylene Burner Co., 124 Fed. Rep., 764 (Northern District of New York), the Court held that the Dolan process of burning acetylene gas was patentable, which consisted in surrounding a jet of gas with an envelope of air at the discharge orifice of the burner, for the purpose of preventing its combustion in immediate contact with the burner, and until it had been projected some distance therefrom, and also for a burner tip adapted to carry out such process.

The Court held, in an opinion by Judge RAY, *inter alia*, that:—

> "An art or operation or process is an act or series of acts performed by some physical agent upon some physical object, and producing on such object some change either of character or of condition. It is said to be so far abstract that it is capable of contemplation by the mind apart from any one of the specific instruments by which it is performed. It is so far concrete that it consists in the application of physical force through physical agents to physical objects, and can thus become apparent to the senses only in connection with some tangible instrument and object. I Rob. on Patents, Sec. 159."

The Court held that *the process did not consist in the operation of the machine, or of the burner, and therefore it was not the function of the burner.*

The Court further stated:—

> "The application of a known force to known objects in a new manner is a new art. Foote *v.* Silsby, 1 Blatchf., 445 Fed. Cas., No. 4916; Higgs *v.* Goodwin, E. B. & E., 529. An art may be either a force applied, a mode of application, or the specific treatment of a specific object, and the art must produce physical effects; but it is, of course, distinct from the instrument which it employs, but any available instrument may be employed."

In the case of Chisolm *et al. v.* Johnson, 106 Fed. Rep., 191, the following process was held to be patentable, as such, and that it was not the mere function, or result, of a machine:—

> "The improvement in the art of hulling green peas, which consists in carrying the filled pods to an elevated position, and impacting the filled pods while falling so as to sever the connections of the two half shells of the pod and [of] the peas with the pods at one operation:

> "The process of gathering and hulling green peas consisting in removing the vines from the ground with the green peas attached subjecting the vines and attached peas while green to impact and separating the hulled green peas from the refuse."

So also Chisolm *v.* Randolph Canning Co., and Chisolm *et al.*, *v.* Canastota Canning Co., 135 Fed. Rep., 815-816.

In Eames *v.* Andrews, 122 U. S., 40, the Supreme Court of the United States sustained the Green driven well patent which covered a process which consisted in the driving a tube tightly into the earth, without removing the earth upwards, to serve as a well pit, and attaching thereto a pump, thereby putting into practical use the new principle of forcing the water in the water bearing strata of the earth into a well pit, by the use of artificial power to create a vacuum.

In the case of Dayton Fan & Motor Co. *v.* Westinghouse Electric & Mfg. Co., 118 Fed. Rep., 562, it was held that a patent for a process is not invalidated by reason of the fact that such process was disclosed in the prior patent for an apparatus, where there has been no dedication of the invention to the public.

It is respectfully submitted that citation of further authorities is unnecessary, and that the method claimed in claim 5, of the patent in suit, under the authorities cited, is clearly a patentable method.

This question of alleged want of patentability of claims 5 and 35 was most fully considered and argued before the Court of Appeals, as well as in the Court below in the Graphophone case, and the claims held to be valid and patentable.

Petitioner's counsel, at the bottom of page 35, attempts also to attack claim 35, because he says, "Claim 35 includes as an element a stylus 'free to be vibrated and propelled' by the record." He contends that this

is the function of the stylus, and argues that this claim, therefore, is not patentable, which we respectfully submit is without any foundation.

Re Petitioner's Tenth Point.

The Petitioner contends (Petition, p. 36) that claim 35 is void, "as being indefinite, meaningless and claiming nothing."

This question was also fully before the Circuit Court and Court of Appeals in the Graphophone case, and decided not to be worthy of consideration.

The language of claim 35 is perfectly clear and intelligible: the word "In," at the beginning of the claim, or the words "consisting of" could have been left out, but the structure intended to be claimed is perfectly clear and intelligible as it stands.

We submit, therefore, that this objection to claim 35 is trivial, and requires no further consideration.

Re Petitioner's Eleventh Point.

The Petitioner here contends (Petition, p. 37) that if claims 5 and 35 should be so construed, in view of the Suess Canadian patent, and in view of Edison's English patent, No. 1644, of 1878, as to limit their scope so as to restrict them to the construction of sound boxes shown in Figs. 6 and 7 of the patent, Petitioner would not infringe.

There is nothing tangible shown as to how or why these claims should be so restricted, and no plausible foundation laid for such a construction.

This question has been heretofore fully considered.

The Petitioner does not deny that its machine and records are made in accordance with the construction and method of operation of claims 5 and 35, as construed by the Court.

The affidavit of H. C. Kennedy (Record, p. 60, etc.) shows that the Petitioner's machine and records in this case are identically the same, except as to some ornamentation, as the respondents' machines and records, and the same as the defendants' machines and records in the Graphophone case.

RE PETITIONER'S TWELFTH POINT.

This contention (Petition, p. 37) is, in substance, that the questions here raised are pure questions of law, and present the whole case to the Court upon final disposition on the merits, and that if *certiorari* should be granted while the decree in this suit in an interlocutory decree granting injunction *pendente lite*, the Petitioner contends that the questions presented are questions of law, and that the case should be finally disposed of on its merits, and the bill dismissed.

It is submitted, on the contrary, that there are no new questions of law presented in this case; the main questions involved were questions of fact.

It is respectfully submitted that there are no such grounds in the present case for certiorari as those which existed in the case of Harriman v. Northern Securities Co., 197 U. S., 234, referred to by counsel for Petitioner, and that certiorari should not be granted.

This is a patent suit of the usual character, involving, of course, the construction and application of statutes, but these statutes have been construed again and again by this Honorable Court, as well as by the Court of Appeals, and the construction given to them by the Circuit Court and the Circuit Court of Appeals in this case, as well as in the Graphophone case, is a proper construction in accordance with the well-settled decisions.

The questions involved were mainly questions of fact, as to whether the facts of the case at bar were

such as to bring the case within the statutes Secs. 4886 and 4887, and the Courts have very properly decided that they were not. This, practically, is all there is to this case.

This is clearly not such a case as to warrant the interposition of this Court in granting the petition for Writ of Certiorari.

See Forsyth *v.* Hammond, 166 U. S., 504.

It is respectfully submitted that a Writ of Certiorari should not be granted in a suit of this character on interlocutory decree for preliminary injunction. If the petition should be granted, and this Court after argument on the merits decide in favor of the respondents, affirming the Courts below, the Leeds & Catlin Co. would have the right to require the complainant to go to final hearing, to give the defendant an opportunity to put in its defense more fully, and thus the litigation prolonged unnecessarily for an indefinite period.

The Petitioner, the defendant, now has the opportunity in the Circuit Court to put in a full defense, if it has such, and should the Circuit Court and the Court of Appeals again decide against the defendant, it would have an opportunity then to come before this Court with a Petition for Certiorari, after the case has been fully heard upon its merits, if any grounds it should have for such Petition.

RE PETITIONER'S THIRTEENTH POINT.

Under the Thirteenth Point, the Petitioner has printed in the Petition (pp. 41 to 46) what is styled "the oral decision of the Circuit Court of Appeals."

It is respectfully submitted that this so-called oral decision of the Court of Appeals is not part of the record, is entirely unofficial, and should not be considered, whether it be favorable to the Petitioner or to the Respondent, as it is not part of the record.

RE PETITIONER'S FOURTEENTH POINT.

This point was one which was considered in the Court of Appeals, but, as stated in the Petition (p. 46), is now abandoned and not urged here.

CONCLUSION.

It is respectfully submitted, for the reasons hereinbefore stated, that the Petition for Writ of Certiorari should be denied.

HORACE PETTIT,
Solicitor and of Counsel for Respondents.
Office and Post Office address,
604 Stephen Girard Building,
Philadelphia, Pa.

May 11, 1907.

FILED
JAN 8 1909
JAMES H. McKENNEY,
CLERK.

Supreme Court of the United States.

OCTOBER TERM, 1908

No. 80.

LEEDS & CATLIN COMPANY,

Petitioner,

against

VICTOR TALKING MACHINE COMPANY and UNITED STATES GRAMOPHONE COMPANY,

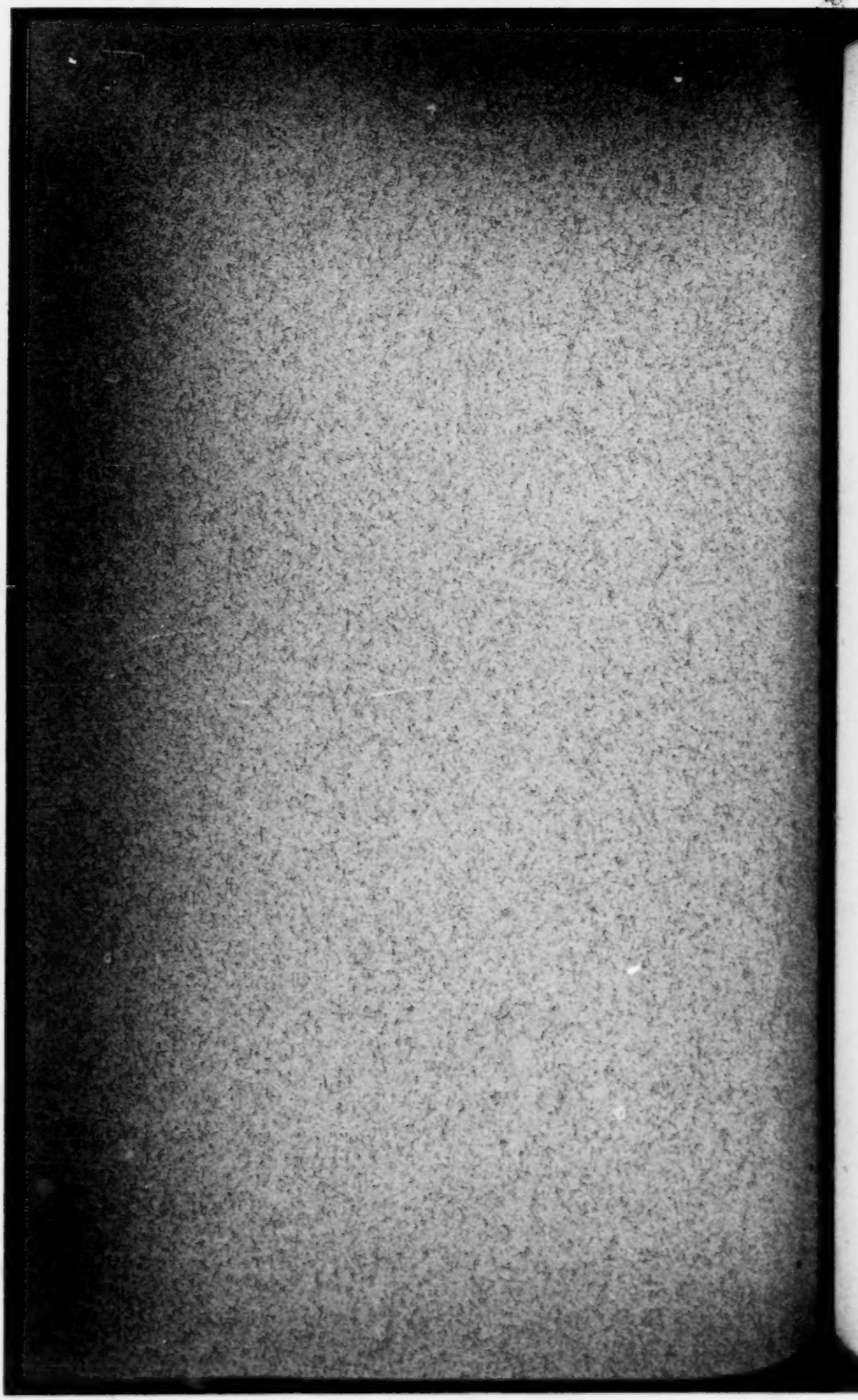
Respondents.

PETITIONER'S BRIEF IN SUIT FOR INJUNCTION.

LOUIS HICKS,
Counsel for petitioner,
71 Nassau Street,
New York City.

On writ of certiorari to the United States Circuit Court of Appeals for the Second Circuit.

APPEAL PRINTING COMPANY, 32-34 VESEY STREET, NEW YORK.



INDEX.

PAGE

STATEMENT 1

Succinct statement of the questions here involved and the manner in which they are raised 8

Assignment of errors 12

Brief statement of the prior art, of Berliner's early domestic and foreign patents, and of the relation thereto of claims 5 and 35 of the patent in suit. Error of the Courts below in selecting one feature as the principal invention of the patent in suit..... 16

(a). The prior art and the relation of Berliner's work thereto..... 16

(b). Berliner's early domestic and foreign patents 23

(c). The relation of claims 5 and 35 of the patent in suit to Berliner's earlier work..... 26

(d). The expression "principal invention" was used by this Court in Siemens' Adm'r. v. Sellers, 123 U. S., 276, merely to designate one of two inventions, and not as a ground of decision. The Courts below erred in refusing to follow the principle of the decision in that case and erred in holding that, because, contrary to Berliner's express statements, they

PAGE

regarded one feature as more important than other features of the invention, the patent in suit has a plurality of terms 36

Whether two patents are granted for the same invention is a question of law to be determined by the court from a comparison of the patents. The question of infringement is also one of law 44

The specifications and drawings of the prior German and French patents relied upon are properly proved, together with certificates of the Patent Offices and the laws of Germany and France 44

POINT ONE. Claims 5 and 35 of the patent in suit are void because they are claims for the functions of a machine 45

POINT TWO. Claim 35 of the patent in suit is void because it is indefinite and meaningless and claims nothing 64

POINT THREE. Claims 5 and 35 of the patent in suit are void because anticipated by British Patent No. 1644 of 1878 to Edison, and for lack of invention in view of the prior art 65

POINT FOUR. Claims 5 and 35 of the patent in suit are void because anticipated by U. S. Patent No. 341,214 of May 4, 1886, to Bell & Tainter or by British Patent No. 6027 of May 4, 1886, to Johnson for the same Bell & Tainter invention and for lack of invention in view of the prior art 80

POINT FIVE. Claims 5 and 35 of the patent

PAGE

in suit are void because anticipated by Werner Suess, and for lack of invention in view of the prior art 96

POINT SIX. Berliner patent in suit No. 534,543, of February 19, 1895, was granted for an invention previously patented by Berliner in Germany, by Berliner German patent No. 53,622, of November 20, 1889. The term of the patent in suit, therefore, expired with the expiration of the term of the prior German patent on Nov. 7, 1902, before this suit was begun. Section 4887 of the Revised Statutes considered and the authorities collated 114

(a) German patent No. 53,622 115

(b) German patent No. 53,622, being a patent for an "invention" constituting an improvement, expired on Nov. 7, 1902, according to the German law, with the patent for the invention upon which the improvement was made 115

(c) The description and claims of the patent in suit for the "invention" previously patented by the German patent 116

(d) The "invention" described and claimed in the prior German patent. Judge Townsend found that the invention described and claimed in the German patent is described and claimed in the patent in suit 122

(e) Futile effort of complainants' counsel to find some slight difference between the description and drawings of German patent

PAGE

No. 53,622 and French patent No. 207,090 and the description and drawings of the patent in suit 124

(f) The provision of § 4887 of the Revised Statutes, fixing the single term of a home "patent granted for an invention" previously patented in a foreign country, is clear and unambiguous and must control the decision in this suit without change by judicial action "based upon some supposed policy of Congress." The Courts below erred in refusing to follow the unambiguous provision of the Statute, and in holding, contrary to the Statute and the decision of this Court, that a patent can have a plurality of terms and can expire in parcels.. 127

(g) The principle of the decisions of the Supreme Court in Siemens' Adm'r v. Sellers, 123 U. S. 276, and of the lower courts following that decision, is that a "patent cannot expire in parcels", "cannot be construed as running partly from one date and partly from another. This would be productive of endless confusion." Such principle is derived from, and is the only principle which can be derived from, the provisions of § 4887 of the Revised Statutes fixing the term of the patent..... 136

(h) Broadening or narrowing of the claims of an American patent will not prevent the operation of the Statute..... 139

(i) The test of the question, whether an American "patent is granted for an invention" previously patented in a foreign country, is whether an article made according to the de-

PAGE

scription of the invention patented by the foreign patent would infringe the American patent, that is any claim of the American patent. 139

(j) In determining whether a home patent is granted for an invention previously patented in a foreign country, the precise question is whether ANY of the claims of the home patent include the invention or some substantive part of the invention shown by the prior foreign patent. If so, the home patent expires as to all its claims with the foreign patent since a "PATENT CANNOT EXPIRE IN PARSELS." (Western Electric Co. v. Citizens' Tel. Co., 106 Fed. 215; Thomson-Houston Co. v. McLean, 153 Fed., 883) 141

(k) The Circuit Court and the Circuit Court of Appeals for the Second Circuit have determined the question, whether a home patent was "granted for an invention" previously patented in a foreign country, by ascertaining whether "ANY ONE of the inventions" claimed in the home patent is contained in the prior foreign patent, and whether any claim of the home patent would be infringed by the structure of the invention of the foreign patent.... 145

(l) Judge Brown has held, in Sawyer Spindle Co. v. Carpenter, 133 Fed. 238, aff'd, 143 Fed. 976, (1), that a patent cannot expire in part and survive in part; and (2) that a generic claim, covering the specific form of a specie claim and other forms as well, must, under any construction of the statute, expire with the expiration of the specie claim..... 146

PAGE

(m) Aquarama Co. v. *Old Mill Co., 124 Fed. 229 and Westinghouse Co. v. Stanley Co., 138 Fed. 123, merely held that a home patent granted only for an invention which is a patentable improvement upon an invention covered by a prior foreign patent, or vice versa, is not granted for the invention covered by the foreign patent and does not expire therewith* 149

POINT SEVEN. Berliner patent in suit No. 534,543, of February 19, 1895, was granted for inventions previously patented by Berliner in France, by Berliner French patent No. 207,090, of July 19, 1890. The term of the patent in suit, therefore, expired with the expiration of the term of the prior French patent on July 19, 1905, before the decree for injunction was entered 152

(a) French patent No. 207,090..... 153

(b) French patent No. 207,090, according to the French law, expired July 19, 1905..... 153

(c) The description and claims of the prior French patent and of the patent in suit for inventions for which the patent in suit was granted 154

(d) Judge Townsend found that French patent No. 207,090 covers the improvements of the patent in suit in the recorder and reproducer 163

POINT EIGHT. The patent in suit and claims 5 and 35 thereof expired, before this suit was

PAGE

begun, with the expiration of the prior British, French and German patents of November 8, 1887, to Berliner for the so-called "Basic Invention" covered by said claims 5 and 35..... 164

Futile effort of complainants' counsel in the courts below to misinterpret claim 9 of the prior British patent and claim 8 of Patent No. 564,586 185

POINT NINE. Berliner Patent in suit, No. 534,543 of February 19, 1895, expired February 11, 1899, before this suit was begun, with the expiration of the term of six years for which the prior Berliner-Suess Canadian Patent No. 41,901, of February 11, 1893, was granted, and beyond which it was not prolonged. 188

(*a.*) *Judge Townsend found that the Berliner-Suess Canadian patent "discloses and broadly claims the invention covered by the claims here in suit," and "that if this patent expired, as claimed in 1899, the patent in suit expired at the same time."*..... 191

(*b.*) *Assuming, as Judge Townsend found, that the Berliner-Suess Canadian patent "discloses and broadly claims the invention covered by the claims here in suit," the patent in suit expired on Feb. 11, 1899, with the expiration of the six year term for which the Canadian patent was granted*..... 192

(*c.*) *The invention of the Berliner-Suess Canadian patent was, under the statute and decided cases, patented and caused to be pat-*

PAGE

ented by Berliner, the patentee of the patent in suit. 193

(*d.*) *Under the patent act of Canada, a Canadian patent "expires," within the meaning of § 4887 of the Revised Statutes, at the expiration of the term for which the fee to the Government has been paid, unless a further fee for a "further term" is paid. The patent does not lapse and is not forfeited, but its term expires. The Berliner-Suess Canadian patent was granted for a term of six, and not of eighteen years, since the granted term depends solely upon the provisions of the patent act.* 194

(*e.*) *Under the provisions of the patent act of Canada payment of a further fee for the prolongation of the patent for a further term is a* **CONDITION PRECEDENT** *to the existence of a term beyond the original term of six years, and not a* **CONDITION SUBSEQUENT** *operating on non-performance to forfeit the unexpired portion of a term previously granted.* 198

(*f.*) *Judge Townsend erred in holding that the legal term of the Canadian patent did not expire but lapsed or became forfeited in 1899. The Bonsack case, cited by Judge Townsend in support of his ruling, is directly opposed thereto, and the Welsbach case, cited by him in support of his ruling, in no way involved the question at issue.* 200

(*g.*) *In the Bonsack case it was squarely held that a Canadian patent for which the fee for a five year term only had been paid and*

PAGE

which was not prolonged by payment of a further fee for a further term before the expiration of the original five year term expired with the expiration of the original five year term and did not lapse or become forfeited 201

(*h.*) *In the Welsbach case the only question involved was whether, where a prior French patent had been forfeited before the grant of the home patent, but after the filing of the application therefor, the home patent was invalid upon the ground of abandonment or other ground arising out of those facts only. The question whether the prior French patent had been forfeited or had expired was not involved, for, concededly, it had been forfeited.* 205

(*i.*) *The distinction under § 4887 of the Revised Statutes, between patents granted for a short term and not prolonged before the expiration of the short term for a further term by reason of which the short term and the patent expire by lapse of time, and patents granted for a fixed term subject to forfeiture as a penalty upon breach of a condition subsequent during the term for which the patent was granted is well settled by authority in the patent law of this country. Judge Townsend erred in not recognizing this distinction and in not holding under the doctrine of stare decisis that the Canadian patent expired in 1899 with the expiration of the six year term for which it was granted, and which was the only term it ever had.* 207

(*j.*) *Additional cases in the lower courts,*

PAGE

following Judge Blatchford's opinions in Commercial Mfg. Co. v. Fairbank and *Gramme Electric Co.* v. *Arnoux*..... 210

POINT TEN. Claims 5 and 35 of the patent in suit are void because of the public use in 1888, in this country, of the alleged invention thereof, more than two years prior to the filing of the application for the patent in suit on March 30, 1892. 215

Additional authorities upon the question of more than two years prior public use..... 230

POINT ELEVEN. Claims 5 and 35 of the patent in suit are void, because, if Berliner ever had any right to the alleged invention of said claims, he had irrevocably abandoned his right thereto before the filing of the application for the patent in suit on March 30, 1892, and before the patent was issued on Feb. 19, 1895. 230

Authorities upon the question of abandonment and estoppel. 236

Abandonment of an invention may be evinced by the conduct of the inventor at any time before or after the patent is granted. .. 238

POINT TWELVE. Defendant's machines do not infringe claims 5 and 35 of the patent in suit when those claims are properly construed in view of the prior art disclosed. 239

POINT THIRTEEN. The matter of the patent in suit was concededly the subject of more than one prior, foreign patent. Hence under Rev. St. Section 4887, the patent in suit ex-

PAGE

pired at the same time with the foreign patent having the shortest term. 246

POINT FOURTEEN. For the reasons stated in the preceding points of this brief, the bill was without equity, and, the patent having expired, the Circuit Court was without jurisdiction to entertain this suit in equity. The Circuit Court, therefore, erred in not dismissing the bill. 249

CONCLUSION. The decree of the Circuit Court for an injunction and the order of affirmance of the Circuit Court of Appeals should he reversed with costs and the cause remanded to the Circuit Court with a direction to dismiss the bill. 250

Supreme Court of the United States.

LEEDS & CATLIN COMPANY, Petitioner, vs. VICTOR TALKING MACHINE COMPANY and United States Gramophone Company, Respondents.	October Term, 1908. No. 80.

PETITIONER'S BRIEF.

Statement.

This cause comes here on writ of *certiorari* to the United States Circuit Court of Appeals for the Second Circuit.

The petition for the granted writ of *certiorari*, being No. 742 of the October Term, 1906, set forth that the precise questions involved in this suit, which is a patent suit in equity, have never been decided by this court and are of such importance and of such general application that they should be considered and decided by this court (petition for writ of *certiorari*, p. 2). The petition furthermore set forth that the record presented the whole case to the Circuit Court and to the Cricuit Court of Appeals "in such wise that it might properly have been finally disposed of in terms by its decree, in accordance with the well settled rule upon that

subject" (197 U. S., 286); and that, although the decree for injunction was an interlocutory decree (T., p. 328) made upon a motion for an injunction *pendente lite*, this court, under the decision in *Harriman* vs. *Northern Securities Co.*, 197 U. S., 284,286, had jurisdiction to review the decision of the Circuit Court of Appeals, which had practically finally disposed of the case in favor of the complainants, and to do what the Circuit Court of Appeals might and should have done, namely, *finally dispose of the case by a direction to the Circuit Court to dismiss the bill* (petition for writ of *certiorari*, pp. 37-40).

It was shown by the petition (p. 38) that, during the pendency of this suit, another suit brought by the same complainants upon the same patent and in the same court against another defendant, the American Graphophone Company, was brought to final hearing and a decree finding infringement and granting an injunction with reference to claims 5 and 35, here in controversy, of patent No. 534,543, of February 19, 1895, to Berliner (T., p. 452), was entered by Judge Hazel (140 Fed. 860) in October, 1905, and affirmed by the Circuit Court of Appeals for the Second Circuit in March, 1906 (145 Fed. 350), so that no useful purpose would be served by compelling this petitioner, at great expense and long delay, to raise, again in the same Circuit Court and again in the same Circuit Court of Appeals, the very questions upon which each of those courts had already finally passed.

Under familiar practice this petitioner was not free to argue, either in the Circuit Court or in the Circuit Court of Appeals, any of the questions previously decided in the said suit against the American Graphophone Company. However, *new de-*

fences of the first importance, *presenting pure questions of law*, were raised in this suit in addition to the defences raised in the prior suit.

Before presenting the questions here involved and the manner in which they are raised, a word of comment is necessary upon the prior suit in order that this court may determine what *weight, if any*, is to be given to the decision in that suit, and how far the decision in that suit should have been controlling upon the courts below in the decision of this suit in respect to such evidence and such defences as were presented in that suit as well as in this suit.

On December 8, 1903, the Victor Talking Machine Company, complainant herein, and the American Graphophone Company entered into an agreement, which is set forth at pages 224-229 of the record herein. Under that agreement it was provided that the parties thereto should do all in their power to speed to final hearing and final adjudication all suits brought by the one party against the other party upon their respective patents (T., p. 225, fol. 675; p. 226, fol. 678). The agreement further provided that if in any such suit the defence should *fail*, in that event the *defeated* party should receive a license under the patent, thus sustained, of the other party (T., p. 226, fol. 676; p. 227, fol. 679); and that thereupon the contracting parties should proceed jointly to enforce against their competitors the patents sustained in the litigations between themselves (T., p. 226, fols. 677-678).

The agreement mentioned the patent here in suit, No. 534,543, of February 19, 1895, to Berliner, as one belonging to the Victor Company, and patent No. 688,739, of December 10, 1901, to Jones, as one

belonging to the Graphophone Company. The result of securing decisions of the courts broadly sustaining these two patents would be to give to the contracting parties a monopoly of the disc talking-machine business, and it obviously became, as a result of the agreement, the interest of the contracting parties to have the said patents sustained in the litigations between themselves, because, as stated, the defeated party was to receive a license under each patent sustained against it.

It is not surprising to find that the Berliner patent *was* sustained in the suit of these complainants against the American Graphophone Company (140 Fed, 860, affirmed, 145 Fed, 350; and T., pp. 63, 73), and that the Jones patent *was* sustained in the suit of the American Graphophone Company against the Victor Company's licensee, the Universal Talking Machine Mfg. Co., (151 Fed. 595), which suit was defended by the Victor Company through its present counsel, Horace Pettit, Esq. (T., p. 216, fols. 648-659).

That the American Graphophone Company *was* interested in sustaining the Victor Company's Berliner patent and that the Victor Company *was* interested in sustaining the Graphophone Company's Jones patent is *matter of record* (*infra*, pp. 5-6).

Upon the sustaining of the Berliner and Jones patents, in accordance with the above stated provision of the agreement, motions for preliminary injunction were at once brought against this petitioner, the Leeds & Catlin Company, in suits which had been previously brought upon said patents and kept pending while the Victor and Graphophone Companies were prosecuting their litigations between themselves in order to sustain the patents. The *new defences* thereupon

adduced by this petitioner, through its counsel, were of such weight and importance that this court granted its writ of *certiorari* to review the decisions in this suit based upon the Berliner patent, and Judge Hough, on August 25, 1908, held the Jones patent to be void (Fed.) on new evidence, adduced by this petitioner when the suit based on that patent was argued before him at final hearing.

When the American Graphophone Company ascertained the nature of the new defences interposed by this petitioner in this suit upon the motion for preliminary injunction heard by Judge Townsend, its counsel, immediately after the argument of the motion and before Judge Townsend had had an opportunity to examine the questions and render his decision thereon, seized upon this petitioner's new defences, to the prejudice of this petitioner, and presented especially the new defence based upon the Berliner-Suess Canadian patent (T., p. 155), to the Circuit Court of Appeals upon a motion to re-open the suit upon the Berliner patent against the American Graphophone Company, and for leave to file a bill in the nature of a bill of review. The Circuit Court of Appeals held that the American Graphophone Company had been guilty of *laches* in presenting its defences and denied the motion (145 Fed. 351). Reference to page 9 of the printed papers of the American Graphophone Company upon said motion shows that its counsel, Mr. Mauro, then stated, in an affidavit verified by him, as follows;—

> "It is *to the interest of the defendant*, the American Graphophone Company, that the (Berliner) patent in suit *should be sustained*

and enforced against other manufacturers of talking machines."

In like manner, in the suit of the American Graphophone Company against this petitioner, upon the Jones patent, it appeared that the expert of the Victor Company, Mr. Hunter, refused to carry out his agreement to testify as an expert on behalf of this petitioner and gave the following reason for his refusal;—

> "The fact is, that my relations to the Victor Talking Machine Company are such that I could not act in any suit that would directly or indirectly affect their interests and of course you know that *after the determination of the suit on the Jones patent in favor of the Graphophone Company, the Victor Company became licensees and their relations are such that adverse decision against the Jones patent at the present time would materially affect their business interests*" (see page 678, fol. 2034 of defendant's record in suit of American Graphophone Co. v. Leeds & Catlin Co. on said Jones patent, now in the Circuit Court of Appeals for the Second Circuit).

Reference to said agreement of December 8, 1903, between the Victor and Graphophone Companies, shows that *apparently* royalty was to be paid for the license to be received by the defeated party under the sustained patents, but the copy of the agreement presented to the court by *these complainants* in the suit against the American Graphophone Company upon said Berliner patent (see p. 151, record on appeal of 145 Fed. 350), which is the same as the copy contained in the record in this suit (T., p. 224), shows that, instead of stating an amount of royalty to be paid, *blank spaces*

for the amount of royalty were left in the agreement. When, in the suit of the American Graphophone Company against this petitioner upon said Jones patent, counsel for the American Graphophone Company was called upon to produce the *original* copy of said agreement of December 8, 1903, *in order to determine whether payment of royalties had actually been contemplated*, said counsel refused to produce the original agreement (see p. 157, fol. 665 of complainant's record; p. 686, fol. 2058 of defendant's record, in said suit on the Jones patent now in the Circuit Court of Appeals for the Second Circuit).

Because, as above shown, the American Graphophone Company was interested in sustaining, and not in overthrowing, the Berliner patent here in suit; because, as the Circuit Court of Appeals said, that company was guilty of laches in presenting its defences; and because the evidence before the court in this suit not only presents important defences not raised by the evidence in the prior suit, but also supplements and strengthens the defences presented in that suit, but little, if any, weight is to be given to the decision in the prior suit, resting as it does upon an *imperfect record* and an *incomplete presentation* of the defence to the patent.

In the Circuit Court and in the Circuit Court of Appeals this petitioner was bound, under the practice prevailing in the Second Circuit, by the decision upon the evidence in the prior suit. *In this court, however, all the questions involved are, for the first time, presented together for decision upon the merits*, this court being at liberty to consider *all* the evidence, to re-examine *all* the defences and to render its decision uncontrolled by the ac-

tion of the lower courts in any prior suit, no matter what the degree of good faith may have been with which the prior suit was conducted by the parties in the lower courts.

Succinct Statement of the Questions Here Involved and the Manner in Which They Are Raised.

The patent in suit No. 534,543, of February 19, 1895, to Berliner, is to be found at page 452 of the record. It was applied for on March 30, 1892. Claims 5 and 35 of the patent, the only claims involved in the prior suit (140 Fed. 860 and 145 Fed. 350) and in this suit (see decree, T., p. 328), are as follows;—

> "5. The *method* of reproducing sounds from a record of the same which consists in *vibrating* a stylus and *propelling* the same *along* the record *by* and in accordance with *the said record,* substantially as described.
>
> "35. IN a sound reproducing apparatus consisting of a *traveling tablet* having a sound record formed thereon and a *reproducing stylus* shaped for engagement with said record and *free to be vibrated and propelled* by the same, substantially as described."

Petitioner contends (*a*) that said claims 5 and 35 were *void* when the patent in suit was issued; and (*b*) if not void, that the patent in suit and said claims thereof had *expired* with prior foreign patents, before this suit was begun on July 12, 1904 (T., p. 11) and before the decree for injunction was entered on May 2, 1906 (T., p. 329); and (*c*) that the patent in suit and said claims thereof are *not infringed.* The grounds of petitioner's

contentions, *which raise pure questions of law*, are the following;—

1. That claims 5 and 35 of the patent in suit are *void* because they are claims for the *functions* of a machine. (See discussion and authorities cited, *infra*, p. 45, under Point One).

2. That claim 35 of the patent in suit is *void* because it is indefinite and meaningless and *claims nothing*. (See discussion and authorities cited, *infra*, p. 64, under Point Two).

3. That claims 5 and 35 of the patent in suit are *void*, because *anticipated* by British patent No. 1644 of 1878 to Edison (T., p. 472). (See discussion and authorities cited, *infra*, p. 65, under Point Three).

4. That claims 5 and 35 of the patent in suit are *void*, because *anticipated* by U. S. patent No. 341,214, of May 4, 1886 to Bell & Tainter (T., p. 387), or by British patent No. 6027 of May 4, 1886 to Johnson for the same Bell & Tainter invention (T., p. 488). (See discussion and authorities cited, *infra*, p. 80, under Point Four).

5. That claims 5 and 35 of the patent in suit are *void*, because *anticipated* by Suess, as shown (*a*) by U. S. patent No. 427,279 of May 6, 1890 to Suess, *assignor to Berliner* (T., p. 446); (*b*) by Canadian patent No. 41,901 of February 11, 1893 to Berliner, *as assignee of Suess* (T., pp. 155-175); and (*c*) by Be. er's lecture before the Franklin Institute of May 16, 1888, acknowledging Suess to be the inventor (T., pp. 245-273, especially page 270, fol. 809 and page 269, figure of "reproducing apparatus, May, 1888"). The drawings of said Suess-Berliner Canadian and United

States patents being identical, the drawings of the United States patent are to be used in connection with the Canadian patent (stipulation, T., p. 541, fol. 1621). (See discussion and authorities cited, *infra*, p. 96, under Point Five).

6. That the patent in suit and claims 5 and 35 thereof *expired* on November 7, 1902, before this suit was begun, with the expiration of the legal term of the prior German patent to Berliner No. 53,622 of November 20, 1889 (T., p. 150). (See discussion and authorities cited, *infra*, p. 114, under Point Six).

7. That the patent in suit and claims 5 and 35 thereof *expired* on July 19, 1905, before the decree for injunction was entered, with the expiration of the legal term of the prior French patent to Berliner, No. 207,090 of July 19, 1890 (T., p. 126). (See discussion and authorities cited, *infra*, p. 152, under Point Seven).

8. That the patent in suit and claims 5 and 35 thereof *expired*, before this suit was begun,

(*a*) on November 8, 1901 with the expiration of the legal term of the prior British patent to Berliner, No. 15,232, of November 8, 1887 (T., p. 516);

(*b*) on November 7, 1902 with the expiration of the legal term of the prior German patent to Berliner, No. 45,048 of November 8, 1887 (T., p. 132); and

(*c*) on November 8, 1902 with the expiration of the legal term of the prior French patent to Berliner, No. 186,827 of November 8, 1887 (T., p. 123).

The drawings of said British, German and French

patents of 1887 to Berliner being identical, the drawings of the English patent are to be used in connection with the German and French patents (stipulation, T., p. 540, fol. 1620). (See discussion and authorities cited, *infra*, p. 164, under Point Eight.)

9. That the patent in suit and claims 5 and 35 thereof *expired* before this suit was begun, on February 11, 1899, with the expiration of the legal term of the prior Canadian patent to Berliner, assignee of Suess, No. 41,901, of February 11, 1893 (T., pp. 155-175; for the drawings of Canadian patent see the identical drawings of U. S. patent No. 427,279, T., p. 446, and stipulation, T., p. 541, fol. 1621). (See discussion and authorities cited, *infra*, p. 188, under Point Nine).

10. That claims 5 and 35 of the patent in suit are *void*, because of the *public use* in 1888 in this country of the alleged invention thereof, more than two years prior to the filing of the application for the patent in suit on March 30, 1892. (See discussion and authorities cited, *infra*, p. 215, under Point Ten).

11. That claims 5 and 35 of the patent in suit are *void*, because, if Berliner ever had any right to the alleged invention of said claims, he had *irrevocably abandoned* his right thereto before the filing of the application for the patent in suit on March 30, 1892. (See discussion and authorities cited, *infra*, p. 230, under Point Eleven).

12. That defendant has *not infringed* the patent in suit or claim 5 or 35 thereof. (See discussion and authorities cited, *infra*, p. 239, under Point Twelve).

13. That the entire matter of the patent in suit was split up by Berliner and previously patented by him in several foreign patents, by reason of which the patent in suit *expired* with the foreign patent *having the shortest term*. (See discussion and authorities cited, *infra*, p. 246, under Point Thirteen).

14. That, for the reasons stated, the bill was *without equity* and the Circuit Court *without jurisdiction* to entertain this suit in equity, by reason of which the Circuit Court erred in not dismissing the bill. (See discussion and authorities cited, *infra*, p. 249, under Point Fourteen).

15. That the decree of the Circuit Court for injunction and the order of affirmance of the Circuit Court of Appeals should be reversed with costs and the cause remanded to the Circuit Court with a direction to dismiss the bill. (See Conclusion, *infra*, p. 250).

ASSIGNMENT OF ERRORS.

The errors assigned (T., p. 534) and relied upon are as follows;—

The Circuit Court erred in the following particulars:

1. In not holding that the patent in suit, No. 534,543, expired with the prior German patent No. 53,622, of November 20, 1889.

2. In not holding that claim 5 of the patent in suit, No. 534,543, expired with the prior German patent No. 53,622, of November 20, 1889.

3. In not holding that claim 35 of the patent in suit, No. 534,543, expired with the expiration of

the prior German patent, No. 53,622, of November 20, 1889.

4. In not holding that the patent in suit, No. 534,543, expired with the prior French patent No. 207,090, of July 19, 1890.

5. In not holding that claim 5 of the patent in suit, No. 534,543, expired with the prior French patent No. 207,090, of July 19, 1890.

6. In not holding that claim 35 of the patent in suit, No. 534,543, expired with the expiration of the prior French patent No. 207,090, of July 19, 1890.

7. In not holding that the patent in suit, No. 534,543, including claims 5 and 35, expired with English patent No. 15,232, of November 8, 1887.

8. In not holding that the patent in suit, No. 534,543, including claims 5 and 35, expired with German patent No. 45,048, of November 8, 1887.

9. In not holding that the patent in suit, No. 534,543, including claims 5 and 35, expired with French patent No. 186,827, of November 8, 1887.

10. In not holding that Berliner was not the inventor of the invention set forth in claims 5 and 35 of the patent in suit.

11. In not holding that the invention of claims 5 and 35 of the patent in suit, No. 534,543, was anticipated by Werner Suess in Canadian patent No. 41,901, of February 11, 1893.

12. In not holding that Berliner had abandoned the invention claimed in claims 5 and 35 of the patent in suit, No. 534,543, before he applied for a patent therefor.

13. In not holding that Berliner had abandoned the invention claimed in claims 5 and 35 of the patent in suit, No. 534,543, before the patent was issued.

14. In not holding that claims 5 and 35 of the patent in suit, No. 534,543, should be limited to Berliner's improvements in the details of construction of his reproducer.

15. In not holding that defendant's devices do not infringe claims 5 and 35 of the patent in suit, No. 534,543.

16. In not holding that the patent in suit, No. 534,543, expired February 11, 1899, with the expiration of the term of six years for which the prior Canadian patent, No. 41,901, of February 11, 1893, was granted.

17. In not holding that claims 5 and 35 of the patent in suit, No. 534,543, were anticipated by English patent No. 1644, of 1878, to Edison.

18. In not holding that the patent in suit, No. 534,543, was not fairly in controversy in the prior suit between these complainants and the American Graphophone Company, and that the adjudication in that suit formed no proper basis for a preliminary injunction.

20. In not holding that the patent in suit, No. 534,543, had expired before the commencement of this suit.

21. In not holding that the patent in suit No. 534,543 had expired before the making of the motion for preliminary injunction and the making of the order entered May 2, 1906, and hereby appealed from.

22. In not denying the motion for preliminary injunction.

23. In not dismissing the bill of complaint upon the hearing of the motion for preliminary injunction.

24. In not holding that claims 5 and 35 of the patent in suit, No. 534,543, are and always have been invalid by reason of more than two years public prior use in the United States by Berliner before the date of the filing of his application therefor.

25. In not holding that claims 5 and 35 of the patent in suit, No. 534,543, are and always have been invalid by reason of more than two years public prior use in the United States by T. Commerford Martin before the date of the filing of the application therefor.

26. In not holding that in view of the state of the prior art claim 5 of the patent in suit, No. 534,543, is void for lack of invention.

27. In not holding that in view of the state of the prior art claim 35 of the patent in suit, No. 534,543, is void for lack of invention.

28. In not holding that in view of the prior art, claim 5 should be limited to a method of reproducing sounds wherein the stylus is vibrated substantially as described in the specification of the patent in suit, No. 534,543, and shown in figures 6 and 7 thereof.

29. In not holding that in view of the prior art, claim 35 of the patent in suit, No. 534,543, should be limited to a sound reproducing apparatus having a reproducing stylus free to be vibrated sub-

stantially as described in the specification and shown in figures 6 and 7 thereof.

30. In not holding that claim 5 of the patent in suit, No. 534,543, is void as being for the function of a machine.

31. In not holding that claim 35 of the patent in suit, No. 534,543, is void as being for the function of a machine.

32. In not holding that claim 35 of the patent in suit, No. 534,543, is void as being indefinite, meaningless and claiming nothing.

33. In enjoining the manufacturing and selling of an article under claim 5 of the patent in suit, No. 534,543, which is limited to a method.

34. In granting the order for preliminary injunction.

Brief Statement of the Prior Art, of Berliner's Early Domestic and Foreign Patents, and of the Relation Thereto of Claims 5 and 35 of the Patent in Suit. Error of the Courts Below in Selecting One Feature as the Principal Invention of the Patent in Suit.

(a.) The prior art and the relation of Berliner's work thereto.

The *recording* of sound in permanent characters and the *reproduction*, by suitable mechanism, of sound so recorded were invented by Edison in 1877 and patented in U. S. patent No. 200,521, of February 19, 1878 (T., p. 334) and British patent No. 1644 of April 24, 1878 (T., p. 472) to Edison. *These are the two fundamental patents of the art.*

In 1885, and prior thereto, Bell & Tainter made an important improvement upon Edison's invention, consisting in the substitution of a wax-like material for Edison's tin-foil spread upon the surface of a wax-like material, as the material in which to record, by cutting or engraving as distinguished from indenting, the permanent characters constituting the sound record. For this improvement Bell & Tainter obtained U. S. patent No. 341,214, of May 4, 1886 (T., p. 387) and British patent No. 6027 of May 4, 1886 to Johnson (T., p. 488).

Prior to Edison and as early as 1857, Scott invented the phonautograph (T., p. 244 and p. 417, lines 87-97), an instrument which recorded sound in a *non-resisting* material, such as lampblack, a material incapable of causing a reproducing stylus to be vibrated, as distinguished from the *resisting* materials above mentioned, capable of causing a reproducing stylus to be vibrated, employed by Edison and by Bell & Tainter. Because of the non-resisting character of the recording material employed by Scott in 1857, sound could not be reproduced from Scott's phonautographic record.

When Berliner, in 1887, entered the field of recording and reproducing sound, *the art was old*. Scott had *recorded* sound by the *lateral* vibrations of a recording stylus in a groove of *even depth* traced in a non-resisting material such as lampblack. Edison had recorded sound not only by the *lateral* but also by the *vertical* vibrations of the recording stylus indenting a resisting material, such as tin-foil spread upon the surface of a wax-like material, and Bell & Tainter had further improved the art by recording, by cutting or engraving, directly in a wax-like material. Edison, moreover, had described the *duplication*, or multiplica-

tion of copies, of original sound records by the well known *stereotype* and *electrotype* processes.

In U. S. patent No. 200,521 of February 19, 1878, Edison described the *stereotype* process as follows (T., p. 336);—

> "The record, if it be upon tin-foil, may be *stereotyped* by means of the plaster-of-paris process, and from the stereotype *multiple copies* may be made expeditiously and cheaply by casting or by pressing tin-foil or other material upon it. This is valuable when musical compositions are required for numerous machines."

In British patent No. 1644 of 1878, Edison described the *electrotype* process as follows (T., p. 472, lines 17-22);—

> "where a *matrix* has been made of steel or iron by *electrotype* deposit, or otherwise, upon the phonogram it may be hardened and used for impressing a sheet or roller of metal, and thereby *the original phonogram can be reproduced indefinitely* in metal that may be hardened and used for any reasonable length of time to utter the sentence, or words or sounds phonetically."

In U. S. patent No. 200,521, of February 19, 1878. Edison stated that he did not confine himself to recording sound by indentations made by the *vertical* vibration of the recording stylus, since, he said, the record might be made "in a sinuous form" by causing the recording stylus to vibrate *laterally* or "to the right and left of a straight line" (T., p. 336, bottom of first column and top of second column). The record made by the lateral vibrations of the recording stylus Edison termed a "*zigzag*" record in British patent No. 1644 of 1878 (T., p. 473, line 55) and said that (T., p. 473, line 57);—

> "the reproduction of the phonogram from a

> matrix or copy in relief of an original phonogram may be made upon a belt, roller, cylinder, *plate* or other convenient surface."

The term "zigzag," applied by Edison to a record having a *laterally* undulating groove of *even depth*, is the term which has been used ever since, and is used to-day, to designate such a record.

In the above mentioned litigation over the Jones patent of the American Graphophone Company, held by Judge Hough, in the suit against this petitioner, to be void, as above stated (*supra*, p. 5), Judge Hazel and the Circuit Court of Appeals, upon a review of the art, found that (151 Fed., 596; 145 Fed. 636);—

> "The prior Edison British patents referred to phonograms 'in the form of a *disk*, * * * and the marks are to be either in straight lines, spiral, *zigzag*, or in any other convenient form,' and stated that 'the *reproduction* of the phonogram from a *matrix* * * * may be made upon a * * * plate" (T., p. 473, line 53).

Not only were sound records having a laterally undulating or a vertically undulating groove, and the process of duplicating the same, old, before Berliner entered the field in 1887, but the *machines* for recording such sound records and for reproducing sound therefrom *were also old* and had been described and patented by Edison and by Bell & Tainter as well as others.

The court will understand, as explained by the evidence, hereinafter referred to, that in a machine employed for *recording* a sound record, it is *necessary that the vibrating, recording stylus be fed* across the surface of a record-tablet rotating about a fixed axis, by some feed mechanism, such as a feed-screw, or that the vibrating, recording stylus

be fixed and the axis of the rotating record-tablet be similarly fed or moved with reference to the fixed stylus, in order that the stylus may record the record in a *spiral* line either upon the surface of a disc or upon the surface of a cylinder. In a machine employed for *reproducing* sound from a record, *such auxiliary means,* as a feed-screw, *are not necessary,* in the case of a record-tablet rotating about a *fixed* axis, since the spiral groove constituting the sound record serves as a screw and will, by itself, feed or guide the reproducing stylus as the stylus moves and vibrates along and within the spiral groove. Moreover, in a machine for reproducing sound, employing a record-tablet rotating about a *moving* axis, the spiral groove of the record will also guide and vibrate the reproducing stylus in like manner. *As hereinafter pointed out, this difference in machines employed for recording and for reproducing sound was stated, described and patented by Edison in British patent No. 1644 of 1878 and by Bell & Tainter in U. S. patent No. 341,214, of May 4, 1886, and British patent No. 6027 of May 4, 1886* (*infra*, pp. 65, 80, Points Three and Four). In some cases the machines employed for recording were also employed for reproducing, while in others machines not adapted for recording, because of the absence of the auxiliary feed mechanism, were employed solely for reproducing.

Such being the state of the prior art when Berliner, in 1887, entered the field of recording and reproducing sound, he sought to devise, as he said (T., p. 257), some means of making a sound record which would not infringe the Edison patents of 1878 or the Bell & Tainter patents of 1886. Berliner found, in Scott's anticipating phonauto-

graphic record of 1857, a sound record made in a non-restisting material, such as lampblack, having "no perceptible resistance at all" to the point of the recording or reproducing stylus and being, therefore, incapable of causing the reproducing stylus to be vibrated and the sounds originally recorded to be reproduced. Scott's phonautographic record was, as above stated, a *zigzag* record or record of lateral undulations and uniform depth. *Berliner invented a method of utilizing Scott's record, traced in non-resisting material, by copying it in solid resisting material, capable of causing the reproducing stylus to be vibrated and thereby to reproduce the sounds originally recorded in the non-resisting material.* That such was Berliner's invention appears from his statements to that effect in several patents (U. S. patent, No. 372,786, of November 8, 1887, T., p. 417, lines 87-97; British patent No. 15,232 of 1887, T., p. 517, lines 29-34). For copying in solid resisting material his original record traced in non-resisting material, Berliner employed, among other processes, the etching process (U. S. patent No. 382,790, of May 15, 1888, T., p. 434). The recording stylus removed the non-resisting material, such as lampblack or a solution of wax, from the surface of a metal plate. Acid was then applied to the portions of the metal plate exposed by the action of the stylus and as a result of the etching action of the acid, Berliner obtained a sound record etched in metal, of which he made duplicates by the electrotype process previously described by Edison, as above stated, in 1878 (U. S. patent No. 382,790, of May 15, 1888, to Berliner, T., p. 435, lines 25-58).

For *recording* Berliner employed a machine in which the vibrating recording stylus was caused to

move across the surface of the record-tablet rotating about a fixed axis (T., p. 452), or the axis of the rotating record-tablet was caused to move with reference to the point of a fixed, vibrating, recording stylus (T., p. 526, Fig. 8), by means of a feed-screw, according to the above mentioned well known methods of the prior art employed by Scott, Edison and Bell & Tainter. This appears from a comparison of Scott's *phonautograph* of 1857 (T., p. 244), or Edison's *phonograph* of 1878 (T., p. 334, Fig. 2, and pages 484-485, Figs. 1-15), or Bell & Tainter's *graphophone* of 1885 (T., p. 387, Figs. 1 and 2, and p. 488, Figs. 12 and 13) with Berliner's *gramophone* (T., p. 452, Fig. 1; p. 526, Figs. 1 and 8).

For *reproducing* sound from the record Berliner employed machines in which the reproducing stylus was guided or fed and vibrated by the record-groove, *either with or without the aid of a feed-screw, in precisely the manner disclosed by the Edison British patent of 1878 and by the Bell & Tainter United States and British patents of 1886.* This appears from a comparison of Edison's phonograph of 1878 (T., pp. 484, 485, Figs. 1-15 and p. 486, Figs. 34 and 37), and of Bell & Tainter's graphophone of 1885 (T., p. 387, Figs. 1, 2 and 8; p. 388, Figs. 12 and 13; p. 389, Fig. 14; p. 512, Figs. 1, 2 and 8, and 12 and 13; and p. 513, Fig. 14), with Berliner's gramophone of 1887 (T., p. 416, Fig. 1; p. 463, Fig. 1; p. 465, Fig. 10, and p. 526, Figs. 1 and 8). As hereinafter more fully shown (*infra*, pp. 65-230, Points Three to Eleven), *whatever improvements Berliner made, with reference to machines for recording or reproducing sound, consisted of improvements upon special features only*

of the recording and reproducing machines of the prior art, operating as above described.

Berliner's contribution to the art of recording and reproducing sound, constituting his *principal or basic* invention, consisted in copying in solid resisting material Scott's phonautographic record of lateral undulations and uniform depth traced in non-resisting material, thereby producing, in a new way, a record, *which was old*, capable of use for the reproduction of sound in a sound reproducing apparatus operating in a well known manner of the prior art. The Circuit Court of Appeals has held that Berliner's basic invention has been discarded (151 Fed. 595).

In the prior suit against the American Graphophone Co., upon claims 5 and 35 of the Berliner patent here in suit, Judge Hazel found (T., p. 64; 140 Fed. 860);—

> "At the date of the invention in suit it was not new to record sound and articulated words and *reproduce the same by suitable mechanical agencies.*"

As stated above, and as more fully shown under Points Three and Four (*infra*, pp. 65, 80), the movement of the *reproducing* stylus across the face of a rotating spiral record, without any auxiliary feeding mechanism whatever and solely by reason of the control of the record-groove over the stylus point, was employed in the prior art and was *not* the invention of Berliner. Complainants' contention to the contrary is error.

(*b*). *Berliner's early domestic and foreign patents.*

Berliner's work consists of *three stages*, each of

which is represented by domestic and foreign patents obtained or applied for, respectively, in 1887, 1888 and 1889-1892.

First Stage: In 1887 Berliner invented, and applied for patents upon, the *copying in solid resisting material*, preferably by the *photo-engraving* process, of Scott's phonautographic record traced in non-resisting material, in connection with unimportant *modifications* of the previously well known sound recording and sound reproducing machines. For this invention Berliner obtained British Patent No. 15,232, of November 8, 1887 (T., p. 516); French patent No. 186,827, of November 8, 1887 (T., p. 123); and German patent No. 45,048, of November 8, 1887 (T., p. 132). The drawings of these three foreign patents are identical and by stipulation (T., p. 540, fol. 1620) only the drawings of the British patent are reproduced. The French patent is a literal translation of the British patent (T., p. 81, fol. 242). The German patent describes the same invention with slightly different phraseology.

The three foreign patents each describe an original and a second or improved form of the invention; hence, in the United States Berliner obtained two patents for this invention and improvement thereon, No. 372,786, of November 8, 1887 (T., p. 416), the seven figures of which are identical with Figs. 1-7 of the three foreign patents, and No. 564,586, of July 28, 1896, applied for November 7, 1887 (T., p. 463), of which Figs. 1-9 are identical with Figs. 8-16 of the three foreign patents. Figs. 10 and 11 of the United States patent No. 564,586 are not shown in the foreign patents. Fig. 11 is unimportant, but Fig. 10 is the basis of

complainants' contention that claims 5 and 35 of the patent in suit were not anticipated and were valid. As hereinafter shown under Point Eight (*infra*, p. 164), if complainant's contention is correct, the patent in suit expired with the expiration of the three prior foreign patents, since the three foreign patents describe and claim the invention, if any, shown in said Fig. 10, which Berliner said was a mere modification of Fig. 1 not departing from the main features thereof (T., p. 469, line 90).

Second Stage: In 1888 Berliner invented, and applied for patents upon, an improved process, *the etching process*, for copying in solid resisting material Scott's phonautographic record of lateral undulations and uniform depth traced in non-resisting material. For this invention he obtained British patent No. 7204 of May 15, 1888 (T., p. 528); French patent No. 190,602, of May 15, 1888 (T., p. 124), which is a literal translation of the British patent (T., p. 81, fol. 242); German patent No. 47,099, of May 16, 1888 (T., p. 145), which was a patent of addition to German patent No. 45,048 of the first stage; and U. S. Patent No. 382,790, of May 15, 1888 (T., p. 434).

Third Stage: From 1889-1892 Berliner invented, and applied for patents upon, an improvement in the construction of the *recorder* and *reproducer* of the machines employed by him for recording and reproducing sound, together with an unimportant modification of his etching process of 1888 for recording sound. For this invention he obtained German patent No. 53,622 of November 20, 1889 (T., p. 150), which was a second patent of addition to German patent No. 45,048 of the first stage; French patent No. 207,090 of July

19, 1890 (T., p. 126); and the U. S. patent here in suit No. 534,543 of February 19, 1895 (T., p. 452). As hereinafter shown under Points Six and Seven (*infra*, pp. 114, 152), the patent in suit expired with said prior German and French patents.

(*c*.) *The relation of claims* 5 *and* 35 *of the patent in suit to Berliner's earlier work.*

The patent in suit, including claims 5 and 35 thereof, describes and claims only improvements upon what was described and claimed in Berliner's prior domestic and foreign patents. The sequence of Berliner's work, consisting of improvements upon the prior art and of modifications of such improvements, appears clearly from Berliner's three, successive German patents, of which No. 45,048 of November 8, 1887 (T., p. 132) was the original patent and of which No. 47,099 of May 16, 1888 (T., p. 145), and No. 53,622 of November 20, 1889 (T., p. 150) were first and second patents of addition thereto, being patents for inventions which were improvements upon the invention of the original patent. In accordance with the German patent law (T., p. 180, fol. 538) and the limitations appearing upon the face of the patents, the original patent and the two patents of addition expired together on November 7, 1902, fifteen years from the date of the original patent.

Berliner's original German patent No. 45,048 covers the original or basic form and the second or improved form of his invention and corresponds to his original British patent No. 15,232 of November 8, 1887 (T., p. 516) and to his original French patent No. 186,827 of November 8, 1887 (T., p. 123), each of which covers the original or basic

form and the second and improved form of his invention. In the United States the original or basic form of the invention was described and claimed in patent No. 372,786 of November 8, 1887 (T., p. 416), and the second or improved form of the invention was described and claimed in patent No. 564,586, granted July 28, 1896, upon an application filed November 7, 1887 (T., p. 463).

The original or basic form of Berliner's invention is accurately and briefly described in claim 1 of U. S. patent No. 372,786 of November 8, 1887, as follows (T., p. 419):

> "1. The method or process of recording and reproducing spoken words and other sounds, which consists in first drawing an undulatory line of even depth in a traveling layer of *non-resisting* material by and in accordance with sound-vibrations, then producing the record thus obtained in *solid resisting* material, and *finally imparting vibrations to a sonorous body, by and in accordance with the resisting record*, substantially as described."

In the basic form of his invention Berliner employed lampblack as the non-resisting material in which to record sound vibrations (T., p. 418, line 44), forming a recording surface mounted upon a cylinder or drum (T., p. 419, line 54), but stated that he did not confine himself to the use of lampblack or to a recording surface mounted upon a drum (T., p. 419, lines 54-66). In the second and improved form of his invention Berliner employed a new recording medium consisting of a layer of semi-fluid ink or paint (T., p. 466, lines 77-97) and a flat, instead of a cylindrical, surface upon which to mount the non-resisting recording medium (T., p. 466, lines 40-61). In the second, as well as in the original, form of his invention, Ber-

liner copied in solid resisting material, preferably by the photo-engraving process, now discarded, the sound record traced in non-resisting material, but in the original form of his invention the copied record was shown as a cylinder, while in the second and improved form the copied record was a disc.

For the reproduction of sound from the record copied in solid resisting material, Berliner employed sound-reproducing machines of the prior art, adapted in one case to reproduce sound from a cylindrical, and in the other from a disc, record (T., p. 526, Figs. 1 and 8; p. 465, Fig. 10). As above explained (*supra*, pp. 22-23), in the sound-reproducing machines employed by Berliner, the reproducing stylus was guided or fed and vibrated by the record-groove, either with or without the aid of a feed-screw, in precisely the manner disclosed in the prior art. *In the reproduction of sound from a sound record Berliner employed no new principle whatever, the differences between sound reproducing machines employed by Berliner and those of the prior art consisting of modifications of details of construction, as hereinafter pointed out* (*infra*, pp. 167-170).

The improvement made by Berliner in 1888 upon his basic invention consisted of a new process, now discarded, for copying in solid resisting material the original record traced in non-resisting material. In this new process Berliner substituted a solution of wax for lampblack as the recording medium, moistened the wax film with alcohol, traced the record-groove through the wax film, thus exposing the plate of metal or glass carrying the film, and then, by the use of acid, *etched* the record-groove into the plate, whereupon duplicates of the etched record were made by Edison's electrotype process of

1878. For this improvement of 1888 Berliner obtained the British, French, German and United States patents of 1888 mentioned under the second stage of his work (*supra*, pp. 21, 25). Claims 3 and 5 of the United States patent No. 382,790 (T., p. 436), the claims of which are identical with those of the British and French patents, briefly summarize the principal features of the improvement of 1888 and are as follows;—

> "3. The method or process of producing a record of sound-waves in solid resisting material for reproduction of the recorded sounds, which consists in depositing upon the surface of such material a *film of wax* from a solution of the same in benzine, then making a phonautographic record upon and through the wax film, and then exposing the record to the action of a suitable *etching* agent, substantially as described.
>
> "5. The method or process of preparing solid surfaces for the reception of a phonautographic record, which consists in depositing upon said surfaces a film of wax and then *moistening the wax film with alcohol*, substantially as described."

The relation existing between the inventions of his early patents and the improvements thereon described and claimed in the patent in suit No. 534,543 of February 19, 1895, applied for March 30, 1892, for features of improvement in the "gramophone" (T., p. 452) was stated by Berliner at the outset of the patent in suit as follows (T., p. 456, lines 8-16);—

> "My invention has reference to *improvements* in the *method* of and *apparatus* for *recording* and *reproducing* sounds, the *improvements being more particularly directed to the*

> construction of that kind of sound *recording* and *reproducing* apparatus which I have called gramophone, and for which letters-patent of the United States No. 382,790, dated May 15, 1888, have been granted to me."

Thus we see that the invention of the patent in suit was an improvement upon the gramophone of patent No. 382,790 of May 15, 1888, and that, according to Berliner's statement above quoted from the patent in suit, *the improvement was made subsequent to May 15, 1888.*

In patent No. 382,790 of May 15, 1888 (T., p. 434, lines 8-20) and in patent No. 564,586 of July 28, 1896, applied for November 7, 1887 (T., p. 466, lines 8-39), Berliner states that the inventions thereof are improvements upon that described in his patent for the original and basic form of his invention, No. 372,786 of November 8, 1887 (T., p. 416).

When, therefore, Berliner filed his application for the patent in suit, No. 534,543, on March 30, 1892, he had already secured No. 372,786 on November 8, 1887, and No. 382,790 on May 15, 1888, and had, more than four years previously, and on November 7, 1887, filed his application for No. 564,586, although the patent upon the application of November 7, 1887, did not issue until July 28, 1896. He had also secured, for *Suess'* improvements upon his gramophone, Letters-Patent of the United States, No. 427,279, issued May 6, 1890, on an application filed August 6, 1889 (T., p. 446), and Letters-Patent of Canada, No. 41901, issued February 11, 1893, on an application filed May 5, 1891 (T., pp. 155-175), which Letters-Patent of Canada for Suess' improvements Judge Townsend found (T., p. 324, fol. 971), "*discloses and broadly*

claims the invention covered by the claims here in suit."

The application for the patent in suit, therefore, was filed several years later, at least four years later, than the application for any one of the other three Berliner patents above mentioned and considerably later than the application for either of the two Suess-Berliner patents mentioned. We should expect to find in the patent in suit, therefore, a statement that the invention of this patent consists in *improvements upon* the gramophone of the earlier patents; and such is the statement which Berliner makes in the first words describing the invention of the patent in suit, for at page 456, lines 17-36, he says;—

> "*One feature* of my invention has reference to *improvements* in the *method of recording sound* by tracing upon a fatty film deposited upon a metallic surface, undulatory lines, corresponding to sound waves, and then etching such lines in the metal base, or, as it is now commonly called, the record tablet; while the *other features* of my invention have reference to the *construction of the details of both the recorder and the reproducer of the gramophone.* Each of these *features of improvement* are designed to overcome certain difficulties, and to avoid certain imperfections *heretofore met with in the operation of the gramophone.* These difficulties and imperfections, and the manner in which they are avoided, will be particularly pointed out in the following detailed description with reference to the accompanying drawing, in which—"

In the specification Berliner first describes his improved *recording machine as a whole* (p. 456, line 31, to p. 458, line 2.) This improved recording machine is illustrated in figures 1 and 2. The

construction of the apparatus for the convenient *application of alcohol*, more alcohol than was used according to prior patent No. 382,790, during the process of recording, is the main feature here described of the improvement. Next Berliner describes the recording diaphragm and stylus or *recorder* (p. 458, line 3 to line 109). The recorder is illustrated in figures 4 and 5 of the drawings and is shown in figures 1 and 2 as part of the recording machine. Next Berliner describes the *mouth-piece* shown in figure 8 (p. 458, lines 110-126). Next Berliner describes the use of the recording machine for the recording of sound with the aid of *alcohol spread continuously*, instead of once as in prior patent No. 382,790, upon the surface of the record tablet (p. 458, line 127, to p. 459, line 94). This operation is illustrated in Figure 1. Next Berliner describes the *reproducing apparatus as a whole* (p. 459, line 95, to p. 460, line 33). It will be noticed that although Berliner states that "*My* improved gramophone recorder is shown as a whole in figs. 1 and 2" (p. 456, line 51), he does not state that the reproducing apparatus as a whole is his invention; but his language is, "*The* reproducing apparatus as a whole is represented in Fig. 3," (p. 459, line 95). As will hereafter be shown (*infra*, pp. 105-110), the reproducing apparatus as a whole and the main features of the reproducing apparatus were, *according to Berliner's own statements*, the invention of Werner Suess. Suess, however, was anticipated by Edison and Bell & Tainter (*infra*, pp. 65, 80). Next Berliner describes the reproducing diaphragm and stylus or *reproducer* (p. 460, lines 34-102). The reproducer is illustrated in figs. 6 and 7, is shown as *part of the Suess reproducing apparatus illustrated as a whole*

in fig. 3, and embodies the true essence of the improvements claimed in claims, 5 and 35, in suit.

Next come the *claims of the patent*, thirty-five in number. Claims 1-4 cover the continuous use of alcohol in the process of recording. Claim 5, in suit, covers Edison's prior *method* of reproducing sound, consisting in "*vibrating*" and "*propelling*" a stylus "*along*" a record, by and in accordance with the record. Claims 6-16 cover the improved *recording* diaphragm and stylus or *recorder*. Claims 17-22 cover a new form of the horizontal rotary table, shown in the earlier application for patent No. 564,586 and in the prior foreign patents of 1887. Claim 23 covers the *mouth-piece* shown in fig. 8. Claims 24-34, except claim 31, which is for the *recording* stylus, are for the improved *reproducing* diaphragm and stylus or *reproducer*, claim 25 covering also the improved *recording* diaphragm and stylus. Claim 35, in suit, covers *something not stated*, IN Edison's prior reproducing apparatus, consisting of a *travelling* tablet having a sound record formed thereon and a reproducing stylus, shaped for engagement with the record as in claim 32 and *free to be vibrated and propelled* by the record.

Such then are the description and claims of the patent in suit covering *as one feature*, the improvement in the *method of recording* and covering, *as the other features*, the construction of the *recorder* and the *reproducer* of the gramophone, and constituting *improvements* upon the method of, and apparatus for, recording and reproducing sound set forth in the *basic patent* No. 372,786, and in the other earlier patents above mentioned.

A comparison of Figs. 1 and 2, which show Berliner's improved recording apparatus as a whole,

with Figs. 4 and 5, which show the improvements in the recorder, makes it clear that the improvements in the *recorder* are incorporated in the improved recording apparatus as a whole and form a *substantive* part thereof. So a comparison of Fig. 3, which shows the Edison-Suess reproducing apparatus as a whole, not claimed by Berliner to be his invention, with Figs. 6 and 7, which show the improvements in the reproducer, makes it clear that the improvements in the *reproducer* are incorporated in the reproducing apparatus as a whole and form a *substantive* part thereof, and are, indeed, the *essence* of the improvements in the reproducing apparatus for which, together with the improvements in the recorder, Berliner applied for the patent in suit. *As hereinafter shown* (*infra*, p. 96) *the reproducing apparatus shown as a whole in Fig. 3 and its method of operation were unquestionably the invention of Werner Suess, and Berliner so stated, when as Suess' assignee he applied for and obtained Canadian patent therefor No. 41,901, issued Feb. 11, 1893, applied for May 5, 1891* (T., pp. 155-175). Judge Townsend, moreover, so found, for he states in his opinion that the Suess-Berliner Canadian patent "*discloses and broadly claims the invention covered by the claims here in suit*" (T., p. 324, fol. 971). Suess, however, was, as above stated, anticipated by Edison and Bell & Tainter (*infra*, pp. 65, 80).

From the foregoing analysis and consideration of the patent in suit, it appears, without question, that the *improvements* described and claimed relate, *first*, to the recording of sound, and, second, to the reproducing of sound. It is impossible seriously to contend that the essence of the improve-

ments consists rather in the *reproduction* of sound than in the *recording* of sound.

In the passage above quoted from the patent in suit (*supra*, p. 31), Berliner specifically stated the important features of the invention described and claimed in the patent. *One feature* he said has reference to improvements in the *method of recording sound*, while *the other features* have reference to the construction of both the *recorder* and the *reproducer* of the gramophone. These features of improvement were designed, he said, to overcome certain difficulties and to avoid certain imperfections theretofore met with in the operation of the gramophone. This was the patentee's express declaration of the features of the improvement contained in the patent. He did not claim that Suess' sound-reproducing *machine* illustrated in Fig. 3 was his invention, nor did he state that such machine or the mode of operation thereof was a feature or the principal feature of the invention described in the patent. As stated by the Circuit Court of Appeals for the Second Circuit, in *Matheson* v. *Campbell*, 78 Fed. 910, 917;—

> "It must be *sound law*, as it is reasonable *common sense* to hold that the *tests of prime importance* in a suit for infringement are those which the *patent itself* prescribes. The inventor certainly may be assumed to know what it is that he has invented. If any one is able to describe the product of his inventive skill, it is himself. He surely knows the ear-marks of the thing he seeks to patent. * * *"

In the face of this express and positive declaration of the patentee as to what are the *features* of his invention, the Courts below not only held

that the patent included other features not enumerated by Berliner, but *went even further and held that the features which Berliner did enumerate as the features of his invention are not the principal features of his invention but are mere minor details* (T., p. 318). In other words, the Courts below held that the patentee did not know what it was that he invented. In his lecture before the Franklin Institute (T., p. 266), Berliner said:

> "I will now describe the *most important* apparatus of the *gramophone*—the *recorder*."

Equally important with the *recorder* is, of course, the *reproducer*, which as Berliner stated in the Franklin Institute lecture, "is constructed on precisely the same principles as the recorder" (T., p. 268). The *recorder* and the *reproducer* each consists of a diaphragm and stylus suitably constructed and conected. *The patent in suit is the first patent, except the prior foreign patents for the same invention, in which Berliner describes and claims his recorder and reproducer whereby the stylus is permitted to be vibrated laterally instead of vertically.*

> *(d). The expression "principal invention" was used by this Court in Siemens' Adm'r v. Sellers, 123 U. S. 276, merely to designate one of two inventions, and not as a ground of decision. The Courts below erred in refusing to follow the principle of the decision in that case and erred in holding that, because, contrary to Berliner's express statements, they regarded one feature as more important than other features of the invention, the patent in suit has a plurality of terms.*

The expression "principal invention" was used by this Court to denote an invention upon which a subsequent invention constituting an improvement had been made. This was in the case of *Siemens' Adv'r* v. *Sellers*, 123 U. S. 276, where it was held that a United States *patent* was limited as to its *term* by a prior English patent because both patents claimed "*an*" invention, which in that case happened to be the original invention upon which improvements, constituting a separate invention, had subsequently been made and claimed in the United States patent. *The expression "principal invention" was used in antithesis to an invention consisting of claimed and patentable "improvements" upon that invention, which also necessarily consisted of patentable "improvements," merely to refer to and to point out* AN *invention which was found in both the United States patent and in the prior English patent;* but the relative importance of the original invention and of the invention consisting of improvements upon it was not considered or stated by this Court and in no sense entered into the decision of the case, for this Court expressly said, that a patent "*cannot be construed as running partly from one date and partly from another. This would be productive of endless confusion.*" In other words this Court squarely held that if a United States patent, expires as to one or more of its claims for *an invention*, previously patented in a foreign country, for which it was granted, it must expire as to all of its claims, no matter what other invention they may cover. A United States patent, therefore, must have a *single* term, which cannot, where the United States patent is "granted for *an invention*" (Rev. St. §4887) previously patented in a foreign

country, exceed the *shortest term* of the terms of the prior foreign patents. But the Courts below in the suit at bar, refusing to follow the decision of this Court to the effect that a patent "cannot be construed as running partly from one date and partly from another" have held that although the patent in suit has expired as to many or most of its thirty-five claims, it, nevertheless, survives as to the two claims, 5 and 35, in suit. *For the first time in the history of the patent law of this country it has been held, contrary to the clear provision of §4887 of the Revised Statutes and to the decision of this Court in Siemens' Adm'r v. Sellers, supra, that a patent can be construed as having a plurality of terms and as running partly to one date and partly to another and that the endless confusion necessarily resulting therefrom is, in effect, a matter of no consequence.* As will hereinafter be more fully shown (*infra*, pp. 127-135), the Courts below erred in so holding. At the present time it is intended merely to point out that, under §4887 of the Revised Statutes, the relative importance of the subject matter of various claims of a patent is not controlling; and that it cannot reasonably be held or said of the claims of the patent in suit either that the claims which cover the reproduction of sound are more important than those which cover the recording of sound, or that among the several claims covering the reproduction of sound any tenable ground exists for holding that the two claims in suit, 5 and 35, are more important than the others, which cover *principal* and *essential* features of improvement of the patent according to the express statement of the patentee. *They are all claims for improvements,*

stand in the same category, and are subject to the same rule of law, as to expiration under the Statute.

The Revised Statutes (§4887) provides;—

> "But every *patent* granted for *an* invention which has been previously patented in a foreign country *shall be so limited* as to expire at the same time with the foreign patent, or, if there be *more than one*, at the same time with the one having the *shortest term*."

This provision fixes the *term* of the home *patent*, which *term* shall expire with the expiration of the term of the prior foreign patent, *provided that the invention previously patented in a foreign country is an invention also covered by the home patent.*

The Courts below, by their decision, have involved the patent law in the "*endless confusion*" which this Court said would be the result of holding that a patent could have a *plurality of terms.* It is respectfully submitted that if the courts are to weigh the relative importance of the different claims of a patent and are to differentiate the various claims of a patent by holding that some of the claims are for features that are basic in their nature and that others are for features that are not basic in their nature, and are to hold, by judicial construction and *not upon any provision of the statute*, that, by reason of such subtle distinction, §4887 of the statute does not apply where the *invention* previously patented in a foreign country and claimed in the home patent is, *in its opinion*, not basic, and does apply where such invention is, *in its opinion*, basic, the condition of uncertainty and confusion resulting therefrom would be intolerable. And how, and by what rule, it may be asked, is the court to determine which claims are

for features that are basic and which claims are for features that are not basic? Is each patent to be a law unto itself? Is the court to read into the statute conditions and provisions not contained in the statute? Is the question of expiration, under the statute, and the application of the statute to be left to judicial discretion and discrimination? The mandate of the statute is clear and unambiguous. It leaves no room for confusion and uncertainty. Under it, where an *invention* previously patented in a foreign country is patented in this country, the home "*patent*," and, therefore, *all* the claims thereof, must be so limited as to expire with the expiration of the foreign patent, or if there be more than one prior foreign patent, with the expiration of the one having the *shortest* term. The only question open to the court for determination, under the statute, is whether *the invention previously patented in the foreign country* is an invention covered by the claims of the home patent. If so, the statute *applies*, and it is immaterial whether or not the home patent covers some *other* invention because, *if it is subject to that statute or law at all*, it must, under the well settled law and the clear mandate of the statute, expire with the foreign patent (see discussion and authorities cited, *infra*, pp. 135-145, under Point Six). Upon the expiration of the patent, all its claims expire, since, as this court said, a patent cannot be construed as running partly to one date and partly to another, for this would be productive of endless confusion. In other words, *a patent cannot expire in parcels, it cannot have a plurality of terms.*

Whether two patents are granted for the same invention is a question of law to be determined by the court from a comparison of the patents. The question of infringement is also one of law.

These propositions are well settled (*Miller* v. *Eagle Mfg. Co.*, 151 U. S., 186, 196; *Heald* v. *Rice*, 104 U. S., 737, 749; *Singer Co.* v. *Cramer*, 192 U. S., 265, 275; *Thomson-Houston Co.* v. *Western Co.*, 158 Fed. 813, 816; *Western Electric Co.* v. *Robertson*, 142 Fed. 471, 478).

The questions presented are, therefore, *pure questions of law*, arising upon the face of the patents and other printed publications contained in the record. They were so considered and decided by the Courts below. Although defendant's witnesses have dealt fully with the subject matter of the patents and publications referred to (T., pp. 76-123; pp. 191-197; pp. 230-242; pp. 283-313), the subject matter of the patents and publications is so clear, that reference to the testimony of the witnesses would, in most cases, be superfluous.

The specifications and drawings of the prior German and French patents relied upon are properly proved, together with certificates of the Patent Offices and the laws of Germany and France.

Rule 13 of this Court reads as follows:—

> "In all cases of equity or admiralty jurisdiction, heard in this court, no objection shall hereafter be allowed to be taken to the admissibility of any deposition, deed, grant, or other exhibit found in the record as evidence, unless objection was taken thereto in the court below and entered of record; but the same shall

otherwise be deemed to have been admitted by consent."

The evidence was closed at the time of the argument in the Circuit Court. No objection was made by either party to the evidence introduced by the other party, and no objection was entered of record. In the Circuit Court of Appeals, however, complainants' counsel, realizing the effect of the prior German and French patents, raised the technical and invalid objection that the *deeds* of grant had not been offered in evidence. If the objection had been made in the Circuit Court before the close of the evidence and entered of record or inserted in the decree, the objection would not be valid.

It is well known that the German Patent Office will not grant a copy of the patent deed, and such it is believed is the practice of the French Patent Office, since a copy of the patent deed in the suits at bar was requested but could not be obtained. In Canada, it was requested and obtained (T., p. 155). However, the copies of the German and French patents are certified by the Patent Offices of Germany and France. The grant of the patents, the duration of the patents, the subject matter of the patents all appear. Judge Severens dealt summarily with such objections in *Western Elec. Co. v. Citizens' Tel. Co.*, 106 Fed. 215. Reference to the cases on appeal in *Siemen's v. Sellers*, 123 U. S., 276, and *Commercial Mfg. Co. v. Fairbank Co.*, 135 U. S., 176, and to all the reported cases shows that the certification of the foreign patent office of the description, claims and drawings of a foreign patent is sufficient, and clearly it is sufficient when accompanied by the certified preliminary statements here in evidence. Furthermore, the question is conclusively settled by the following clear

provision of §893 of the Revised Statutes, which reads as follows;—

> "Copies of the *specifications* and *drawings* of foreign letters patent certified as provided in the preceding section, shall be *prima facie evidence* of the fact of the *granting* of such *letters patent*, and of the *date* and *contents* thereof."

Under this section no copy of the patent deed, which, as is well known, cannot be obtained from many foreign countries, is necessary. In *Pohl* v. *Anchor Brewing Co.*, 134 U. S., 381, 383, this Court held that from the face of the specification the duration and date of a prior foreign patent could be obtained; so did the examiner of patents in *ex parte Trotter* 32 O. G., 1603. As appears from § 893 of the Revised Statutes above quoted, and from § 1015 of Robinson on Patents, certified copies of the specifications and drawings of foreign letters-patent, certified by the head of the foreign patent office, are *prima facie* evidence of the fact of the granting of such letters-patent, and of the date and contents thereof, and are admissible in evidence. In *Rosseau* v. *Brown*, cited by complainant's counsel in the Circuit Court of Appeals, the question was, what was the date of *application* of the foreign patent? The court did not hold that under § 893, above quoted, certified copies of the specifications and drawings of a foreign patent were not evidence of the *granting* of the letters-patent and of the *date* and *contents* thereof, but held only, that the French patent deed had not been exhibited in evidence and that even if it had been in evidence it would have had no effect, since, in the interference in question, the contesting party was entitled to priority.

In addition to the certified copies of the German,

French and Canadian patents offered in evidence, the material parts of the Patent Acts of France, Germany, Canada and Great Britain (T., pp. 176-190), in force at the times the aforesaid patents were applied for and granted, were proved in evidence without objection (T., p. 81, fols. 243-244).

Clearly, under Rev. St. § 893 above quoted, the duly certified copies of the specifications and drawings of the foreign letters-patent are *prima facie* evidence of the granting thereof and of the dates and contents thereof In addition, the laws of the foreign countries are in evidence, proved without objection. If complainants had any valid objection to make, such objection should have been made in the Circuit Court, whereupon the objection, if valid, could have been met by defendant.

It would seem, although the point has never been directly passed upon, that the courts should take judicial notice of the Patent Acts of foreign countries

Judge Severens said in *Western Electric Co.* v. *Citizen's Tel. Co.*, 106 Fed. 215, that the court ought to take judicial notice of such facts as the laws of foreign countries relating to patents as being within the range of information conveyed by encyclopedias and other repositories of facts of general interest. In *Pohl v. Anchor Brewing Co.*, *supra*, and many other cases which might be cited *Carpmael's Patent Laws of the World* was used as the source of information for the patent laws of France and Germany.

That the courts of the United States will take judicial notice of an act of Canada where the act has the notoriety sufficient for such purpose was decided by this court in *The New York*, 175 U. S., 187, 195-197, where it was held that an act of Can-

ada regulating the navigation of Canadian waters was an act of such general application and notoriety as to warrant the courts of the United States to take judicial notice of it. Since § 4887 of the Revised Statutes limits the term of the home patent by the legal term of a foreign patent, and since the patent laws of foreign countries are set forth in encyclopedias and other repositories of general information, as stated by Judge Severens, no distinction can exist between the patents laws and the navigation laws of foreign countries by reason of which the courts of this country should take judicial notice of the navigation laws and should not take judicial notice of the patent laws of foreign countries. As stated by this court in the case cited, following an opinion of Chief Justice Marshall in an early case, the courts of this country can take *judicial notice of the public laws of a foreign nation on a subject of common concern to all nations and the negative of this proposition, said the great Chief Justice, has not been maintained in any of the authorities adduced.* The principle cannot be confined to admiralty cases.

POINT ONE.

Claims 5 and 35 of the patent in suit are void because they are claims for the functions of a machine.

(*Assignment of errors 30 and 31, supra, p. 12*).

Claims 5 and 35 of the patent in suit read as follows:

> "5. The *method* of reproducing sounds from a record of the same which consists in *vibrating* a *stylus* and *propelling* the same *along* the

record *by* and in accordance with the said *record*, substantially as described.

"35. In a sound reproducing apparatus consisting of a *traveling tablet* having a sound record formed thereon and *a reproducing stylus* shaped for engagement with said record and *free to be vibrated and propelled* by the same, substantially as described."

In the contempt proceedings in this suit, to review which this court granted its additional writ of *certiorari* (case No. 81, October Term, 1908), Judge Wallace, at the opening of his dissenting opinion in the Circuit Court of Appeals, said (154 Fed. 61);—

"In considering the question of infringement, claim 5 may be laid out of view, as it covers merely *the function of the machine or combination of claim 35*. It is more than doubtful whether the claim is not void upon its face, but assuming it to be valid, as must be done for present purposes, it is not infringed except by using the combination or machine of claim 35."

In the reproduction of sound from a record of the same, according to claim 5, *a traveling tablet* having a sound record formed thereon and *a reproducing stylus* shaped for engagement with said record and in engagement therewith and free to be vibrated and propelled by the record are necessary, including the mechanism necessary to make the record-tablet travel and to mount the stylus. In other words, all the elements of the sound reproducing apparatus or machine described in claim 35 are necessary for carrying out the method of claim 5. On the other hand, the method of claim 5 can be carried out *only* through the employment of all

the elements constituting, in combination, the sound reproducing apparatus described in claim 35. Whether the stylus is mounted on Edison's or Suess' pivoted, swinging arm, as in Fig. 3 of the patent in suit, or is held by the hand of the operator is immaterial, because in either case all the elements mentioned of the *sound reproducing machine* are necessary, are the same and are present. The pivoting of the stylus by a human arm instead of by an arm of wood does not justify complainants' contention that claim 5 is not a claim for a function. Planing a board, holding the plane in the hand, is a mechanical process and not patentable, because the so-called "process" is nothing but the function of a machine (*Westinghouse v. Boyden Co., infra*, pp. 56-57). Clearly claim 5 is, as Judge Wallace said, merely a claim for the function of the machine or combination mentioned in claim 35. Claim 5 is, therefore, invalid.

The specification of the patent in suit describes one, and only one, way and means of practicing the method of claim 5. The specification says (T., p. 460, lines 19-33);—

> "It will now be understood, that when *a record tablet*, having a record of sound waves upon its surface, produced in accordance with my invention, is mounted upon the table 79, and when the point of *the stylus* is *adjusted in engagement* with the record groove, *and the wheel 80, is rotated, the rotating record groove* will *guide* the stylus across the face of the tablet, *and* will at the same time *vibrate* the stylus and diaphragm in accordance with the undulations of the record groove. The sound waves thus produced by the diaphragm will issue from the flaring opening of the trumpet, and the sounds will be heard by a listener in front of the trumpet, or in its vicinity."

The passage quoted describes the function of the machine or combination mentioned in claim 35. Unless the elements of the machine or combination mentioned in claim 35 are all employed precisely as set forth in the patent, the method of claim 5 cannot be practiced.

It is, of course, immaterial whether the reproducing stylus is "*free to be vibrated and propelled*," along the record, by and in accordance with the record, because its freedom for such purpose is due

(1) to its adjustment at the free end of a *movable or pivoted arm* as shown in Figs. 34 and 37 of prior British patent No. 1644 of 1878 to Edison (T., p. 486), which patent, as shown under Point Three (*infra*, p. 65), is a complete anticipation of claims 5 and 35 of the patent in suit; or

(2) is due to the employment of a universal joint obtained by the use of *a rubber tube* to which the reproducer carrying the stylus is affixed, as shown in Figs. 8 and 13 of prior U. S. patent No. 341,214 of May 4, 1886 to Bell & Tainter (T., p. 387), which patent, as shown under Point Four (*infra*, p. 80), is another complete anticipation of claims 5 and 35 of the patent in suit, and which rubber tube, supported by the Edison-Suess pivoted arm, was shown by Berliner in his lecture before the Franklin Institute of May 16, 1888, to embody the novel feature which complainant now contends is covered by claims 5 and 35 (T., p. 269, "Reproducing Apparatus, May, 1888"; p. 270, fol. 809; p. 232, Q 14); or

(3) is due to the employment of the discarded and impractical arrangement, consisting of *a truck* carrying the diaphragm and stylus and *provided*

with wheels rolling upon a horizontal rod, shown in Fig. 10 of U. S. patent No. 564,586 of July 28, 1896, applied for November 7, 1887, to Berliner (T., p. 465); or

(4) is due to the employment of a diaphragm and stylus mounted on the free end of *a pivoted, swinging arm* permitted to move in reproducing sound by a pin traveling in a guide-groove or by a feed-screw, so that the reproducing stylus is at all times free to be vibrated, guided and propelled along the record by and in accordance with the record, as shown in Figs. 1-15 of prior British patent to Edison, No. 1644 of 1878 (T., p. 484), or in Figs. 1 and 8 of Berliner's prior British patent No. 15,232 of 1887 (T., p. 526).

In all such cases the reproducing stylus is "*free to be vibrated and propelled*," by and in accordance with the record, and "*along*" the record, as stated in claims 5 and 35. The only limitation stated in claim 5 or in claim 35 is that the stylus shall, in the case of claim 5, be *vibrated and propelled* "*along the record*" by and in accordance with the record, or, in the case of claim 35, that the stylus shall be "*free to be vibrated and propelled*" along the record, by and in accordance with the record. The *means* by which the stylus is made "*free to be vibrated and propelled*" along the record, by and in accordance with the record, are not stated or referred to in either claim, but the *function* alone is claimed of an arrangement by which the stylus shall be "*free to be vibrated and propelled.*"

It should also be remarked that the record mentioned in claims 5 and 35 is not limited to a record having a *spiral* record-groove and the statement is that the stylus shall be propelled "*along*" the

record and not *across* the record. A record consisting of a straight groove upon a travelling tablet might, therefore, be employed. Such records were common (T., p. 473, line 53; p. 487, Figs. 56 and 57). There is, moreover, no limitation that the propelling of the stylus by the record shall occur in a machine not provided with suitable feed mechanism to keep the arm carrying the stylus properly adjusted so that the stylus shall at all times be free to perform its functions of following along the record and vibrating.

Claim 35 cannot be limited and held valid by construing the stylus "free to be vibrated and propelled" as meaning a stylus mounted upon a swinging arm, such as the swinging arm shown in Fig. 3 of the patent in suit (T., p. 454), because, as Berliner stated in his lecture before the Franklin Institute (T., p. 270, fol. 809) and in the Canadian patent which he obtained as the assignee of Suess (T., pp. 155-175), the swinging arm arrangement shown and described was broadly the invention of Suess. Judge Townsend found (T., p. 324) that the Canadian patent to Berliner for Suess' invention "discloses and *broadly claims* the invention covered by the claims here in suit," and "describes and claims the broad generic invention thereof" (T., p. 325). Moreover, such a limitation of claim 35 would invalidate it, not only because Berliner *shows no construction of his own invention* upon which the claim thus limited can be read, but because the *mounting* of a stylus as shown in Fig. 3 of the patent in suit, so that it shall be "free to be vibrated and propelled" along the record, by and in accordance with the record, was anticipated not only by Suess, but also by Edison, as shown especially in Figs. 34 and 37 of British patent No. 1644 of 1878

(T., p. 486; discussed under Point Three), and by Bell & Tainter, as shown by Figs. 8 and 13 of U. S. patent No. 341,214 of May 4, 1886 (T., p. 387; discussed under Point Four), and by the swinging arms of the prior art, which were kept in position by the aid of a feed-screw or guide-pin moving in a spiral groove, as shown by Figs. 1-15 of British patent No. 1644 of 1878 to Edison (T., p. 484; discussed under Point Three), so that the stylus was at all times free to be vibrated and propelled along the record, by and in accordance with the record.

This whole matter is summed up in claim 1 of British patent No. 1644 of 1878 to Edison, which reads as follows (T., p. 482);—

> "First. The combination with the diaphragm and point of a flat receiving surface and *means* for *revolving* the receiving surface, and *causing the point to follow a volute or spiral line*, substantially as represented in Figs. 1, 2, 6, 7, 8, 9, 10, and 34."

The expression "means for * * * causing the point to follow a volute or spiral line" employed by Edison in the above quoted claim, has the same significance, when applied to Edison's sound-reproducing apparatus, as Berliner's expression "a stylus * * * free to be propelled" by the record.

By reference in said claim 1 to Figs. 1 and 2, Edison showed that the point or stylus was, in *reproducing* sound, forced to follow the spiral line of the record solely by the pressure exerted upon the stylus by the walls of the record-groove, and that the point moving in the central spiral groove 3, necessary in recording, might be retained in reproducing, since its movement would *permit* the stylus to be freely vibrated and propelled by the

record-groove, but would not *cause* the same. *Only the record can vibrate the reproducing stylus and the force that vibrates it alone propels it.* By reference in said claim 1 to Figs. 6, 7, 8, 9 and 10, Edison showed that feed mechanism, used in recording, might also be retained in reproducing for the same reason.

By reference in said claim 1 to Fig. 34, Edison showed that the feed mechanism, as well as the central spiral groove 3 of Fig. 2, necessary in recording a spiral groove, might be dispensed with altogether in the reproduction of sound, and that the walls of the record-groove would, by themselves, cause the stylus to be fed across the face of the record as it vibrated and traveled along the spiral record-groove of the rotating tablet. A description of Fig. 34 (discussed under Point Three) is to be found at page 479, lines 48-53.

In Fig. 37 Edison also disclosed a stylus free to be vibrated and propelled by the record-groove without the presence of feed mechanism and solely by reason of the pressure exerted upon the stylus by the walls of the traveling record-groove. A description of Fig. 37 (discussed under Point Three) is to be found at page 480, lines 11-14, from which it appears that the stylus is carried "upon a *pivoted arm* so that it may *swing across* or at right angles to the line of movement of the indented material or phonogram." The line of indentation might be lengthwise of the traveling belt or across the same in the arc of a circle. In other words, the record-groove might be a continuous circle upon the belt or a volute or spiral line upon the belt, as upon a cylinder, and, in case the record-groove consisted of a spiral line, the stylus carried by the pivoted arm would be vibrated and

propelled across the belt, at right angles to the line of movement of the traveling record-groove, the pressure exerted by the walls of the record-groove upon the point of the stylus causing the pivoted arm to swing.

Thus Edison distinctly pointed out and claimed, as *equivalents*, the causing of the stylus to follow the record-groove, either by propelling the stylus across the face of the record by the walls of the record-groove *alone, as in Figs. 34 and 37*, or by similarly propelling a stylus mounted on the free end of a pivoted, swinging arm, permitted to swing by a guide-groove or a feed-screw, as in Figs. 1-10, for example.

As shown, in considering the relation of Berliner's work to the prior art (*supra*, pp. 17-19), Edison, in his British patent No. 1644 of 1878, as well as in his U. S. patent No. 200,521, of February 19, 1878, disclosed the *zigzag* record, that is, a record of lateral undulations and even depth, similar to Scott's phonautographic record of 1857. Neither claim 5 nor claim 35 sets forth any limitation restricting the claim to a record of even depth (*Cincinnati Co. v. American Co.*, 143 Fed. 322, 325). Judge Hazel in the prior suit, referring to claims 5 and 35, said (140 Fed. 864):—

> "The broad claims in suit in my judgment cannot be restricted to a record of even depth."

As shown by the evidence, the mode of operation is precisely the same whether the record employed is of even or of uneven depth (T., p. 294). This was decided years ago by the courts in the litigation over the prior Bell & Tainter patent No. 341,214 (*infra*, pp. 92-96; and 74 Fed. 789 and 87 Fed.

873, 878). The equivalency of the two types of records in this respect also appears in Edison's British patent No. 1644 of 1878 (*supra*, pp. 17-19).

Clearly an attempt is made in claim 35 of the patent in suit to claim a function and not means for accomplishing the function. Moreover, *the function claimed is the only thing upon which any pretense of novelty can rest.* Sound reproducing apparatus was old. A traveling tablet having a sound record formed thereon was old. A reproducing stylus shaped for engagement with said record was old. A stylus free to be vibrated was old, and although a stylus free to be propelled by a record-groove was old, as above shown, nevertheless, *upon this function as the sole pretense of novelty*, complainants argue that claim 35 broadly covers every sound reproducing apparatus in which the reproducing stylus is free to be propelled along the record, by the record. The claim is vicious, comes under the condemnation repeatedly made by this court of similar claims and is void.

Authorities showing that claims 5 and 35 of the patent in suit are void because they are claims for the function of a machine.

The decision of this Court in *Westinghouse* v. *Boyden Co.*, 170 U. S., 537, 554 (18 C. C. 70 Fed., 816, 829), is sufficient authority to show that claims 5 and 35 are invalid as being for the function of a machine. In that case it was held that if, in a claim for a combination of mechanical elements, *one* of the elements be properly interpreted as a function, the entire claim would be void, since it would be open to the objection, held in several cases to be fatal, that the mere function of a machine cannot be patented. Clearly claim 5 describes

nothing but the function of the machine illustrated in Fig. 3. Claim 35 includes as an element a stylus "*free to be propelled*" by the record. This function is clearly the function of the stylus shown in Fig. 3 of the patent in suit.

In *Westinghouse* v. *Boyden Co.*, 170 U. S., 537, this Court considered the following claim:

> "2. In a brake mechanism, the combination of a main air pipe, an auxiliary reservoir, a brake cylinder and a triple valve having a *piston* whose preliminary traverse admits air from the auxiliary reservoir to the brake-cylinder, *and which by a further traverse admits air directly from the main air pipe to the brake cylinder*, substantially as set forth."

The Circuit Court of Appeals (70 Fed., 816, 829) held this claim invalid, saying:

> "We think that when Claim 2 of 360070, in its language describing the action of that device, failed to describe the means by which the extreme traverse of the piston produced it, declaring merely that the piston by a further traverse admits air directly from the main air-pipe to the brake-cylinder, it was fatally defective, claiming only *a result, which is public property*, and not identifying the specific *means* (this own property) by which the result is achieved."

This Court, speaking of the same claim (170 U. S., 554) said:

> "The claim in question is, *to a certain extent*, for a function, viz., the admission of air directly from the train-pipe to the brake-cylinder, and is only limited to such function when performed by the further traverse of the piston of the triple valve. This *limitation*, however, does not vitiate the objection that the

means are not fully and specifically set forth for the performance of the function in question.

"The difficulty we have found with this claim is this: that if it be interpreted simply as a claim for the function of admitting air to the brake-cylinder directly from the train-pipe, it is open to the objection, held in several cases to be fatal, that the mere function of a machine cannot be patented."

(p. 568). "But after all, even if the patent for a machine be a *pioneer*, the alleged infringer must have done something more than reach the same result. He must have reached it by substantially the same or similar means, or the rule that the function of a machine cannot be patented is of no practical value. *To say that the patentee of a pioneer invention for a new mechanism is entitled to every mechanical device which produces the same result is to hold, in other language, that he is entitled to patent his function.*"

It is clear, therefore, that if, in a combination claim for a machine, *one element* of the combination claimed is a *function* of a part of the machine, the claim is invalid. The reason is that the function or effect of the machine is not patentable, and the insertion of a function as an element into a combination claim for a machine vitiates the *entire claim* and renders it invalid.

Perhaps the leading case upon the question of what is a patentable process is *Corning* v. *Burden*, 15 How., 252, in which, as stated by this Court in *Westinghouse* v. *Boyden Co.*, *supra*,

"Mr. Justice GRIER, delivering the opinion of the Court, drew the distinction between such processes as were the result or effect of 'chemical action, by the operation or applica-

tion of some element or power of nature, or of one substance to another,' and the mere result of the operation of a machine, with regard to which he says:

"'It is for the discovery or invention of some practicable method or means of producing a beneficial result or effect that a patent is granted, and *not for the result or effect itself.* It is when the term 'process' is used to represent the means or method of producing a result that it is patentable, and it will include all methods or means *which are not effected by mechanism or mechanical combination.*

"'But the term 'process' is often used in a more vague sense, in which it cannot be the subject of a patent. Thus we say that a board is undergoing the process of being planed, grain of being ground, iron of being hammered or rolled. Here the term is used subjectively or passively as applied to the material operated on and not to the method or mode of producing that operation, which is by mechanical means, or the use of a machine, as distinguished from a process.

"'In this use of the term it represents the function of a machine, or the *effect produced by it on the material subjected to the action of the machine.* But it is well settled that a man cannot have a patent for the function or abstract effect of a machine, but only for the machine which produces it.'"

In *Westinghouse* v. *Boyden Co.*, 170 U. S., 537, this Court also said:

"These cases assume, although they do not expressly decide, that a process, to be patentable, must involve a chemical or other similar elemental action, and it may be still regarded as an open question whether the patentability of processes extends beyond this class of inventions. *Where the process is simply the*

> *function or operative effect of a machine the above cases are conclusive against its patentability.*"

As pointed out in *Risdon Locomotive Works* v. *Medart*, 158 U. S., 68, 78, Mr. Justice GRIER, in *Corning* v. *Burden*, further said:

> "But where the result or effect is produced by a 'chemical action, by the operation or application of some element or power of nature, or of one substance to another,' such modes, methods or operations are called processes. *A new process is usually the result of discovery; a machine of invention.*"

In the *Telephone Cases*, 126 U. S., 1, 531, Mr. Chief Justice WAITE, in holding that "gradually changing the intensity of a continuous electric current so as to make it correspond exactly to the changes in the density of the air caused by the sound of the voice," for the purpose of transmitting vocal or other sounds, was a patentable process, also stated that a *process* was the result of *discovery*, and that a *machine* was the result of *invention*.

The elements or powers of nature, the inherent properties of substances and chemical action are things which exist independent of devices, machines and mechanisms invented by man. The cases hold that when some method is discovered for utilizing such elements or powers of nature, properties of substances or chemical action, such method is an art or process which is patentable. But methods or means which are effected by mechanism or mechanical combinations are not patentable as stated in *Corning* v. *Burden*, *supra*. *In Risdon Locomotive Works* v. *Medart*, *supra*, Mr. Justice BROWN, after reviewing the cases in which

certain processes had been held to be patentable, at page 77, said:

> "It will be observed that, in all these cases the process was either a chemical one, or consisted in the use of one of the agencies of nature for a practicable purpose.
>
> "*It is equally clear, however, that a valid patent cannot be obtained for a process which involves nothing more than the operation of a piece of mechanism or, in other words, for the function of a machine.*"

In the *Risdon* case a process consisting of several steps for the manufacture of pulleys was held to be mechanical and not patentable. In stating the reasons for the decision, Mr Justice BROWN, at page 71 (158 U. S.), said:

> "That certain processes of manufacture are patentable is as clear as that certain others are not, but nowhere is the distinction between them accurately defined. There is somewhat of the same obscurity in the line of demarcation as in that between mechanical skill and invention, or in that between a new article of manufacture, which is universally held to be patentable, and *the function of a machine which it is equally clear is not*. It may be said in general that processes of manufacture which involve chemical or other similar elemental action are patentable, though mechanism may be necessary in the application or carrying out of such process, *while those which consist solely in the operation of a machine are not*. Most processes which have been held to be patentable require the aid of mechanism in their practical application, but where such mechanism is *subsidiary* to the chemical action, the fact that the patentee may be entitled to a patent upon his mechanism does not impair his right to a patent for the process; since

> he would lose the benefit of his real discovery, which might be applied in a dozen different ways, if he were not entitled to such patent. *But, if the operation of his device be purely mechanical, no such considerations apply, since the function of the machine is entirely independent of any chemical or other similar action.*"

While it appears from the foregoing statement of this court "that processes of manufacture which involve chemical or other similar elemental action are patentable though mechanism may be necessary in the application or carrying out of such process," it also appears that it is *the process* which is patentable as a process and not the function of the mechanism which is subsidiary to the process. In other words, the operation of a piece of mechanism or the function and *result* of a machine is no part of a patentable process and is not patentable. If the process, and each step of the process, does not exist separate and apart from the function of a machine, though mechanism may be necessary to carry out the process, the process is not patentable (*Busch* v. *Jones*, 184 U. S., 598, 607; *Westinghouse* v *Boyden Co., supra; Steinmetz* v. *Allen*, 192 U. S., 543, 559, citing the *Telephone cases, supra*).

As pointed out in *Westinghouse* v. *Boyden Co., supra*, if the operation of a piece of mechanism or the function and *result* of a machine is made *one element* in a combination claim for a machine, such claim must be invalid because the operation and function or *result* of a machine or mechanism cannot be patented as part of a machine, and because a patentable process cannot be based in whole or in part upon the operation or function of a machine or mechanism. Mechanism subsidiary to the carrying out of a process may be patented as mech-

anism or as a machine, but the function or result of a machine cannot be patented as a process, or as part of a machine.

In *Hatch* v. *Moffitt*, 15 Fed., 252, the invention fell within the category of machines, and it was held, as stated in the head-note, that "a claim not only for the mechanism but also for the mode of operation generally, is void." This case was cited with approval by the Supreme Court in *Risdon Locomotive Works* v. *Medart*, *supra*. In *Stokes Co.* v. *Heller*, 96 Fed., 104, a similar claim for a process was held invalid. The court said:

> "The process is simply the mechanical operation of a combination of mechanical elements. There is no chemical or other similar elemental action involved in producing the desired result. This being true, we find that the operation as described is simply the function of the rasp-cutting machines, and as such is not the subject of a patent (*Risdon Locomotive Works* v. *Medart*, 158 U. S., 71, 84)."

In *Cleveland Co.* v. *Detroit Co.*, 131 Fed., 740, 742, the court said:

> "It has been held that there cannot be in the same patent a claim for a machine and a claim for the process of using that machine (*Gage* v. *Kellogg*, 23 Fed., 891, 894, and cases cited). This would make the fifth claim of doubtful validity. The process it describes is nothing more than a claim for the operative effect of a vapor burner. This is not patentable. (*Risdon Iron Works* vs. *Medart*, 158 U. S., 77, 79; *Westinghouse* vs. *Boyden Co.*, 170 U. S., 555, 557)."

The case of *Gage* vs. *Kellogg*, *supra*, was approved by the Supreme Court in *Risdon Locomotive Works* vs. *Medart*, 158 U. S., 68, 79.

In *Manhattan Co.* v. *Helios Co.*, 135 Fed., 785, Judge ARCHBALD held, as stated in head note 3, as follows:

> "The Baker patent, No. 684,165, for a method of regulating electric circuits, is void, as being merely for an operative theory, and one which, if sustained, would monopolize every means by which such theory may be utilized or applied."

In *Tyden* v. *Ohio Co.*, 152 Fed., 183 (C. C. A.), claim 1 of a patent for a pedestal extension table was held void because, among other elements mentioned, it claimed "means" for accomplishing a function without setting forth the means claimed. The Circuit Court of Appeals said (p. 185);—

> "It claims all means for locking and holding such pedestals, and is substantially a claim for a function. It cannot be upheld, and must be held void."

In *American Co.* v. *Steward*, 155 Fed., 731, 738, C. C. A., two process claims were held void as being claims for the function of the apparatus described. As in the patent here in suit, no means or way of practicing the process, except by the operation of the patented machine, was pointed out in the description of the patent.

In *American Co.* v. *Denning*, 160 Fed., 108, Judge REED collated some of the leading cases decided by this court upon the invalidity of patents claiming the function of a machine. At page 112 he quoted from the opinion of Mr. Justice GRIER in *Burr* v. *Duryee*, 1 Wall, 531, 570, as follows:

> "Because the law requires a patentee to explain the mode of operation of his peculiar machine, which distinguishes it from others, it does not authorize a patent for a 'mode of oper-

> ation' as exhibited in a machine. * * * The specification of this reissued patent, instead of describing, first, the machine and the several devices, which exhibit its peculiar mode of operation in order to produce the desired effect, and stating what the patentee claims as his peculiar invention, commences by describing 'a mode of operation' as the thing intended to be patented, and uses these words, 'The said mode of operation, * * * is embodied in the following description of the mode of application.' The claim is for the mode of operation, substantially as herein described. We have no leisure for a further development of this novel form of patent, or how, by the use of general and abstract terms, the specification is made so elastic that it may be construed to claim only the machine, *or so expanded as to include all previous or future inventions for the same purpose.* * * * *In this case we have an attempt to convert an improved machine into an abstraction*, a principle or mode of operation, or a still more vague and indefinite entity often resorted to in argument—*an idea.*"

Claims which describe the operation and effect of a machine have, without exception, been held invalid: *Busch* vs. *Jones*, 184 U. S., 598, 607; *Risdon Locomotive Works* vs. *Medart*, 158 U. S., 68, citing and approving *Mackay* vs. *Jackman*, 12 Fed., 615, and *Brainard* vs. *Cramme*, 12 Fed., 621, and *Gage* vs. *Kellogg*, 23 Fed., 891, and *Hatch* vs. *Moffitt*, 15 Fed., 252, and *Sickles* vs. *Falls Co.*, 4 Blatch., 508, and *Excelsior Co.* vs. *Union Co.*, 32 Fed., 221; *Coupe* vs. *Weatherhead*, 16 Fed., 673; aff'd 147 U. S., 322; *Stokes Co.* vs. *Heller*, 96 Fed., 104; *Dodge Mfg. Co.* vs. *Ohio Works*, 101 Fed., 584; *Dodge Mfg. Co.*, vs. *Collins*, 106 Fed., 935, 937; *Cleveland Co.* vs. *Detroit Co.*, 131 Fed., 740, 742; *Travers*

vs. *Hammock Co.*, 78 Fed., 638; *Wells Glass Co.* vs. *Henderson*, 67 Fed., 930, 935; *American Co.* vs. *Elkhart Co.*, 84 Fed., 960; *Ginsdorff* vs. *Deering*, 81 Fed., 952; *Dick Co.* vs. *Henry*, 160 Fed., 690, 692.

POINT TWO.

Claim 35 of the patent in suit is void because it is indefinite and meaningless and claims nothing.

(Assignment of error 32, supra, p. 12).

Claim 35 reads as follows:

> "35. *IN a sound reproducing apparatus* consisting of a travelling tablet having a sound record formed thereon and a reproducing stylus shaped for engagement with said record and free to be vibrated and propelled by the same, substantially as described."

All that claim 35 does is to describe a sound reproducing apparatus *in* which *something not stated* is to be claimed. Under the decision of this Court in *Merrill* v. *Yeomans*, 94 U. S., 568, 573:

> "The public should not be deprived of rights supposed to belong to it without being clearly told what *it is* that limits these rights."

In Merrill's case the patentee had claimed a process only, and had brought suit alleging that the sale of a product infringed the patent. The Court held that the sale of a product could not infringe a claim for a process and that the patentee's remedy was "by a surrender and re-issue. When this is done, the world will have fair notice of what he claims." Clearly claim 35 claims nothing.

In *Keystone Bridge Co.* v. *Phoenix Iron Co.*, 95 U. S., 274, 278, Mr. Justice Bradley said;—

> "If the patentees have not claimed the whole of their invention, and the omission has been the result of inadvertence, they should have sought to correct the error by a surrender of their patent and an application for a reissue. They cannot expect the courts to wade through the history of the art and spell out what they might have claimed, but have not claimed."

To the same effect is *Hardison* v. *Brinkman*, 156 Fed., 962, 967 (C. C. A.).

In *Cincinnati Co.* v. *American Co.*, 143 Fed., 322, 325, the Circuit Court of Appeals said;—

> "The law requires the patentee to define in his claim *precisely* what his invention is. This Crosby has done, and the Court has no power to disregard the plain terms of the claim and either change or enlarge it by a reference to the specification. Merrill v. Yeomans, 94 U. S., 568, 573; Keystone Bridge Co. v. Phoenix Iron Co., 95 U. S., 274, 278; White v. Dunbar, 119 U. S., 47, 51; McCarty v. Lehigh Valley R. R. Co., 160 U. S., 110, 116; Penfield v. Potts, 126 Fed., 475."

POINT THREE.

Claims 5 and 35 of the patent in suit are void because anticipated by British Patent No. 1644 of 1878 to Edison, and for lack of invention in view of the prior art.

(*Assignment of errors 10, 17, 26 and 27, supra, p. 12*).

It has been shown (*supra*, pp. 16-23), that in 1878 Edison described and patented in U. S. patent No. 200,521 of February 19, 1878 and in Brit-

ish patent No. 1644 of 1878, the following important features in the art of recording and reproducing sound;—

(*a.*) The *recording* of sound-waves upon *cylindrical* and flat or *disc* surfaces, (1) in *spiral* grooves of *lateral* undulations and uniform depth, forming the *zigzag* record, and (2) in spiral grooves of *vertical* undulations and uneven depth.

(*b.*) The *duplication* or multiplication of copies of such sound records by the stereotype and the electrotype processes.

(*c.*) *Machines* for use in *recording* such sound records and for use in *reproducing* sound therefrom.

It has also been shown (*supra*, pp. 19-20), that in and by said United States and British patents of 1878, Edison made it known that in *recording* sound records, it was necessary, in order to produce a sound record consisting of a spiral groove and not simply of a circular groove or straight line, to employ suitable feeding mechanism, operating to feed the vibrating recording stylus to the recording surface, or *vice versa;* but that in *reproducing* sound from a sound record, consisting of a spiral groove, such feed mechanism could be *dispensed* with, since the spiral groove constituting the sound record would, when caused to revolve, not only *vibrate* the reproducing stylus, but also *guide and propel* it across the face of the record, toward and from the center of the disc, as the stylus traveled in and along the revolving, spiral, record-groove.

Obviously, and as shown by Edison in said patents of 1878, a machine adapted for recording

sound in a spiral groove was also adapted for reproducing sound from such spiral groove when recorded. Such machines of the *disc* type Edison illustrated in Figs. 1-11 (T., p. 484) and of the *cylindrical* type in Figs. 12-15 (T., p. 485) of British patent No. 1644 of 1878.

As shown in Figs. 1, 2 and 11, Edison fed the vibrating, *recording* stylus to the recording surface by means of a pin connected with the recording stylus and traveling in and along a spiral guide-groove 3 located either upon the recording tablet, as shown in Fig. 2, or upon a separate disc beneath the recording tablet and revolving therewith upon the same shaft, as shown in Fig. 11. Substantially this same form of apparatus for feeding the vibrating, *recording* stylus to the recording surface was described by Edison in U. S. patent No. 200,521, of February 19, 1878 (T., p. 336) as follows;—

> "It is *obvious* that *many forms* of mechanism may be used to give motion to the material to be *indented*. For instance, *a revolving plate* may have a volute *spiral* cut both on its upper and lower surfaces, on the top of which the foil or indenting material is laid and secured in a proper manner. A two-part arm is used with this *disk*, the portion beneath the disk having *a point in the lower groove*, and the portion above the disk carrying the speaking and receiving diaphragmic devices, *which arm is caused, by the volute spiral groove upon the lower surface, to swing gradually from near the center to the outer circumference of the plate as it is revolved, or vice versa*."

Clearly the mode of operation of the Edison-Sue-s sound reproducing apparatus shown by Berliner in Fig. 3 of the patent in suit (T., p. 454) is

precisely the same as that of the guide-pin traveling in and along the spiral guide-groove 3 shown by Edison in Fig. 2 of the British patent of 1878 (T., p. 484). In each a point or stylus, carried at the free end of a pivoted arm, travels in and across a spiral groove. Whether the groove is a record-groove or a plain groove is immaterial. When the record-groove was once obtained, it took the place of the guide-groove which was necessary only in recording a spiral record-groove. No invention could be involved in first using the plain groove to guide the point traveling in it, while recording, and then, in reproducing, after the spiral groove of the record had been made, in using the spiral record-groove for the same purpose, the guiding of the stylus, for which the plain groove had been used. If there was invention in so doing, Edison and not Berliner disclosed it.

As shown in Figs. 6-10 and in Figs. 12-15 of British patent No. 1644 of 1878, a feed-screw or similar feed mechanism might also be employed for feeding the vibrating, *recording* stylus to the recording surface.

The employment of a spiral guide-groove or of a feed-screw for the purpose stated in a sound *recording* machine was a mere adoption, without invention, of the same devices previously employed for a like purpose in machines receiving and recording *telegraphic messages*, as shown in U. S. patents No. 191,464 of May 29, 1877 to Pickering (T., p. 331); No. 213,554, of March 25, 1879 to Edison (T., p. 337); No. 238,929 of March 15, 1881 to Leggo, Fig. 2 (T., p. 352); No. 277,349 of May 8, 1883 to Rogers, Fig. 1 (T., p. 357); and No. 295,219 of March 18, 1884 to Amsterdam, Fig. 2 (T., p. 378). That the mode of operation of a

sound recording machine, employing the above described guide-groove and pin traveling therein, was nothing but the mode of operation of previously existing machines adapted to receive and record telegraphic messages, appears also from Edison's reference to his said patent No. 213,554, of March 25, 1879 for automatic-telegraph, application filed March 26, 1877 (T., p. 337), made in his fundamental U. S. patent No. 200,521 of February 19, 1878, for improvement in phonograph or speaking machines, as follows (T., p. 336);—

> "An apparatus of this general character *adapted* to a magnet that indents the paper is shown in my application for a patent, No. 128, filed March 26, 1877; *hence no claim is made herein to such apparatus, and further description of the same is unnecessary.*"

Although a spiral guide-groove or feed-screw was necessary in *recording* sound waves in a *spiral* groove, nevertheless, when once the spiral groove, constituting the sound record, had been made, it was obvious that the auxiliary spiral guide-groove or feed-screw could be dispensed with in a machine employed for *reproducing* sound from a record consisting of a spiral groove, because in the reproduction of sound from such a record, the spiral groove of the record would take the place of, and perform the function performed by, the spiral guide-groove of the recording-machine, namely, the feeding of a stylus, traveling in and along it, across the face of the record and toward or from the center thereof. *Not only was this obvious, but Edison actually did it and disclosed it in Figs. 34 and 37 of British patent No. 1644 of 1878* (T., p. 486), which will presently be considered.

Clearly when a sound recording machine was employed for *reproducing* sound from a record consisting of a spiral groove, the auxiliary spiral guide-groove or feed-screw *ceased* to perform any function other than that of continually *permitting* the reproducing stylus to be in a position, relative to the record-groove, where it would be at all times "free to be vibrated and propelled" by the revolving record-groove, the undulating walls of the record groove itself causing the stylus, traveling in it, to vibrate and guiding and propelling the stylus along the groove. So far as the freedom of a reproducing stylus "to be vibrated and propelled" by the record groove was concerned, it made no difference whether that freedom was obtained by the use of a *pivoted arm* free to move laterally, or by the use of an arm similarly pivoted and connected with *a guide-groove or feed screw*. This identity of function in the pivoted arms of the machines referred to was, as stated, first described by Edison in British patent No. 1644 of 1878. *For this reason claims 5 and 35 of the patent in suit were anticipated by Figs. 1, 2 and 11, as well as by Figs. 34 and 37 of British patent to Edison No. 1644 of 1878.*

The instrument or portion of the instrument, consisting of the diaphragm and recording stylus that *records* sound, Edison termed a "*phonograph.*" The instrument or portion of the instrument, consisting of the diaphragm and reproducing stylus, that *reproduces* the sound from the record, he termed a "*phonet.*" The sound record he termed a "*phonogram*" (T., p. 475). The mounting and movement of the recording stylus and of the repro-

ducing stylus Edison stated as follows (T., p. 473, lines 7-11);—

> "the phonograph is on *an arm that swings towards and from the center of the disc*, and is guided by *grooves* or other convenient mechanism. The phonet device takes the place of the phonograph device when the sounds are to be reproduced."

The *swinging arm*, carrying the phonograph with its recording stylus or the phonet with its reproducing stylus, Edison described as follows (T., p. 475, lines 45-48);—

> "The phonograph is upon a lever arm *i* pivoted at 5 to the cylindrical stud 6, so that the phonograph may be *raised or lowered vertically*, or *moved horizontally* for a purpose hereafter stated" (see Figs. 1 and 2, T., p. 484).

The swinging lever arm, having such a universal joint permitting the vertical and horizontal movement of the stylus carried by the arm, was, therefore, clearly the invention of Edison. It was subsequently employed by Bell & Tainter and by Suess. Berliner received it from Suess, who got it from Edison.

After describing the recording of sounds by the use of the phonograph, Edison said (T., p. 478, line 1);—

> "I will now describe how the sounds are *reproduced* from the phonogram."

First he described the use of the sound *recording* apparatus for *reproduction* of sound from the record (T., p. 478, lines 1-7) as follows;—

> "If it is desired to reproduce the sounds from the phonogram *in the same instrument* in

> which the phonogram was produced it is only necesary that *the indenting point c be made to traverse the line of indentations* in the phonogram, and that a *funnel-shaped mouth-piece*, shown by dotted lines in Fig. 1, be added to the phonograph to aid in increasing the loudness and distinctness of the sound. The instrument in this form I term a 'phonet.' "

The vertical "funnel-shaped" mouth-piece is the *horn* used to-day in the Suess machine shown by Berliner in Fig. 3 of the patent in suit (T., p. 454). Suess arranged the horn horizontally instead of vertically.

Then Edison said (T., p. 478, line 36);—

> "I will now briefly describe some *modifications* in the construction and operation of the phonograph and *phonet*."

Fig. 34 he described as follows (T., p. 479, line 48);—

> "Fig. 34 is a perspective view showing a double *phonet*, there being a *spiral* line of indentations on each side of the *revolving disk d*, one phonet coming into action as the other finishes; in this case the spirals should be in opposite directions, *so that the disk continuing to revolve in the same direction moves one phonet from the center outwards*, and *then the other phonet is connected and moved back towards the center;* this may be used as a toy."

All machines, adapted for *reproducing only*, are used as toys for purposes of amusement only. Complainants' and defendant's machines are toys. They cannot be used for commercial purposes, such as dictation, since, like Fig. 34, they cannot be used for recording.

Fig. 37 Edison described as follows (T., p. 480, line 11);—

"Fig. 37 represents the phonograph or *phonet* upon a *pivoted arm, so that it may swing across* or *at right angles* to the line of movement of the intended (indented) material or phonogram. In this case the line of indentations may be lengthwise of the belt, or *across the same in the arc of a circle.*"

The sound reproducing apparatuses shown in Figs. 34 and 37 are claimed by Edison in *the first and tenth claims* of British patent No. 1644 of 1878, which claims read as follows (T., p. 482);—

"First. The combination with the *diaphragm* and *point* of a *flat* receiving surface, and means for *revolving* the receiving surface, and *causing the point to follow a volute or spiral line*, substantially as represented in Figs. 1, 2, 6, 7, 8, 9, 10, 15 and *34*.

"Tenth. The mechanism for producing a phonogram and employing the same in a *phonet*, substantially as described, and illustrated in Figs. 32, 33, 35, 36 and *37*."

The above quoted descriptions of Figs 34 and 37 and the first and tenth claims of the Edison British patent of 1878 clearly set forth the elements of claims 5 and 35 of the patent in suit. For comparison claims 5 and 35 are here set forth;—

"5. The method of reproducing sounds from a record of the same which consists in *vibrating* a stylus and *propelling* the same *along* the record by and in accordance with the said record, substantially as described.

"35. In a sound reproducing apparatus consisting of *a travelling tablet* having a sound record formed thereon and *a reproducing stylus* shaped for engagement with said record and *free to be vibrated and propelled* by the same, substantially as described."

Unquestionably the devices shown in Figs. 34 and 37 would infringe claims 5 and 35 of the patent in suit; hence they would anticipate, under the well settled rule that "*that which infringes if later, would anticipate if earlier*" (*American Co.* v. *Streat*, 83 Fed. 700, 706, citing *Heating Co.* v. *Burtis*, 121 U. S., 286,295; *Grant* v. *Walter*, 148 U. S., 547, 554; *Gordon* v. *Warder*, 150 U. S., 47).

Where a prior patent *discloses the principle and mode of operation* of the device of a later patent, the prior patent anticipates the later patent (*Van Epps. v. United Co.*, 143 Fed. 869, 874, citing *Pickering v. McCullough*, 104 U. S., 310, 319, where the prior device was not successful; *Watrous Co. v. American Co.*, 161 Fed. 362, 364; *Brunswick Co. v. Backus Co.* 153 Fed. 288).

Edison shows "*a travelling tablet having a sound record formed thereon*" in the revolving disc of Fig. 34 having a spiral line of indentations, constituting a spiral record-groove, formed on each side thereof, and in the moving belt of Fig. 37 having either a spiral groove when the indentations cross the belt in the arc of a circle, or a circular record-groove, when the indentations are lengthwise of the belt. Edison also shows "*a reproducing stylus shaped for engagement with said record*," the phonets *aa* of Fig. 34 and the phonet *a* of Fig. 37 consisting, as described in the patent, of the diaphragm and reproducing stylus, constituting the same. The stylus is, moveover, "*free to be vibrated*" by the record-groove as described throughout the patent. The stylus is, furthermore, "*free to be propelled*" along the record, *by* and in accordance with the record. With reference to Fig 34, Edison says in the above quoted description thereof, that the re-

volving disc, having a spiral record-groove formed upon each side thereof, "*moves first one phonet from the center outwards and then the other phonet is connected and moved backward towards the center.*"

The mode of operation is clearly shown in Fig. 34. The arm carrying the phonets *aa* slides upon the rod supporting it. The reproducing stylus of one phonet *a* being in engagement with the record-groove, *the revolving disc*, as stated by Edison, "moves one phonet from the center outwards and *then* the other phonet is connected and moved backward towards the center." It is the *revolving record disc* that moves the phonet toward and from the center by reason of the pressure exerted by the walls of the spiral record-groove upon the point of the reproducing stylus. The mode of operation is precisely the same as that explained by Edison in describing the action of the spiral guide-groove 3 of Figs. 1, 2 and 11, which causes the guide-pin traveling therein to be propelled along the groove and across the face of the record tablet (T., p. 476, lines 18-22). In Figs. 1, 2 and 11, the movement of the guide-pin in the guide-groove 3 is necessary, in *recording*, to enable the *recording* stylus, with which the guide-pin is connected, *to record* the sound-waves in a *spiral* record-groove; but in Fig. 34, it is the spiral groove of the *sound-record itself* which vibrates the *reproducing* stylus and *propels* it along and across the face of the record, *independently of other means.* So also, in Figs. 1, 2 and 11, when used in *reproducing*, it is the spiral groove of the *sound record itself* which *vibrates* the reproducing stylus and propels it along and across the face of the record, for in *reproducing* the movement of the reproducing stylus is

caused *solely* by the revolving spiral record-groove itself, the movement of the pin in the spiral guide-groove leaving the stylus "*free to be propelled*" by the record-groove, but not propelling it, as above explained (*supra*, pp. 69-70).

Precisely the same function is performed by the arrangement shown in Fig. 37 as by that shown in Fig. 34. The stylus is "*free to be propelled*" along the record-groove, *by* and in accordance with the record-groove. The stylus is carried at the end of a *pivoted arm* so that it may *swing across*, or at *right angles* to, the line of movement of the traveling record-groove. In case the record-groove is lengthwise of the belt, the stylus carried by the pivoted arm will simply vibrate as it travels in and along the said record-groove, but in case the record-groove is, as stated, across the traveling belt in the arc of a circle, forming a spiral record-groove, as upon a cylinder, then the stylus, being carried by a *pivoted* arm, "*swings across*" the face of the belt and record as it travels in and along the spiral record-groove, the pressure of the walls of the record-groove itself upon the point of the stylus moving the phonet in the manner stated, *independently of other means.*

Figs. 34 and 37 and Edison's description thereof are, therefore, clear anticipations of claims 5 and 35 of the patent in suit. According to complainants' expert (T., p. 58), the alleged

> "distinction of the invention of the patent in suit over the prior art is in the manner of the *propelling* of the stylus across the record, which is not accomplished by an auxiliary feed-screw, but is due to the operating engagement of the stylus point with the *record-groove itself*, independently of other means."

This defense, which was not raised in the prior suit, was not open to this petitioner in the courts below, because the Edison British patent No. 1644 of 1878 had been dead wood in the record of the prior suit. Judge Townsend said (T., p. 327);—

> "The defence founded on the prior Edison patent will not be discussed because said patent was before the court in the original suit."

The defence is good and valid and should have been considered and decided on its merits by the courts below under the rule stated by this court in *Mast, Foos & Co.* v. *Stover Mfg. Co.*, 177 U. S., 485, as follows;—

> "Comity has no application to questions *not considered* by the prior court, or, in patent cases, to alleged anticipating devices which were not laid before that court. As to such the action of the Court is purely original."

Whether the defendant, the American Graphophone Company, in the prior suit was not aware of the contents of the prior Edison British patent, or refrained from acquainting the courts therewith, in a suit where, according to the sworn statement of its counsel (*supra*, p. 5), it was to the interest of that defendant *to lose*, is immaterial. The defence was not, in fact, raised in the prior suit, and being a defence that completely overthrows claims 5 and 35 of the patent in suit, it should, when urged in this suit, have been considered and decided on its merits by the Courts below. The sole use made in the prior suit by counsel for the American Graphophone Company, of the Edison British patent was to cite Figs. 1 and 2 thereof in support of their contention, hereinafter considered under Point Four (*infra*,

p. 80), that the Bell & Tainter patent No. 341,-214 (T., p. 387) was an anticipation of claims 5 and 35 of the patent in suit.

Claims 5 and 35 of the patent in suit are void because Edison anticipated the method and apparatus thereof. Berliner did not invent the form of sound-reproducing apparatus shown as a whole in Fig. 3 of the patent in suit, for such, concededly, was the invention of Suess. Berliner made an impractical and unsuccessful sound-reproducing apparatus upon the basis of Edison's prior disclosures, and he cannot, under well settled rules of law, claim the broad invention which belonged to Edison, but must be limited (Railway Co. v. Sayles, 97 U. S., 554) to the specific form of apparatus which he disclosed in Fig. 10, of U. S. patent No. 584, 586, of July 28, 1896, applied for November 7, 1887 (T., p. 465). This matter is discussed under Point Five (*infra*, p. 96), where it is shown that Edison having made the broad invention, and Berliner and Suess having made modifications thereof, Berliner and Suess can, under the repeated decisions of this court, claim only the specific forms devised by them. *Berliner's form never went into use.* Suess' form, which did go into use, differs from Edison's in details only. Defendant employed the Suess form only.

Even if Edison had not shown, in Figs. 34 and 37, that in the reproduction of sound from a spiral record-groove the guide-pin, traveling in and along the guide-groove 3 of Fig. 2, could be dispensed with, it would still be true that claims 5 and 35 of the patent in suit are void for lack of invention in view of the prior art, since *it obviously required no invention*, when a spiral record-groove had once been obtained, *to dispense, in reproducing, with the*

guide-pin moving in the spiral guide-groove which was useless in reproducing and useful only in recording. In other words, the spiral record-groove being precisely like the spiral guide-groove, it could require no invention to use the spiral record-groove in reproducing for the same purpose that the spiral guide-groove had been used in recording, namely, to guide the reproducing stylus as it traveled in and along the record-groove. In fact, whether the guide-pin traveling in the guide-groove was retained or not retained in reproducing, it was the spiral record-groove that alone vibrated and propelled the reproducing stylus. The decision of this court in *McClain* v. *Ortmayer*, 141 U. S., 419, affirming 33 Fed. 284, is in point. There Judge Blodgett held, as stated in head note 2, as follows (33 Fed. 284);—

> "A patent obtained upon a device, upon which a patent had already been obtained, in combination with another exactly similar but *unnecessary* device, *which it required no invention to dispense with, there being no material difference in the mode of operation and result*, presents no patentable novelty, and for that reason is void."

Defendant's expert, Mr. Goss, has dealt with Fig. 34 of the Edison British patent of 1878 (T., pp. 300-303), showing, as above shown, that it is a clear anticipation of claims 5 and 35 in suit.

POINT FOUR.

Claims 5 and 35 of the patent in suit are void because anticipated by U. S. Patent No. 341,214 of May 4, 1886, to Bell & Tainter or by British Patent No. 6027 of May 4, 1886, to Johnson for the same Bell & Tainter invention and for lack of invention in view of the prior art.

(*Assignment of errors 10, 26 and 27, supra, p. 12*).

It has been shown under Point One (*supra*, p. 45) that the alleged novelty and patentability of the method and apparatus of claims 5 and 35 of the patent in suit rest *solely* upon the *functional* limitation, incorporated in the claims, that the reproducing stylus is "*free to be propelled*" along the record-groove, by and in accordance with the record-groove.

It has also been shown under Point Three (*supra*, p. 65) that claims 5 and 35 of the patent in suit were anticipated by Figs. 34 and 37, as well as by Figs. 1, 2 and 11, of British patent to Edison, No. 1644 of 1878. In that patent Edison, as shown, described and claimed a sound-reproducing apparatus consisting of a traveling tablet having a spiral record-groove formed thereon, in combination with a reproducing stylus shaped for and in engagement with the record-groove and *free to be vibrated and propelled* along the record-groove, by and in accordance with the record-groove.

This freedom of the stylus "to be propelled" along the record-groove, by and in accordance with the record, was the result of *the loose mounting of the reproducer arm* secured, as shown by Edison, either

(*a*) by permitting one end of the arm *to slide* upon its support, as shown in Fig. 34; or (*b*) by *pivoting* the arm at one end so that it was free to swing horizontally, as shown in Fig. 37; or (*c*) by the employment of a *universal joint* for connecting one end of the reproducer arm with its support so that it was free to move vertically and to swing horizontally, as shown in Figs. 1, 2 and 11, of British patent No. 1644 of 1878.

That claims 5 and 35 of the patent in suit were anticipated by Bell & Tainter also, appears from claims 19-23 of U. S. patent No. 341,214 of May 4, 1886 (T., p. 397) and from the identical claims 19-23 of the corresponding British patent No. 6027 of May 4, 1886 (T., p. 505), which claims read as follows:

> "Nineteenth. The combination with the reproducing style, of *a mounting* therefor, *which leaves said style free to move laterally*, and thereby adjust itself automatically to a sound record, substantially as described.
>
> Twentieth. The reproducer *loosely mounted* on a suitable support, *so that the reproducing style is capable of a lateral movement*, and may in consequence thereof adjust itself automatically on the record, substantially as described.
>
> Twenty-first. *The reproducer mounted on an universal joint and held against the record by yielding pressure*, substantially as described.
>
> Twenty-second. The combination, with a *grooved tablet* or other body having a sound record formed therein, of *a reproducer* having a rubbing style *loosely mounted, so that it is free to move laterally*, and thus adjust itself to the groove, substantially as described.
>
> Twenty-third. The combination, with the tablet or other body having the sound record

formed therein as an irregular groove with sloping walls, of *a reproducer* having a style for rubbing over said record and *mounted on an universal joint*, substantially as described."

In the specifications Bell & Tainter described this construction as the fourth part of their invention, saying, in U. S. patent No. 341,214 (T., p. 391, line 84);—

"The invention consists, fourthly in *loosely mounting the reproducing-style so that it can readily be guided by the record.* Preferably the reproducing-style, or rather what may be called the 'head' of the reproducing instrument is mounted on an *universal joint*, and *the style is pressed against the record by the yielding pressure of a spring or weight.* Practically in the instruments made by us the pressure is due to the weight of the instrument, modified by the elasticity of a section of *soft-rubber tube*, which supports the same and *constitutes a universal joint;* but evidently *there are many devices which can be used to mount the reproducer, so that it is free to follow the sound record or phonogram, and which, therefore, would be within the spirit of the invention.* The reproducing-style, *mounted as just explained*, is specially adapted for use in connection with a record in the form of *a groove* with sloping walls, and this combination is specially claimed; but it may also be usefully employed in connection with *other forms* of record."

The records of the patent in suit, being made by a wedge-shaped point (T., p. 455, Fig. 5; p. 462, claim 32), have sloping walls.

As stated, Bell & Tainter showed a *soft-rubber tube*, constituting the *universal joint*, permitting the reproducing stylus to be moved laterally, to be guided by the record-groove, and to follow the record-groove. Such soft-rubber tube, is shown in Fig.

8 of the United States and British patents (T., pp. 387 and 512), wherein K is the reproducer or phonet, consisting of the usual diaphragm 28 and reproducing style 27. The reproducer K is provided with tube 31. A tube 32 of soft, flexible, vulcanized rubber slips over the lower end of tube 31 and connects it with tube 33, thus forming the universal joint. When it is desired to use the apparatus shown in Figs. 1 and 2 for reproducing, instead of for recording, sound, the reproducer K, shown in Fig. 8, is substituted for the recorder H, shown in Figs. 1 and 2, by withdrawing the tube 18 of the recorder from the tube 19 in which it is held, and by inserting the tube 33 connected with the reproducer K in tube 19 (T., p. 394, lines 33-67).

In Fig. 13 (T., p. 388) is shown a modified form of the Bell & Tainter machine wherein the reproducer K and the recorder H[1] are provided with independent supports, the support of the reproducer K being free to swing horizontally, turning in rings of the bracket 72.

The court will understand from the explanation given (*supra*, pp. 19-20), that Bell & Tainter's reproducer K could not be used for recording sound-waves in a spiral record-groove, and that for this reason Bell & Tainter employed, for recording, the recorder H, which was not mounted on a universal joint. The court will also understand, from the same explanation, that in order to record sound-waves in a spiral record-groove, Bell & Tainter were obliged to feed the rotating record-tablet to the vibrating recording stylus, or *vice versa*, as by feed-screw 5 shown in Fig. 1, or by the swinging arm L shown in Figs. 12-14. In reproducing sound from a spiral record-groove, however, Bell & Tain-

ter mounted the reproducing stylus upon a *universal joint*, so that the stylus was *free to be propelled and guided* by the record-groove, was *free to follow* the record-groove, was *free to move laterally*.

In Figs. 12, 13 and 14, (T., pp. 388-389) Bell & Tainter showed a modified form of their sound-recording and sound-reproducing apparatus. The rotating record-tablet, in *recording*, was fed to the vibrating recording stylus by the swinging arm L, in such manner that the recorder engraved a spiral record-groove, the operation being described as follows (T., p. 395, lines 17-23);—

> "As the arbor D, disk E, and tablet F are rotated, the screw 56 turns the shaft 58, and consequently—the worm-wheel 53 being held stationary by the clamp M—the arm L is swung gradually to one side, so that the recorder engraves *a spiral line* on the wax face of the tablet."

The use of the *same apparatus* for *reproducing* they described in words immediately following (T., p. 395, lines 23-28;—

> "When the record has been cut, it is only necessary, in order to restore the tablet to the starting point for reproducing, to draw back the recorder and *to loosen clamp M*, when arm L can be moved at once to the proper position."

It will be noticed that in recording it was necessary that the worm-wheel 53 be held *stationary*, as stated, by the clamp M in order to swing the arm L gradually to one side and thus feed the revolving, recording surface to the vibrating, *recording* stylus. When, however, the apparatus was to be used for reproducing, *clamp M was loosened*, as stated, the sound record-tablet was moved to its proper position, and nothing is said about

tightening clamp M to feed the record-tablet during the process of *reproducing,* because in that process, reliance was had upon the loose mounting of the reproducing stylus by means of a universal joint, so that the stylus should, as they said (*supra*, pp. 81-82), be free to be guided and propelled by the record, free to move laterally, free to follow the record.

With reference to the reproducer K of this modification of their machine (see Fig. 13), Bell & Tainter said (p. 395, lines 57-65);—

> "In this machine the reproducer K, instead of being mounted on the same bracket as the recorder when the latter has been removed, is carried by a separate bracket, 72, *the tube 33 being hinged* thereto, so that the recorder and reproducer remain, or may remain, always attached to the machine, it only being necessary to turn one or the other into position, as may be required."

An inspection of Fig. 13 shows that the reproducer K, connected by the rubber tube 32 to the *hinged* tube 33, was free to move or be propelled laterally, not only because of the rubber tube 32, constituting a *universal joint*, but also because the *hinged* tube 33 *turned*, as stated in the perforated rings of the bracket 72. That Fig. 13, as well as Figs. 8 and 2, discloses a reproducing stylus free to be vibrated and propelled by the spiral-record-groove cannot be denied, and that Bell & Tainter fully and clearly described the method and apparatus of claims 5 and 35 of the patent in suit is beyond question.

The mounting of the reproducer on a laterally-movable, hinged arm, as shown in Fig 13, was claimed by Bell & Tainter as follows (T., p. 397);—

"37. *The reproducer mounted on a hinged arm*, and provided with a sound-conveyer extending lengthwise of said arm, substantially as described.

"38. *The reproducer mounted on a hinged arm*, and provided with a sound-conveyer extending lengthwise of said arm, and connected at the hinge with an exterior sound-conveyer, substantially as described."

Bell & Tainter, moreover, secured *two* lateral movements of the reproducing stylus, *one to permit the stylus to be guided and propelled by the record*, as above described, and the other to permit the stylus to "accommodate itself" to the record without movement of the diaphragm and other parts of the reproducer. This is stated in the British patent (T., p. 489, lines 23-31) as follows;—

"*The reproducing style should be mounted so that it can readily be guided by the record.* This may be accomplished in different ways as for example by *mounting* the head of the *reproducing instrument* upon a *joint* which admits of a *lateral movement*, or the *style* may be so mounted as to be capable of a lateral movement *independently* of a diaphragm and other parts of the reproducer—*By this latter arrangement* the style can *accommodate itself* to the record without having put in motion the larger mass of the head of the reproducer. It therefore responds more quickly—*Both* arrangements will be illustrated."

By the employment of the *universal joint*, the rubber tube of the first arrangement, freedom of the stylus to be guided and propelled by the spiral record-groove of the *disc* record was secured.

The mere accommodation of the stylus to the record-groove of a *cylindrical record*, without movement of the diaphragm and other parts of the re-

producer, was secured by fastening the reproducing stylus to the end of a thin, flexible, metal strip. Such mounting of the reproducing stylus is independent of the universal joint and is referred to in the description of the cylindrical record, in the British patent (T., p. 500, lines 7-11), but not in the United States patent, where only the *disc* form of record and machine is described. In the United States, Bell & Tainter obtained a separate patent, No. 341,288 (T., p. 399), covering the mere accommodation of the reproducing stylus to the record-groove of a cylindrical record (T., p. 406, lines 28-95, etc.).

This statement in the British patent, which was not in evidence in the prior suit (T., p. 78, fol. 234), of the *two* arrangements employed by Bell & Tainter for the mounting of the reproducing stylus, is a complete answer to complainants' contention that Bell & Tainter had in mind only the *second* arrangement which permits the stylus to accommodate itself to the record groove. Claims 21 and 23, above quoted, broadly cover the universal joint of Fig. 3 of the patent in suit and for the same purpose, to permit the stylus to be vibrated and propelled by the revolving spiral record-groove, or as Bell & Tainter said "*to be free to follow the sound-record*" (*supra*, p. 82).

It is important to bear in mind the distinction made between sound recording and sound reproducing machines, the distinction being (*supra*, pp. 19-20) that in a sound recording machine a feed-screw or equivalent device is necessary to enable the vibrating, recording stylus to record sound-waves in a spiral record-groove, and not necessary in a sound reproducing machine to enable the reproducing stylus to follow the record-

groove, since the reproducing stylus is vibrated, guided and propelled solely by the walls of the record-groove in and along which it travels.

If the reproducing stylus were not *propelled* solely by the record-groove, across the record-tablet, it could not be vibrated, as it is, *solely* by the record-groove. The record-groove propels the stylus at the same time that it vibrates the stylus, and this has been known in the art since Edison's British patent of 1878.

Because Judge Hazel's attention was not directed in the prior suit to this clear distinction, he fell into an error when he said that the difference between the Berliner machine and the machine of Bell & Tainter was that (T., p. 68);—

> "In the latter, an auxiliary joint or feed-screw was necessary, as already stated, to effectuate the required passage of the record over the point of the stylus, or to cause the stylus and *reproducing* diaphragm to travel across the surface of the record."

This was the distinction between sound *recording* and sound *reproducing* machines, but it was *not* the distinction between the sound reproducing machines of Berliner and Bell & Tainter. On the contrary, Bell & Tainter expressly stated that the *reproducing* stylus, not the *recording* stylus, was loosely mounted, as by the employment of a *soft rubber tube* forming a *universal joint*, so that the stylus was free to be guided by the record, to move laterally, to follow the record.

Within the meaning of claims 5 and 35 of the patent in suit Bell & Tainter disclosed a traveling tablet having a spiral record-groove formed thereon and a reproducing stylus shaped for and in engagement with the spiral record-groove, the

stylus being free to be vibrated and being mounted, by means of a universal joint, so as to be free to be propelled along the record, by and in accordance with the record.

The fact that Bell & Tainter pointed out how a reproducing stylus mounted by means of a universal joint could be adapted for use in the machine employed for recording, by substituting the reproducer so mounted for the original recorder, is utterly immaterial. When the reproducer was substituted and the machine was used for reproducing, the stylus was not only "*free to follow the sound-record*" and *free* to be vibrated and propelled "*along*" the record-groove by and in accordance with the record-groove, according to the limitations of claims 5 and 35 of the patent in suit, but it was *actually* vibrated and propelled along the record-groove by and in accordance with the record-groove. The universal joint permitted the stylus to move laterally, to follow and to be guided by the record, as Bell & Tainter expressly stated (*supra*, p. 82), and the walls of the record-groove alone vibrated and propelled the stylus so that as the stylus vibrated it followed "*along*" the spiral line of the record-groove and moved across the face of the record-tablet. In reproducing, the feed mechanism necessary in recording might be dispensed with if desired in the Bell & Tainter machine as above pointed out (pp. 84-86) in describing Figs. 13, 14 and 15 of the patent: *but whether the feed mechanism was dispensed with or retained and used during the operation of reproducing, the only effect of the feed mechanism was, so to move the revolving record-tablet or the reproducer arm, that the stylus mounted upon the universal joint was at all times free to be vibrated and propelled by the revolving, spiral, record-groove.*

In other words, the limit of the flexibility of the rubber tube, *if a short tube was used,* would not be reached as the spiral record-groove propelled the stylus across the rotating record-tablet.

Claims 5 and 35 of the patent in suit are not limited by a swinging arm capable, *without movement of its pivot,* of permitting the record-groove to move the stylus *entirely* across the face of the record. The swinging arm of Fig. 3 of the patent in suit was derived by Berliner from Suess who derived it from Edison (*infra*, p. 96). Berliner did not show a swinging arm in his device of Fig. 10 of patent No. 564,586 (T., p. 465) upon which his claim to invention solely rests.

There is no limitation in the claims that the vibrating and propelling of the stylus is to be accomplished without a feed-screw. The claims are for a stylus free to be vibrated and propelled by the record groove. *The Bell & Tainter patent is, therefore, a complete anticipation. "To imply as elements of a claim parts not named therein for the purpose of limiting its scope, so that it may be accorded novelty, is contrary to a well settled rule of patent law" (McCarty v. Railroad Co.*, 160 U. S. 110, 116 and *F. B. Stearns & Co. v. Russell*, 85 Fed. 218, 224, C. C. A.).

The claims are explicit, broadly claiming *such freedom* of the stylus, irrespective of the *means* by which it is obtained. The means *shown* in Fig. 3 (T., p. 454), were the means of Suess (*infra*, p. 96), and of Edison (*supra*, p. 65).

Where a claim is thus explicit, the courts cannot alter or change it and the claim must be held invalid if anticipated when construed according to its clear language (*Keystone Co. v. Phoenix Co.*, 95 U. S., 274, and *McClain v. Ortmayer*, 141

U. S. 419, cited and applied in 151 Fed. 23 and 161 Fed. 112 and 154 Fed. 669 and 143 Fed. 325). The court cannot rewrite the claims. As shown under Point Eight (*infra*, pp. 170-174), Berliner intended claims 5 and 35 to cover the propelling of the stylus by the record in reproducing whether the feed-screw or other like mechanism was dispensed with or not and such is the meaning of the claims. Such also is complainants' contention, though they may now deny it, as will be seen from Judge Hough's opinion in *Victor Talking Machine Co., et al. v. Hoschke*, 158 Fed. 309, where these complainants contended and Judge Hough held that, under the decisions upon claims 5 and 35 of the patent in suit, a machine employing a *spring* acting on the reproducer arm to propel it across the face of the record-tablet while the stylus was vibrated and propelled by the revolving spiral record-groove was an *infringement*. To such an extent have these functional claims been applied by the courts below to sound reproducing apparatus of the prior art.

Claims 5 and 35 of the patent in suit broadly claim the function of a stylus free to be vibrated and propelled, and in any view of the case they are anticipated, because not only was that function accomplished by the machines of the prior art, but it was accomplished in precisely the manner described in the patent in suit. A universal joint, consisting of a flexible tube of soft rubber, would permit the stylus to be guided and propelled by the record-groove *entirely* across the record-groove, as shown in Suess' reproducing apparatus of May, 1888 (T., p. 269 and p. 270, fol. 809), *but it can make no difference whether the length of the rubber tube was such as to permit the reproducing*

stylus to be guided and propelled a distance of half an inch or a distance of two inches, for in either case the terms and the substance of claims 5 and 35 are met; and *still further* can it make no difference if the reproducer arm or revolving record-tablet was fed along in order to permit the stylus mounted on such a universal joint at all times to be free to be vibrated and propelled by the record from the beginning to the end of the reproduction of sound from the record. This whole matter was thoroughly understood by Bell & Tainter, as testified to by Dr. Bell (T., p. 306, Q. 9) and by defendant's expert, Mr. Goss (T., p. 300), and as appears from the Bell & Tainter patent.

The result of connecting Bell & Tainter's flexible tube of soft rubber, constituting a universal joint, with an arm or tube that was fed, or of feeding the revolving record tablet, was to enable Bell & Tainter to employ a reproducer arm of *less length* than that of the arms shown by Edison in Figs. 1, 2, 11, 34 and 37 of British patent No. 1644 of 1878; but whether the feed took place or not, the function of the universal joint remained the same—the reproducing stylus was, by reason of the universal joint, free to be vibrated and propelled by the spiral record-groove. Since the expiration of Edison's prior British patent of 1878 and of Bell & Tainter's prior patents of 1886, such universal joint in a sound-reproducing apparatus has been *public property* and every one is at liberty to use it for every purpose for which it is adapted.

The Bell & Tainter U. S. patent No. 341,214 was a patent of great importance and was frequently considered and passed upon by the courts.

In *American Graphophone Co. v. Amet*, 74 Fed. 789, Judge Grosscup held, as stated in head note

2, that letters-patent, No. 341,214, issued to Bell & Tainter, May 4, 1886, for an improvement in recording and reproducing speech and other sounds,

> "*is infringed by a device in the essential characteristic of a loose joint, so as to enable the style to follow the groove of the record.*"

In the course of his opinion, after quoting claims 22 and 24, Judge GROSSCUP said (pp. 790-791);—

> "It will be seen that, in order to follow the groove accurately, the reproducer must be loosely mounted, and this is accomplished by the *universal joint* described in the patent. Much stress was laid by counsel for complainants upon the patentability of *the adaptation of this universal joint to the purpose of a graphophone.* If the validity of the patent depended upon this contention, I would be disposed to hold against it, *for I can see nothing novel about the joint, except its new use;* and such adaptation to new use is not, in my judgment, patentable invention. But while this element, separately considered, is not invention, the *combination* which embraces it, in my judgment, is."

Such *combination* having been patented first by Edison and then by Bell & Tainter, how can the later claims 5 and 35 of the patent in suit be valid?

Although Judge GROSSCUP considered that no invention resided in the *new use* of the universal joint, he held the combination of a reproducing stylus, mounted by means of a universal joint, and a grooved sound-record tablet of wax-like material patentable, *only because the record-tablet was composed of Bell & Tainter's new patentable, wax-like, recording material* (p. 790). The machine which Judge GROSSCUP held to be an infringement of the Bell & Tainter patent employed a reproducing stylus mounted upon a swinging arm connected by a

universal joint with its support and *permitting the stylus to be vibrated and propelled by the rotating record-groove in the manner of the patent in suit.*

In *American Graphophone Co.* v. *National Gramophone Co.*, 90 Fed., 824, Judge LACOMBE held that claim 21 of the Bell & Tainter patent for

> "(21) The reproducer, *mounted on a universal joint and held against the record by yielding pressure*, substantially as described",

was infringed by the apparatus of claims 5 and 35 of the patent in suit. Judge LACOMBE pointed out that the Bell & Tainter patent covered, in the combination of claim 21, sound records of *lateral*, as well as of vertical, undulations. The Circuit Court of Appeals in the same case, however, taking, apparently, Judge GROSSCUP'S view of the scope of the Bell & Tainter patent, held (92 Fed., 364) that inasmuch as Berliner's record consisted of *hard rubber*, and since Bell & Tainter's record consisted of a new *wax-like material*, a preliminary injunction should not have been granted by Judge LACOMBE until the status of a hard rubber record in the combination of claim 21 had been determined at final hearing. The Circuit Court of Appeals did not dissent, however, from Judge LACOMBE'S holding, that the mounting of the reproducing stylus of the Berliner machine, so that it should be free to be guided or propelled by the record-groove of a lateral or zigzag record was the same as that specified in the Bell & Tainter patent.

In *American Graphophone Co.* v. *Leeds*, 87 Fed., 873, Judge SHIPMAN held that a machine similar to the machine in the *Amet* case, *supra*, infringed claims 19-24 of the Bell & Tainter patent. Judge SHIPMAN said (p. 878) that the stylus was carried

by a reproducer arm swinging laterally by reason of a universal joint, being guided solely by the record-groove.

It should be remarked that in the cases above cited, stress was laid upon the feature disclosed in the Bell & Tainter patent, that the stylus pressed against the record by reason of the weight of the reproducer. Although this element is shown in the Suess machine illustrated in Fig. 3 of the patent in suit (T., p. 454), it is not shown in Fig. 10 of Berliner's patent No. 564,586, of July 28, 1896, applied for Nov. 7, 1887 (T., p. 465), upon which Berliner's claim to invention *solely* rests. In this we have an additional reason why Berliner, being one of several subsequent workers along the line of Edison's broad invention of 1878, must be limited to the specific device invented by him, namely, the impractical and discarded apparatus of Fig. 10 of patent No. 564,586. As hereinafter explained (*infra*, pp. 101-102), Berliner's reproducer of said Fig. 10, being suspended by means of wheels, resting on a horizontal rod, is *incapable of vertical adjustment* and cannot rest or press by gravity upon the record-groove, so that Berliner's stylus of Fig. 10 will leave the record-groove or the wheels will be thrown from the horizontal rod in case the revolving record-tablet warps or rises and falls in its revolution, as it always does (*infra*, p. 112).

The *disc* record and the *disc* machine were described by Bell & Tainter as the preferred form of record and machine in both the United States (T., p. 393, line 27) and British patents; but in the British patent the cylindrical record and the cylindrical machine were also described and shown in Figs. 22-38 (T., pp. 513-515). In the United States patent (T., p. 392, line 1) and in the British patent (T., p. 489, line 50) Bell & Tainter stated that

the reproducing stylus, mounted by means of a universal joint, may be usefully employed in connection with the various forms of records, including, as Judge LACOMBE held, the well known records of lateral undulations and uniform depth, disclosed by Edison in 1878 (*supra*, pp. 17-19).

POINT FIVE.

Claims 5 and 35 of the patent in suit are void because anticipated by Werner Suess, and for lack of invention in view of the prior art.

(Assignment of Errors 10, 11, 26 and 27, supra, p. 12).

This defence rests upon the three following documents;—

1. U. S. patent No. 427,279, of May 6, 1890 to Suess, assignor to Berliner (T., p. 446).

2. Canadian patent No. 41,901 of February 11, 1893, applied for May 5, 1891, to Berliner, as assignee of Suess (T., p. 155 and p. 169, fol. 507).

3. Berliner's lecture before the Franklin Institute of May 16, 1888, acknowledging Suess to be the inventor (T., p. 245; p. 269, Figure of "Reproducing Apparatus, May, 1888", p. 270, fol. 809).

The drawings of said Suess-Berliner Canadian and United States patents being identical, the drawings of the United States patent (T., p. 446) are to be used in connection with the Canadian patent (stipulation, T., p. 541, fol. 1621). Judge Townsend found (T., p. 324);—

> "This (Canadian) patent discloses and *broadly claims* the invention covered by the claims here in suit."

Judge Townsend also found (T., p. 325);—

> "But the Canadian patent in terms *describes and claims the broad generic invention* of Berliner covered by the claims here in suit."

The Circuit Court of Appeals was of the same opinion, saying;—

> "Of course if the Canadian patent expired, the United States patent expired at the same time" (petition for writ of *certiorari*, p. 42).

Berliner's claim to the *alleged* "broad generic invention" covered by the claims here in suit, rests solely upon Fig. 10 and the description thereof to be found in U. S. patent No. 564,586 of July 28, 1896, issued to Berliner upon an application filed November 7, 1887 (T., p. 466).

In that patent Berliner first describes the drawings showing his *apparatus* (p. 467, line 7, to p. 468, line 54). He then describes the deposition of a suitable *layer of ink* upon the tablet and the making thereon of a phonautographic record by *recording* and the *copying* of that record by photo-engraving (p. 468, line 55, to p. 469, line 45). He then describes the *centering of the copied record* upon its support (p. 469, lines 46-80). Berliner then, referring to Fig. 1, states that

> "*the stylus is then adjusted with its point in engagement* with the outer end of the record groove and the weight 26 is allowed to descend. It will now be clear that *the stylus will be forced positively to follow the undulations* of the record and that the diaphragm vibrating under the stylus will emit the same sounds which produced the original record, which sounds can be distinctly heard at the ear-piece 34" (p. 469, lines 80-89.)

Having thus described his invention, Berliner in the next line says;—

> "Both the process and the apparatus thus far described may be *modified* in various ways *without departing from the main features of* my invention" (p. 469, lines 90-94). This he shows in Fig. 10.

From Berliner's foregoing statements, it appears that in Fig. 1, as well as in Fig. 10, the *reproducing* stylus was forced by the walls of the record-groove itself to follow the spiral record-groove. In this respect, the mode of operation was the same, whether the spiral record-groove rotated about an advancing axis, as in Fig. 1, or about a stationary axis, as in Fig. 10. The two arrangements were recognized by Berliner as known equivalents for permitting the reproducing stylus to be vibrated and propelled by the revolving spiral record-groove, since they had been *shown, described* and *claimed* by Edison in 1878 as *equivalent* arrangements for such purpose (*supra*, pp. 48-53).

With regard to Fig. 10, Berliner says (T., p. 467, line 22);—

> "Fig. 10 is a sectional elevation of a *modified form* of my reproducing apparatus."

After describing his invention consisting of his improved process of recording and reproducing sound and his improved *disc* gramophone illustrated in Fig. 1, which, as stated in the patent, he used both for recording and reproducing, Berliner described the modified form, illustrated in Fig. 10, of his improved disc gramophone, as follows (T., p. 469, lines 90-123);—

> "Both the process and the *apparatus* thus far described *may be modified in various ways without departing from the main features of*

my invention. So, for instance, I can dispense with the centering device and *can rotate the record upon a stationary axis, if the diaphragm with its attached stylus is mounted in a manner to make it follow the spiral record. An arrangement of this character* is shown in Fig. 10. The reproducing-disk 54 is *in this case* mounted as hereinbefore described, but without regard to the centering device. The support 7′ may be fixed in position so that the bevel-gear 9, mounted upon the same in the manner described with reference to Fig. 3, will turn without progressive motion. Bevel-gear 9, and with it the reproducing-disk 54, are rotated by a bevel-gear 14′ upon a shaft 6′, to which power is applied by a weight, as shown, or in any other suitable manner. *The diaphragm-casing 31 is secured to a small truck 55 upon rails 56* arranged vertically above and parallel with a diameter of the reproducing-disk, and at such height above the same that the stylus 29 will be in engagement with the undulatory grooves of even depth which represent the record of sounds.

The listener applies his ear to the ear-piece, and when the shaft 6′ is rotated the stylus and diaphragm will be forced to vibrate, as in the apparatus shown in Fig. 1, but will at the same time move with the truck 55 across the face of disk 54."

In the Electrical World for November 12, 1887 (T., p. 244, top of second column) Berliner briefly described the apparatus of Fig. 10 as

> "the plan of mounting a reproducing diaphragm and stylus on *a carriage moving on rails*, and permitting the point of the stylus not only to vibrate, but also to push the carriage across the revolving disc, and *thereby* follow the volute of the sound record."

It has been shown under Point One (*supra*, pp. 48-53), that Edison in 1878 anticipated Berliner

and disclosed the broad, generic invention of mounting a sound reproducing stylus "*in a manner to make it follow the spiral record.*" It is true that Edison did not disclose a vibrating stylus pushing, across the revolving disc, a truck or carriage suspended by wheels moving upon a horizontal rod. Such a devise is impracticable and never went into use. But Edison *did* disclose the successful sound reproducing stylus so mounted that it was free to be vibrated and propelled by the spiral record-groove alone across the revolving disc or travelling belt. For this purpose Edison employed a stylus (1) carried by the free end of *a pivoted arm* as shown in Fig. 37; or (2) carried by the free end of *a sliding arm*, as shown in Fig. 34; or (3) carried by the free end of *an arm pivoted with a universal joint*, as shown in Figs 1, 2 and 11; or (4) carried at the free end of *an arm constantly fed by a feed-screw* to permit the stylus at all times to be vibrated and propelled by the revolving, spiral, record-groove, as shown in Figs. 6-10.

After Edison's disclosure of 1878 all such devices for permitting a sound reproducing stylus to follow a revolving, spiral, record groove and to be vibrated thereby were known equivalent devices of the art. The important point here is that, beyond all question, in Figs. 34 and 37, and as heretofore shown (*supra*, pp. 75-76) in Figs. 1, 2 and 11, Edison disclosed a sound reproducing stylus vibrated by a revolving record-groove and propelled across the groove or record-tablet solely by the pressure exerted by the record-groove itself upon the point of the stylus as it travelled in and along the spiral record-groove. This mode of operation Edison secured by mounting the stylus upon an arm that was free to move laterally, because of the manner

in which the arm was connected with its support.

It is an absurd proposition that claims 5 and 35 of the patent in suit can be construed to cover the broad, generic invention disclosed by Edison in 1878, and at the same time be held valid.

It will avail complainants nothing to contend that Judge Shipman, in *American Graphophone Co.* v. *Leeds*, 87 Fed. 873,877, held that it was not clear whether or not the Edison British patent No. 1644 of 1878 disclosed in Figs. 27, 34 and 37, *the gravity reproducer*, that is to say, a diaphragm and stylus, constituting a reproducer, of which the point of the stylus rested in and pressed upon the sound record-groove by gravity or the weight of the reproducer, as shown and claimed in the Bell & Tainter U. S. patent No. 341,214. A gravity reproducer mounted upon an arm connected to its support by a universal joint, and swinging vertically and horizontally was clearly disclosed by Edison in Figs. 1, 2 and 11 of his British patent of 1878 as well as by Bell & Tainter. We are not here concerned, however, with a gravity reproducer, except to point out that whatever else Berliner may have done, or may not have done, he did not invent, disclose or describe the gravity reproducer. By means of a gravity recorder or reproducer the *vertical adjustment* of the sound recording or sound reproducing stylus was obtained, as in Figs. 1, 2 and 11 of the Edison British patent of 1878, and in Fig. 13 of the Bell & Tainter patent No. 341,214, of May 4, 1886, which in claims 21 and 23 above quoted (p. 81) claimed a gravity reproducer secured by a *universal joint*.

Fig. 10 of Berliner's patent No. 564,586 (T., p. 465) disclosed a device in which a gravity reproducer was not and could not be employed, and in

which, therefore, no vertical adjustment of the sound reproducing stylus was possible. As hereinafter explained (*infra*, pp. 111-112), for this reason Berliner's device of Fig. 10 was impractical, never went into use and was discarded by Berliner himself after making only one such device (T., p. 239, Berliner's answers to Qs. 3-5). Even this one device Berliner lost (same reference).

It is respectfully submitted that the proposition cannot be controverted that Edison invented, described and claimed in 1878 the broad, generic invention of claims 5 and 35 of the patent in suit. So did Bell & Tainter in 1886. The proposition is an important one because under the well settled rule of patent law, supported by many decisions of this court, *in the field of improvement each patentee must stand on the specific improvement made and disclosed by him (Railway Co.* v. *Sayles*, 97 U. S., 544; *Cumming* v. *Baker*, 144 Fed. 395, 398, C. C. A. and cases cited; *Kokomo Co.* v. *Kitselman*, 189 U. S., 8, 24; *Cimiotti Co.* v. *American Co.*, 198 U. S., 399, 414; *Computing Scale Co.* v. *Automatic Scale Co.*, 204 U. S., 609; *American Graphophone Co.* v. *Walcutt*, 87 Fed. 556, 558.)

The principle was well stated by Judge Wheeler, following *Railway Co.* v. *Sayles, supra*, in *American Graphophone Co. v. Walcutt, supra.* In that case defendant was charged with infringing the claims of the Bell & Tainter patents for a record-tablet consisting of wax-like material on a paper backing. Judge Wheeler held that Edison, having disclosed, in 1878, the broad invention of a sound record-tablet,

> "The inventors (Bell & Tainter) could not have a valid patent for anything but their *improvement* upon Edison's tin-foil surface on a

> paper backing, *and if the defendant's structures are different improvements, he does not thereby infringe (Railway Co. v. Sayles,* 94 U. S., 554)."

Clearly, under the well settled law, *Berliner is limited to the device shown in Fig. 10* of patent No. 564,586, consisting of "a reproducing diaphragm and stylus on a carriage moving on rails," the carriage being suspended from the rail by wheels rolling on the rail.

Defendant's sound reproducing apparatus charged with infringement is the sound reproducing machine of the Suess United States and Canadian patents, a machine which Berliner in his lecture before the Franklin Institute said was the very "*ingenious*" work of Suess. Under no principle of patent law can the successful, commercial and "ingenious" machine devised by Suess, as an improvement upon the disclosures made by Edison in 1878, be held to come within the principle of the impractical, useless and discarded machine shown by Berliner in Fig. 10 of patent No. 564,586, because Berliner, like Suess, worked upon the basis of the disclosures made by Edison in 1878. Berliner was entitled to his improvement, if it was useful and patentable; but Suess was still more entitled to his improvement because Suess' improvement was successful and commercial.

In *Railway Co.* v. *Sayles*, 97 U. S., 554, this Court, as stated in head note 1, held as follows;—

> "1. A party who invents a new machine never used before, and procures letters-patent therefore, acquires a monopoly as against all merely formal variations thereof; *but if the advance toward the thing desired is gradual, and proceeds step by step, so that no one can*

claim the complete thing, each inventor is entitled only to his own specific form of device."

In *Central Co.* v. *Coughlin*, 141 Fed., 91, 94, 95, the Circuit Court of Appeals said;—

(p. 94) "*The first inventor of improvements cannot invoke the doctrine of equivalents and suppress all other improvements.* Walker on Patents (4th Ed.) §359, and cases cited. For stronger reasons, the first inventor of an improvement in a machine cannot prevent another from using the old machine without the improvements."

(p. 95) "*To carry the doctrine of equivalents to the length contended for* would make the granting of a combination patent for a machine confer on the patentee, not only the right to enjoin others from using *his* patent, but also the right to enjoin others from using *all old and well known machines*, in use at the time the patent was granted, intended to effect the same results produced by the new invention."

Berliner being a mere improver, and an impractical one at that, cannot enjoin others from using either the machines disclosed by Edison in 1878 or the improvement made by Suess in 1888. Berliner was not the inventor of a sound reproducing machine, having as one element of the combination composing it, a stylus free to be vibrated and propelled by the record. Berliner's rights, therefore, were limited to the device disclosed by him in Fig. 10 of U. S. Patent No. 564,586.

The device of Fig. 10 is *essentially different in its construction and mode of operation* from the Suess machine shown in Fig. 3 of the patent in suit (T., p. 454).

That the sound reproducing machine shown in Fig. 3 of the patent in suit was the invention of

Suess and not of Berliner is not open to question. Berliner himself has proved the point. Berliner testified that he prepared the article entitled "Berliner's Gramophone," published in the Electrical World for November 12, 1887 (T., p. 230, Q. 3; p. 243), in which the idea of mounting the reproducer "on a carriage moving on rails" was advanced (T., p. 244, top of second column) in accordance with the illustration of such device shown in Fig. 10. In his lecture before the Franklin Institute on May 16, 1888, Berliner, referring to Suess, said (T., p. 270);—

> "*He suggested to mount the sounder on a pivot at some distance from the disc and then let the reproducing groove guide the sounder across the disc over an arc of flat amplitude.* This happy idea is embodied in the *present* apparatus, and is a very *ingenious* adaptation indeed."

Suess' apparatus was used by Berliner to illustrate his lecture of May 16, 1888, and is shown in the cut entitled "Reproducing Apparatus, May, 1888" (T., p. 269). Berliner in his testimony described the Suess apparatus of the said cut as follows (T., p. 232, Q. 14);—

> "The reproducing diaphragm sound-box was mounted at the end of a pivoted lever, to it attached was a rubber tube which led to a horn mounted on the violin music stand. The stylus of the reproducing sound-box was placed into the outer circle of the spiral of the record, and upon turning table, upon which the record was mounted, the sound-box was propelled freely across the record-disc by and along the volute of the record."

Subsequently Suess improved the details of his reproducing apparatus of May, 1888, and there-

upon Berliner, *as the assignee of Suess,* on August 6, 1889, applied for and thereafter obtained U. S. patent No. 427,279 of May 6, 1890 (T., p. 446). A comparison of Fig. 1 of the Suess patent No. 427,279 with Fig. 3 of the patent in suit will show at once that Fig. 3 of the patent in suit illustrates, not Berliner's invention shown in Fig. 10 of patent No. 564,586, but Suess' sound reproducing apparatus of May, 1888 (T., p. 269), of Fig. 1 of Suess' U. S. patent No. 427,279 (T., p. 446), and of Fig. 1 (T., p. 446) of Suess' Canadian patent No. 41,901 (T., p. 155). A closer examination of Fig. 3 of the patent in suit will show that *Berliner merely incorporated in the Suess machine his improved reproducer,* consisting of the diaphragm and stylus shown in Figs. 6 and 7 of the patent in suit. In the Suess machines of May, 1888, and of the Suess United States (No. 427,279) and Canadian (No. 41,901) patents, a different stylus or reproducer is shown, the stylus and reproducer used to-day and used in defendant's machine. Defendant's machine is the Suess machine in all material respects and in no sense is defendant's machine the Berliner device of Fig. 10 of patent No. 564,586.

Subsequently, on May 5, 1891 (T., p. 169, fol. 507), Berliner, *as the assignee of Suess,* filed an application in Canada for a patent *broadly* covering the features of the Suess machine and thereafter, upon such application, obtained Canadian patent No. 41,901 of February 11, 1893 (T., p. 155). In his petition accompanying the application, *Berliner stated that Suess was the inventor and that he acquired the right to obtain the patent by assignment from Suess* (T., p. 170). As stated in the assignment, Berliner paid Suess $100 as the consideration thereof (T., p. 169). The descrip-

tion and drawings of the Suess Canadian patent are identical with the description and the drawings of the Suess U. S. patent, but although the Canadian patent contains each of the five claims of the United States patent, *the Canadian patent contains eight additional claims broadly covering the generic invention.* Claims 6, 8, 9, 4 and 10 of the Canadian patent correspond respectively to claims 1, 2, 3, 4 and 5 of the U. S. patent. In addition the Canadian patent contains the following eight *broad* claims (T., p. 165);—

> "1. In an apparatus for reproducing sounds from a rotating record tablet, *a reproducing stylus mounted on a swinging lever system* and having a *rectilinear* path over the record tablet, substantially as described." (See Fig. 3).
>
> "2. In an apparatus for reproducing sounds from a rotating record tablet having a record in the shape of a spiral groove, *a reproducing stylus and diaphragm mounted on a swinging lever system* and having a *radial* path over the record tablet, substantially as described." (See Fig. 1).
>
> "3. In an apparatus for reproducing sounds the combination of a disc having a record of sounds in the shape of an undulatory, spiral groove upon its surface and rotating about its center, with *a reproducing stylus guided by the record groove and mounted on a swinging lever system*, so as to have a *radial* path over the record tablet, substantially as described." (See Fig. 1).
>
> "7. In an apparatus for reproducing sounds from a record tablet, the combination with a reproducer mechanism consisting of a *sound conveyer*, and a diaphragm and stylus *mounted at one end thereof*, of a supporting frame for

the said reproducer, *loosely pivoted to swing freely both laterally and vertically*, substantially as described."

(NOTE: Claim 7 describes the specific form of the Suess machine which went into commercial use The "sound conveyer" is the horn and the advantageous feature of the combination was the mounting of the reproducer at the small end of the horn and also at the free end of the pivoted supporting arm or frame, as shown in Fig. 1, p. 446 and described at p. 158, fol. 472. Defendant's machine, described at p. 61, fol. 181, is this Suess machine).

"11. *In an apparatus for reproducing sounds from a rotating record-tablet, a reproducing stylus mounted to have a free movement over the surface of the record tablet*, substantially as described." (See Fig. 1).

"12. In an apparatus for reproducing sounds from a rotating record tablet, a reproducing stylus mounted on *a swinging lever system for carrying the stylus freely over the surface of the record tablet*, substantially as described." (See Fig. 1).

"13. In an apparatus for reproducing sounds from a rotating record tablet, a reproducing stylus mounted on *a lever system permitting universal movement of the stylus*, substantially as described." (See Fig. 1).

Clearly the apparatus of Fig. 3 of the patent in suit and defendant's machine are *not* the invention of Berliner. It is apparent, moreover, that Suess was a mere improver upon Edison. Referring to claim 1 of the Canadian patent Suess caused the reproducing stylus to travel in a *rectilinear* path instead of in the *radial* path mentioned in claim 2, by a system of links illustrated in Fig. 3 (T., p. 447). Edison had secured the

rectilinear path in 1878, as shown in Fig. 34 of his British patent (T., p. 486) by employing, for the mounting of the stylus, *an arm sliding on a rod* as the revolving, spiral, record-groove vibrated and propelled the stylus across the face of the record. Suess' system of links may, perhaps, have been new, but *the rectilinear path was old.* In Fig. 37, as well as in Figs. 1, 2 and 11, Edison showed the *radial* path. So it is with the various other features of the Suess machine. They all embodied the broader inventions of Edison, and of Bell & Tainter. Suess was an improver like Berliner, but his improvements have nothing in common with Berliner's device of Fig. 10 of patent No. 564,586, except those features of the prior art which were public property and which neither he nor Berliner could appropriate.

Berliner and Suess both attempted to improve upon Edison's broad invention, upon which Bell & Tainter had already made important improvements, but *the devices made by Berliner and by Suess were radically different.* Berliner cannot, therefore, claim that the Suess device comes within the scope of the principle of his device shown in Fig. 10 of patent No. 564,586. Moreover, Berliner's device of Fig. 10 was impractical, never went into use and was discarded. No such device was ever sold and Berliner himself made only one, which he lost (T., p. 239, Q. 5). The Suess machine went into immediate use for Berliner used it to illustrate his lecture of May 16, 1888. It is the Suess machine which complainants use to-day. It is the Suess machine which the defendant bought and sold and which complainants charge as an infringement (T., p. 60, fols. 180-182). The Suess machine, moreover, is the Edison machine of 1878 and the

Bell & Tainter machine of 1885, the only material difference and advantage of the Suess machine being the manner in which Suess combined the large horn or sound conveyer with the reproducer. As stated in the above quoted seventh claim of the Canadian patent, Suess mounted the diaphragm and stylus, constituting the reproducer, at the free or swinging end of the horn and of the supporting arm. This was copied by Berliner, with the other features of the Suess machine, in Fig. 3 of the patent in suit (T., p. 454), and is the construction employed in defendant's machine (T., p. 61, fol. 181).

Suess described the mode of operation of his apparatus in the Canadian, as well as in the United States, patent as follows (T., p. 158, fol. 474);—

> "The stylus engaging with its point the record groove, is controlled by the walls of the latter, and as will be hereinafter more fully shown, *I rely upon this control of the stylus by the walls of the record groove for the movement of the stylus across the face of the disc*, there being no positive feeding mechanism for thus moving the stylus."

This mode of operation Berliner claimed broadly as the invention of Suess. For example, claim 11 of the Canadian patent (T., p. 167) reads as follows;—

> "11. In an apparatus for reproducing sounds from *a rotating record tablet, a reproducing stylus mounted to have a free movement over the surface of the record tablet*, substantially as described."

In view of the foregoing statements and claims of the Canadian patent, it can avail complainants nothing to argue, as they did without success in the Courts below, that Suess in U. S. patent No. 427,-

279 (T., p. 448, lines 8-14) and in the Canadian patent (T., p. 157, fol. 471) stated that his sound-reproducing apparatus was an improvement upon the gramophone of the expired Berliner patents No. 372,786 of Nov. 8, 1887 (T., p. 416) and No. 382,790 of May 15, 1888 (T., p. 436), since those expired patents contain no suggestion of the subject matter here in controversy. The statement made by Suess (T. p. 449, line 32) that

> "The construction of the *stylus* and the mounting therefor form no part of the present invention, *and are therefore not specifically described*."

refers, obviously, to the stylus and the manner of attaching the stylus to the diaphragm, which had been described in the prior art, as for instance in Fig. 2 of Berliner's expired U. S. patent No. 372,786 of Nov. 8, 1887 (T., p. 416) or Fig. 2 of the expired British patent No. 15,232 of Nov. 8, 1887 (T., p. 526). The subject matter here in controversy was fully and specifically described by Suess in both the United States and Canadian patents and was broadly claimed by him as his invention in the Canadian patent. In such claims Berliner acquiesced, for he secured the Canadian patent as the assignee of Suess.

An inspection of Fig. 10 of patent No. 564,586 shows at once that Berliner's apparatus of Fig. 10 is impractical. It was because it was impractical that Berliner abandoned it. Defendant's experts have conclusively shown that the apparatus of Fig. 10 is impractical (T., Ensign, pp. 106-111, fols. 318-332; Leeds, pp. 119-121, fols. 357-362; Moeller, p. 122, fols. 365-367; Irish, p. 288, fol. 862).

Among the many reasons given by defendants' experts showing that the apparatus of Fig. 10 of

patent No. 564,586 is impractical, the following may be mentioned; *the lack of vertical adjustment* would either prevent the stylus from reaching down into the record-groove or the bottom of the record-groove on rising would force the stylus up and the truck, 55, would be lifted from the rail, 56, and fall; the revolving disc always rises and falls, the rise or fall increasing toward the circumference, and, because of the lack of vertical adjustment, the stylus would leave the record groove when the disc falls and would be struck by the bottom of the record-groove when the disc rises, throwing the truck off the rail; record-grooves are of different depths and record tablets are of different thicknesses and often warp and buckle, by reason of which, and because of the lack of vertical adjustment, either the stylus would not reach into the record-groove or would be pushed up by the bottom of the record groove; the weight of a tube, 33, or of a horn would throw the stylus, 29, out of the record groove; the lateral movements of the stylus would cause the truck, 55, to move laterally and the diaphragm would not vibrate and the sound would not be reproduced; the revolving disc would cause a swaying of the truck and suspended sound-box and the stylus would be forced out of adjustment with the record-groove; for these and other reasons enumerated by defendants' experts, the arrangement shown in Fig. 10 is a mere laboratory experiment and not a practical or operative device. It never went into use. Berliner made only one; which he lost.

In *Westinghouse* v. *Boyden Co.*, 177 U. S., 534, 572, this court held that the *successful* Boyden device should not be construed to be an infringement of the *unsuccessful* Westinghouse patent, saying;—

"We are induced to look with more favor

> upon this (Boyden) device, not only because it is a novel one and a manifest departure from the principle of the Westinghouse patent, but because it solved at once in the simplest manner the problem of quick action, whereas the Westinghouse patent did not prove to be a success until certain additional members had been incorporated into it."

Berliner's device of Fig. 10 *never* proved to be a success. Berliner clearly did not take "the last successful step" (*Cimiotti Co. v. Fur Co.*, 198 U. S., 399; *Kokomo Co. v. Kitselman*, 189 U. S., 8; *Dey Co. v. Syracuse Co.*, 161 Fed., 111).

In *Killeen* v. *Buffalo Furnace Co.*, 140 Fed. 33, 36, Judge Hazel said;—

> "The Killeen patent was not anticipated. The patent to Hartman, dated June 27, 1893, No. 500,386, upon which reliance is placed by defendant *has never been put into practical use*. According to the expert witness for complainant, *the Hartman apparatus is wholly impracticable*."

POINT SIX.

Berliner patent in suit No. 534,543, of February 19, 1895, was granted for an invention previously patented by Berliner in Germany, by Berliner German patent No. 53,622, of November 20, 1889. The term of the patent in suit, therefore, expired with the expiration of the term of the prior German patent on Nov. 7, 1902, before this suit was begun. Section 4887 of the Revised Statutes considered and the authorities collated.

(Assignment of errors, 1, 2 and 3, supra, p. 12).

In the consideration of this important point we have to do not with "minor details," as stated by the courts below, but with an INVENTION covering one of the *most important* parts of the *gramophone*, namely, the REPRODUCER, for which Berliner secured this prior German patent. The error of the courts below, with reference to the relative importance of the different features of improvement of the patent in suit, has been pointed out in the Statement of this brief, where it was shown that, in his lecture before the Franklin Institute, Berliner stated that the *reproducer* and the *recorder*, which he said were constructed on precisely the same principles, constituted the *two most important features of the gramophone* (*supra*, pp. 35-36); and that, in pointing out the principal features of improvement of the patent in suit, Berliner specifically stated that of the *three* principal features of his invention, the *reproducer* formed *one*, and that the second and third consisted of the *recorder* and the *improvement in recording* wherein alcohol was

continuously applied to the recordng medium (*supra*, pp. 31-33).

The German Patent Office, notwithstanding its well-known stringent requirements upon the question of invention, granted this prior German patent to Berliner for the *invention* embodied in the *reproducer*. Letters-patent of Germany are, according to the German patent law (T., p. 179, fol. 536), granted for *inventions only*, and not for insignificant or minor details. Having obtained this prior German *patent* for the important invention embodied in that most important part of the gramophone, namely, the reproducer, Berliner thereafter applied for and obtained the patent in suit, claiming and patenting therein the *invention*, embodied in the reproducer, which he had previously patented in Germany. Under the well settled law, the patent in suit, therefore, expired with the expiration of the prior German patent.

(a) German patent No. 53,622.

A certified copy of the patent forms one of defendant's exhibits (stipulation, T., p. 542). A copy of the drawings and a translation of the specification of the patent are to be found in the record (T., pp. 150-154).

That the *invention* described and covered by the German patent is an *invention* described and covered by the patent in suit and for which the patent in suit was granted, appears upon the face of the patent and is shown by defendant's witnesses (Hicks, T., pp. 82-86, fols. 245-256; Ensign, T., pp. 99-101, fols. 297-303; Leeds, T., pp. 116-118, fols. 348-352).

(b). German patent No. 53,622, being a patent for an "invention" constituting an im-

provement, expired on Nov. 7, 1902, according to the German law, with the patent for the invention upon which the improvement was made.

A copy of the material parts of the German Patent Law is included in defendant's exhibits (T., p. 179).

According to the German law, the duration of a patent is fifteen years, but "if an invention is an improvement upon another invention patented in favor of the applicant," a patent of addition only can be obtained, which terminates with the patent for the original invention (T., p. 179, fols. 537-538). It appears upon the face of German patent No. 53622, that it is a second patent of addition to patent No. 45,048, of November 8, 1887, which also forms one of defendants' exhibits together with a translation thereof (T., p. 132). Patent No. 53,-622, therefore, expired November 7, 1902 with patent No. 45,048. That the term of patent No. 53622 was limited to expire on November 7, 1902, is stated on the face of the patent. The certificate of the German Patent Office also states that patent No. 53622 had been cancelled in the rolls (T., p. 151, fol. 451).

(c). The description and claims of the patent in suit for the "'invention" previously patented by the German patent.

What then is the *invention* described and claimed in German patent No. 53,622 and also in the patent in suit No. 534,543? It is that *important* part of the gramophone, known as the *reproducer*. A comparison of figures 6 and 7 of the patent in suit (T., p. 455) with figures 1 and 2 of the German patent

(T., p. 154) shows that the reproducer patented in the patent in suit is identical with the reproducer patented in the German patent.

As shown in the opening statement of this brief (*supra*, pp. 31-36), *Berliner specifically stated that the recorder*, illustrated in Figs. 4 and 5 (T., p. 455), *and the reproducer*, illustrated in Figs. 6 and 7 (T., p. 455), *constituted most important features of the invention forming the improvement described and claimed in the patent in suit.*

The reproducer of the patent in suit, illustrated in figures 6 and 7 thereof, is described at page 460, lines 34-102. The reproducer consists of the diaphragm, lever and *reproducing* stylus carried by the free end of the lever. The diaphragm 92 is mounted in a casing 91. A leaf spring 101 forms the lever and carries the stylus 112. The leaf spring is bent or twisted at right angles at 102, *so that the face of one part of the leaf spring is perpendicular to the face of the other part of the leaf spring.* The leaf spring faces with its flat side the face of the diaphragm up to a point beyond the center of the diaphragm, and is secured at one end to the diaphragm casing. The other end of the leaf spring crosses the diaphragm casing at a point opposite to the point at which the flat end is fixed, and is, as above stated, perpendicular to the face of its flat part which is fixed to the diaphragm casing. As stated in the patent in suit (p. 460, lines 53-54), "*the spring is therefore elastic in two directions at right angles to each other.*" At the point where the leaf spring passes over the center of the diaphragm, it is, by means of a screw pin 106, connected with the center of the diaphragm, and nuts are provided whereby the *tension* between the diaphragm and the leaf

spring can be regulated (p. 460, lines 61-71). The end of the leaf spring which crosses the diaphragm casing is not secured thereto, but is *free to vibrate* and it is called the free end, 103, of the spring. To the free end of the spring a binding post 111 is secured in which the reproducing stylus 112 having a *wedge-shaped point* is held by a set screw 113 (p. 460, lines 72-76). In order to reduce the volume of the emitted sound or to render it more clear, one or more perforated diaphragms 114, may be placed in the neck 90 leading from the the diaphragm casing (p. 460, lines 90-102). In order to dampen the individual vibrations of the leaf spring, soft rubber cushions, 104, may be placed upon the leaf spring (p. 460, lines 60-61). *The tendency of the leaf spring 101 is to press toward the diaphragm* and the edge of the part 103 which crosses the diaphragm casing bears against the diaphragm casing 99 and also against the block 100 (p. 460, lines 47-54.)

Such are the features of the reproducer of the patent in suit and these features are covered in claims 24-34. The features of the reproducer, consisting of the diaphragm and *laterally* vibrating stylus, are also covered by claims 5 and 35 which are limited by, and depend for their *novelty* upon, a stylus "vibrating" and "free to be vibrated," *substantially as described*, and having a "*wedge-shaped point*," that is a point so "*shaped for engagement with said record.*"

Claims 24-34 summarize the important features of the reproducer and are as follows:

> "24. In a gramophone a sound reproducing diaphragm in combination with *a stylus lever extending diametrically across the same, and*

elastic in two directions at right angles to each other, substantially as described.

25. In a gramophone, the combination of a diaphragm and a stylus carrier composed of *a leaf spring twisted at one point so as to bring the edge of the one portion at right angles to the face of the other portion, whereby it is elastic in two directions*, substantially as described.

26. In a gramophone the combination of a reproducing diaphragm and stylus; with a stylus carrier composed of a leaf spring *extending flatwise over the face of the diaphragm and edgewise over the edge of the diaphragm*, substantially as described.

27. In a gramophone the combination of a reproducing diaphragm mounted in a suitable frame the latter being provided at one point with a boss or stop; with a double elastic stylus carrier composed of *a twisted leaf spring tending toward the diaphragm* and against the boss or stop, substantially as described.

28. In a gramophone, a reproducing diaphragm and stylus in combination with an elastic stylus carrier extending over the face of the diaphragm and tending toward the same, of an adjustable connection between the diaphragm and stylus carrier and *adjustable for varying the pressure between diaphragm and style carrier*, substantially as described.

29. In a gramophone the combination of a reproducing diaphragm mounted in a suitable frame provided with a boss or stop; with a double elastic stylus carrier tending toward the diaphragm and toward the stop and elastic non-resonant dampers interposed between the style carrier and the frame and stop, substantially as described.

30. In a gramophone a sound reproducing diaphragm and a sound conveying tube for the

same, with one or more non-resonant perforated diaphragms in the said tube for reducing the volume of sound conveyed to the ear, substantially as described.

31. In a gramophone a recording stylus pivoted to move in response to the vibrations of a diaphragm and *elastic in a plane at right angles to such motions*, substantially as described.

(Since a recording stylus may also be a reproducing stylus, claim 31 can be read upon the reproducer shown in Figs. 6 and 7.)

32. In a gramophone, *a reproducing stylus having a wedge-shaped point engaging the walls of the record groove*, substantially as described.

33. In a gramophone reproducer, a stylus carried or formed by a spring fixed at one end to the diaphragm holder and freely extending across and beyond the same and *operatively connected with the center of the diaphragm*, substantially as described.

34. In a gramophone reproducer, a spring constituting or carrying a stylus, fixed at one end to the diaphragm holder and extending across and beyond the periphery of the same and freely pressing against the diaphragm, substantially as described."

Claims 5 and 35 read as follows:

"5. The method of reproducing sounds from a record of the same which consists in *vibrating* a stylus and propelling the same along the record by and in accordance with the said record, *substantially as described.*

35. In a sound reproducing apparatus consisting of a traveling tablet having a sound record formed thereon and a reproducing *stylus shaped for engagement with said record*

and *free to be vibrated* and propelled by the same, *substantially as described.*"

Obviously, a reproducer consisting of a diaphragm and stylus mounted thereon in the manner described has for its object the *lateral* vibrations of the stylus carried by the free end of the leaf spring.

Judge Hazel, in the prior suit, said (T., p. 67);—

> "Complainants contend, and the proofs show, that the stylus attached to the diaphragm is arranged so as *to permit* the same *to vibrate laterally* and that owing to lateral undulations in the walls of the record groove, a desirable swaying motion is imparted to the reproducer diaphragm."

Mr. Middleton, complainants' expert, in describing the operation of complainants' machine, says (T., p. 51, fol. 153);—

> "The stylus of the sound-box *engages the record groove* of complainants' sound record and when the latter is rotated with the turntable, the stylus is *laterally vibrated* to set up vibrations in the sound-box diaphragm."

Mr. Kennedy, complainants' expert, in describing the invention of the patent in suit, says (T., p. 57, fol. 169);—

> "The sound-box contains a diaphragm which is set in vibration by a stylus suitably connected therewith, which stylus *enters the record* groove and is *laterally vibrated* thereby. These lateral vibrations being reproduced in the diaphragm," etc.

Indeed, a stylus carried by a leaf spring so constructed and so mounted could vibrate in no other manner than laterally, and, as the specification

states (p. 460, lines 27-29), the stylus and diaphragm vibrate "in accordance with the undulations of the record groove," which undulations are lateral and not vertical. The *"vibrating"* stylus of claim 5, and the reproducing stylus *"free to be vibrated"* of claim 35, each *"substantially as described"* is, of course, the laterally vibrating stylus of the reproducer claimed in claims 24-34, the stylus being, by means of the *bent leaf spring*, so mounted that it is *"free to be vibrated"* laterally. Furthermore, the *"stylus shaped for engagement with said record"* of claim 35, is the *"reproducing stylus having a wedge-shaped point engaging the walls of the record groove"* of claim 32.

The reproducer, shown in Figs. 6 and 7 and *patented* in claims 24-34, is the reproducer of the sound reproducing apparatus shown in Fig. 3 and *patented* in claims 5 and 35.

(d). The "invention" described and claimed in the prior German patent. Judge Townsend found that the invention described and claimed in the German patent is described and claimed in the patent in suit.

Referring now to the specification and drawings of German patent No. 53,622 (T., p. 150), there is the same diaphragm casing *cc'*, which holds between its parts the same diaphragm *b*. There is the same lever or leaf spring *aa'*, consisting of two parts, one the flat part fastened to the diaphragm casing at *g*, and the other twisted *so that its face is perpendicular to the face of the flat part and it is free to vibrate laterally*. The free end of the leaf spring carries the stylus *k*, *having a wedge-shaped point, shaped for engagement with the record*. The stylus *k* is secured to the leaf spring in the same man-

ner by means of a block *h*, made fast to the leaf spring, and a set screw *i*. Just as in the United States patent, the leaf spring is connected with the diaphragm by means of a pin *m*, and nuts and screws, *n*, *f* and *e*, serve to regulate the *tension* between the leaf spring and the diaphragm, just as the *tension* between the leaf spring and the diaphragm is regulated in the United States patent. In order to obtain a dampening of the leaf spring, the free end of the leaf spring is surrounded by a ring of rubber, *s*, just as in the United States patent. The tube *d* leads from the diaphragm casing but is cut off so that the perforated tube, shown in the corresponding French patent next to be considered and in the United States patent, does not appear. Without question, *the invention shown in the German patent is shown in the United States patent*, and *that invention is covered by both patents*. Within the language and meaning of §4887 of the Revised Statutes the United States patent *was "granted for an invention which has been previously patented"* in Germany and "shall be so limited as to expire at the same time with the foreign patent." The claim of the German patent reads as follows (T., p. 153);—

> "The replacing of the two armed lever (*s*) protected by claim 2b of the chief patent No. 45048, and of the recording stylus (29) protected by claim 4b of the same, by a spring (*aa'*) carrying the stylus for the reproduction of the sound, which with the one end is made fast to the casing (*cc'*) enclosing the diaphragm, *while the other end of the same can vibrate freely*, so that the vibrations communicated to the latter are carried over by means of the pin (*m*) connecting the spring and the diaphragm at right angles to the surface of the diaphragm."

The two-armed lever (*s*) protected by claim 2b of the chief patent No. 45048 (T., p. 143), and the recording stylus 29 protected by claim 4b of the same (T., p. 144), are shown in figures 2 and 9 of German patent No. 45048 (T., pp. 526,527). The drawings of German patent No. 45048 are identical with the drawings of English patent 15,232 of 1887 (T., pp. 526-527), and by stipulation (T., p. 540) have not been reproduced.

Judge Townsend found (T., p. 320);—

> "The drawings of the German patent are substantially identical with Figures 6 and 7 of the patent in suit *and the specifications describe and the claims cover these constructions.*"

> (*c*). *Futile effort of complainants' counsel to find some slight difference between the description and drawings of German patent No. 53,622 and of French patent No. 207,090 and the description and drawings of the patent in suit.*

Complainants' counsel in the Courts below, realizing the strength of the defences set forth under this and the following point of this brief, laboriously endeavored to find some slight distinction between the description and drawings of Berliner's third German and French patents (see Point Seven for French patent) and the description and drawings of the patent in suit. Complainants' counsel admitted that the imaginary differences in operation claimed by him are nowhere stated to exist in the patent in suit. It is unnecessary to deal with these hair-breadth distinctions which complainants' counsel endeavored to draw. *Concededly and obviously the numerous claims of the patent in suit, claims 24-34 above quoted* (*supra*, pp. 118-120),

would be infringed by the reproducers and recorder described and patented in the prior German and French patents. Hence the patent in suit was granted for an invention previously patented in the German and French patents, according to all the authorities, and whether there are differences or not is immaterial, as Judge Severens expressly stated in *Western Electric Co. v. Citizens' Tel. Co.*, 106 Fed. 215, 219, where he "conceded that there are differences in some details between the foreign and the home patents upon which independent claims might be based." But he added;—

> "If the home patent CANNOT EXPIRE IN PARCELS, and the Italian patent, for instance, covered the matter of the *first claim* of the patent in suit, it necessarily follows that the home patent expired with the Italian patent three years after the issue of the latter, and from this it necessarily results that the complainant must fail, and that the bill should be dismissed."

To the same effect is *Thomson-Houston Co. v. McLean*, 153 Fed. 883 (C. C. A.), where the *differences* existing between claim 12 of the home patent and claim 2 of the prior British patent did not constitute a *patentable* invention and where the plea of expiration was, therefore, sustained on the authority of *Siemens' Adm'r v. Sellers*, 123 U. S. 276.

In the German and French patents, as well as in the United States patent, there is a positive connection between the spring and the diaphragm. Claim 28 (*supra*, p. 119), of the patent in suit shows that "an adjustable *connection between the diaphragm and stylus carrier* and *adjustable* for varying the *pressure* between diaphragm and style

carrier" were particularly pointed out as elements of the reproducing diaphragm and stylus. Claim 33 (*supra*, p. 120), also covers the connection between spring and diaphragm. The same, of course, is true of the recorder of the patent in suit. Various parts of the specification might be referred to, but it seems unnecessary. As above shown constant *tension* exists between the spring and diaphragm in the United States and German patents, and means are shown in each patent for regulating the tension. The same is true of the French patent. Whatever vibrations the diaphragm does have, in reproducing the record, are due to the positive pressure of the stylus in one direction and the removal or reduction of the pressure of the stylus in the other direction, in which latter case the *tension* of the diaphragm comes into play to straighten the diaphragm and thus produce a vibration, as it were, toward the stylus. This clearly is the mode of operation in all the patents, notwithstanding any possible differences in the use or placing of a particular nut or screw.

Complainants' counsel did not intimate, even in the vaguest manner, and could not truthfully say that the imaginary differences, which he claimed to exist and upon which he argued, affect in the slightest degree the proposition that the numerous claims of the patent in suit, claims 24-34 above quoted (*supra*, pp. 118-120), would be infringed by the structures described and *patented* in the prior German and French patents.

Of course, the acoustic springs of the French and German patents, as well as of the patent in suit, have a tendency to press toward the diaphragm. The figures of the patents all show this. The French patent claims it (claim 7, T., p. 129). The

description of the French patent expressly states that the extremity of the acoustic spring presses against the casing of the sound-box (T., p. 127, fol. 381) and claim 34 of the patent in suit would be infringed by this. The perforated diaphragm 114 in the tube 90 of the patent in suit (Fig. 7, T., p. 455) is the perforated diaphragm D of Fig. 3 of the French patent (T., p. 131). Hence claim 30 (*supra*, p. 119) of the patent in suit would be infringed by the reproducer of the French patent; but it is useless to pursue this question further. That numerous other claims of the patent in suit would be infringed by the reproducers and recorder of the German and French patents is clear.

> *(f). The provision of § 4887 of the Revised Statutes, fixing the single term of a home "patent granted for an invention" previously patented in a foreign country, is clear and unambiguous and must control the decision in this suit without change by judicial action "based upon some supposed policy of Congress." The Courts below erred in refusing to follow the unambiguous provision of the Statute, and in holding, contrary to the Statute and the decision of this Court, that a patent can have a plurality of terms and can expire in parcels.*

The point under consideration is that the "*invention*" described and covered by prior German patent No. 53,622 is an invention covered by the patent in suit No. 534,543 and for which the patent in suit was granted. What then is the law applicable to this state of facts?

At the time the patent in suit was issued, February 19, 1895, section 4887 of the Revised Statutes

was in force, governs the patent (155 Fed. 842, 849), and read as follows:

> "Sec. 4887. No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country, unless the same has been introduced into public use in the United States for more than two years prior to the application. But *every patent* granted for *an invention which has been previously patented in a foreign country shall be so limited* as to expire at the same time with the foreign patent, or, if there be *more than one*, at the same time with *the one having the shortest term*, and in no case shall it be in force more than seventeen years."

The German patent was previously patented (*Bate Refrig. Co.* v. *Sulzburger*, 157 U. S., 1).

The following provision of the Statute fixes the *term* of the United States *patent;*

> "But *every patent* granted for an invention which has been previously patented in a foreign country *shall be so limited* as to expire at the same time with the foreign patent."

It is the *patent*, and not the separate *claims* thereof, which shall be so limited to expire. If there is *an invention* patented in a foreign country, and if that invention is described and claimed in a subsequent United States patent to the same inventor, the *term* of the United States *patent*

> "shall be so limited as to expire at the same time with the foreign patent, or, if there be *more than one*, at the same time with the one having the *shortest term*."

As stated by Judge Coxe in *Société v. Electric Co.* (97 Fed. 604, 605);—

> "Section 4887, Rev. St. U. S., has reference only to *inventions previously patented in a foreign country.*"

The *definition* and *designation*, contained in the statute, of the *invention* which must appear in the United States patent and in the prior foreign patent, in order that the former shall be limited to expire with the latter, is an invention, "*which has been previously patented in a foreign country.*" This is the sole and exclusive definition and designation. The court cannot change the definition and designation. The test, therefore, is solely, whether the United States patent claims the "invention which has been previously patented in a foreign country." If so, the statute *applies* and the United States *patent* expires with the foreign patent.

This provision of the Statute fixes the *term* of the United States *patent* as a whole. To fix the *term* of the *patent* is the sole purpose of the provision (*Sawyer Spindle Co. v. Carpenter*, 143 Fed. 976, 979). It does not assign to the several *claims* of the patent *different* terms. It assigns to the patent as a whole a *single term* and the *patent* or *the term* of the patent must be so limited as to expire at the same time with the foreign patent. The Statute applies *whenever* a United States patent claims the invention which has been previously patented in a foreign country. When the Statute once applies, the *term* of the United States patent is limited by the *term* of the prior foreign patent and must expire therewith. No *exception* is made in favor of a United States patent which may contain *additional* claims which would not

be supported by the specification of the foreign patent. No matter what else the United States patent may contain, if it *does* contain, and if it *is* granted for, *an invention previously patented in a foreign country*, the *term* of the United States patent *as a whole* must expire with the *term*, and the *shortest term*, of the prior foreign patents. The *single term* of the prior foreign patent measures the *single term* of the home patent. This clearly is what the Supreme Court held in *Siemens' Adm'r. v. Selers*, 123 U. S. 276, when it said that a patent "*cannot be construed as running partly from one date and partly from another. This would be productive of endless confusion*"; and this clearly is the plain provision of the Statute. Under such circumstances, the question whether one claim of a patent embodies a basic invention or is more important than another claim of the same patent need not be determined since the answer to such a question, if, *indeed, it can be answered*, is *not the test prescribed by the Statute*. Such a test would involve the greatest doubt, *confusion* and uncertainty. There is no provision in the statute limiting the *extent* of the expiration of a patent granted for an invention previously patented in a foreign country. There is no provision in the Statute giving to a patent "*granted for an invention which has been previously patented in a foreign country*" one term for claims covering *that* invention and *another term* for other claims which may be contained in the patent. *According to the Statute*, the United States *patent* is to have a *single* term if it is granted for *an* invention previously patented in a foreign country, *no matter what else the United States patent may be granted for*. The

rule of the Statute is clear and positive. No exception is stated. The rule applies to "*every* patent." When, therefore, the Courts below in the suit at bar held that the patent in suit could have *a plurality of terms*, and that claims 5 and 35 of the patent in suit could survive the expiration of prior foreign patents granted, concededly, for *an invention* claimed by the United States patent in suit, the Courts below clearly erred on the question of law.

Suppose several prior foreign patents granted in the *same* country for *different features* of the invention covered by the home patent. In such case, the home patent must expire "*with the one having the shortest term.*" The Patent Office so held even before the decision by this Court in *Siemens' Adm'r v. Sellers*, saying (*ex parte Unsworth*, 15 O. G. 882);—

> "Where the entire matter" (of the home patent) "is the subject of more than one foreign patent" (in the same country) "the restriction should be made in view of the one having the shortest term."

Concededly in the suit at bar, the matter of the patent in suit was the subject of *more than one* prior foreign patent. As shown in this and the following point, the reproducer and the recorder of the patent in suit were previously patented in Germany and France. As shown under Point Nine (*infra*, p. 188), both the Circuit Court and the Circuit Court of Appeals held that the alleged invention of claims 5 and 35 in suit was previously patented in Canada. Hence, under the statute, as applied by the Patent Office in *ex parte Unsworth*, *supra*, the patent in suit was limited to expire with the prior foreign patent having *the shortest term.*

If the German patent had the shortest term, then the home *patent* expired therewith. It cannot be held, under the statute and the decision in the *Siemens'* case, that *some* claims expired with the German patent, *some* with the French patent, and *some* with the Canadian patent.

In *Bate Refrig. Co.* v. *Sulzberger*, 157 U. S., 1, 36, the Supreme Court, referring to the language of §4887 of the Revised Statutes, said, as summarized in 4 Fed. Rep. Digest 9048;—

> "Where the language of a statute is *plain* and *unambiguous*, it is the *duty* of the court to enforce it according to the *obvious meaning* of the words, *without attempting to change it* by adopting a different construction, based upon some *supposed policy* of congress in regard to the subject of legislation, or upon considerations of *injustice* or *inconvenience* arising from the enforcement of the statute according to its terms."

Hard cases make bad law and are the quicksands of the law (*Doepfner v. Bowers*, 55 Misc., 562 (N. Y.).

There can, however, be no injustice in enforcing the Statute in cases such as the suit at bar. Berliner *voluntarily* included claims 5 and 35 of the patent with other claims for *inventions which to his knowledge he had previously patented in foreign countries*. He, therefore, *voluntarily* subjected the claims in suit to the operation of the Statute and no strained or forced interpretation or construction of the Statute or of claims 5 and 35 should be resorted to in order to protect him against his voluntary act.

In support of its holding that where the language of a statute is plain and unambiguous, "a

refusal to recognize its natural, obvious meaning would be justly regarded as indicating a purpose to change the law by judicial action based upon some supposed policy of Congress," this Court in *Bate Refrig. Co.* v. *Sulzberger*, cited and quoted at p. 37 (157 U. S.), its prior decisions in the two following cases;—

Hadden v. *Collector*, 5 Wall, 107, 111, where this Court said;—

> "What is termed the policy of the government with reference to any particular legislation is generally *a very uncertain thing*, upon which *all sorts of opinions*, each variant from the other, may be formed by different persons. It is a ground much too unstable upon which to rest the judgment of the court in the interpretation of statutes."

Scott v. *Reid*, 10 Pet., 524, 527, where this Court said;—

> "Where the language of the act is explicit, there is great danger in *departing from the words used*, to give an effect to the law which may be *supposed* to have been designed by the legislature. *It is not for the court* to say where the language of the statute is clear, that it shall be so construed as to embrace cases because no good reason can be assigned why they were excluded from its provisions."

As stated by the New York Court of Appeals (*Tompkins* v. *Hunter*, 149 N. Y., 117, 123), if the words of a statute have a definite meaning,

> "there is no room for construction and *courts have no right to add to or take away from that meaning.*"

In *Karst* v. *Gane*, 136 N. Y., 316, 321, the same court said;—

> "in recent times courts are less disposed than

> formerly to depart from or qualify the plain words of a statute in favor of what is termed *an equitable construction*, in order to take *particular cases* out of its operation *upon some supposed view of policy not indicated in the act itself.*"

To the same effect is *People* v. *Woodruff*, 132 N. Y., 355, 364.

In *South Bay Co.* v. *Howey*, 190 N. Y., 240, 247, the same court said;—

> "It is not an answer to the position of the defendant to say that his defense is technical because if the plaintiff comes within the provisions of the statutes quoted the defense is interposed in accordance with *the express policy of this state.*"

By what authority, then, did Judge Townsend read into the statute the *exception* that it "does not apply to cases where the foreign patents which have expired do not cover the *broad* claims for the *basic* invention?" There is contained in the statute no such exception. The clear and imperative rule is that the United States patent shall expire with a prior foreign patent if the "*invention*" protected by the prior *foreign* patent is "*an invention*" for which the United States patent was granted.

The proper rule for the interpretation of a statute, such as the Canadian Patent Act, hereinafter referred to under Point Nine, was stated, in perfect agreement with the rule stated by this Court in *Bate Refrig. Co.* v. *Sulzberger*, *supra*, by the House of Lords in England in *Dominion Cotton Mills Co.* v. *General Engineering Co.*, L. R. App. Cas. (1902), p. 570. In that case it was said (p. 573);—

> "The whole question, therefore, turns on the meaning and legal effect of the words 'under

any circumstances, *if a foreign patent exists*, the Canadian patent shall expire at the earliest date on which any foreign patent for the same invention expires.' "

The Canadian Exchequer Court held, in the first instance, that the words "if a foreign patent exists" referred to the date of the *grant* of the Canadian patent. The Canadian Supreme Court reversed the Exchequer Court and held that the words referred to the date of the *application* for the patent. Thus both Courts attempted, by judicial legislation, to read into the statute something which was not there. The House of Lords held that the words meant *just what they said* and that according to the statute a Canadian patent must expire with a foreign patent existing *at any time* during the continuance of the Canadian patent. The House of Lords said (p. 573);—

"The language is *clear* and *imperative*. Their Lordships can only understand it as declaring that under all circumstances as soon as any foreign patent for the same invention expires the Canadian patent, if then existing, shall expire also; they can *find* no limit as to time except that the foreign patent must both exist and expire after the Canadian patent has been granted and before it has ceased from any other cause."

(*g*). *The principle of the decisions of the Supreme Court in Siemens' Adm'r. v. Sellers, 123 U. S. 276, and of the lower Courts following that decision, is that "a patent cannot expire in parcels," "cannot be construed as running partly from one date and partly from another. This would be productive of endless confusion." Such principle is derived from,*

and is the only principle which can be derived from, the provision of §4887 of the Revised Statutes fixing the term of the patent.

In the leading case of *Siemens' Adm'r* v. *Sellers*, 123 U. S. 276, the question was whether a United States patent which had *four* claims had expired with a prior English patent which had only *one* claim. It was argued on behalf of the appellants as follows (123 U. S. 280);—

> "II. But if it be admitted that this claim is anticipated by the English patent of 1861, this would not invalidate the first three claims of the patent."

In answer to this argument the Supreme Court said;—

> "It is contended by the counsel of the complainants, that the American patent contains improvements *which are not exhibited in the English patent.* But if this were so, it would not help the complainants. The principal invention is in both; and if the American patent contains improvements, this fact cannot save the patent from the operation of the law which is invoked, *if it is subject to that law at all.* A patent cannot be exempted from the operation of the law by adding some new improvements to the invention; *and cannot be construed as running partly from one date and partly from another. This would be productive of endless confusion.*"

The Supreme Court held that the United States *patent* was limited by the prior English patent. The *principle* of the decision in *Siemens' Adm'r.* v. *Sellers, set forth in the words above italicized,* has been followed without exception in all reported cases, except the suit at bar. The decision was made in 1887. As the claims of the home patent,

for patentable inventions, not contained in the foreign patent, were held to have expired with the foreign patent, the law became settled, that *the home patent could not be kept alive as to such features by disclaiming the features of the expired foreign patent.* (*Thomson-Houston Co. v. McLean*, 153 Fed. 883, 886).

The decision in *Siemens' Adm'r.* v. *Sellers* establishes that a patent *cannot* be construed as running partly from one date and partly from another, the *reason* being that *this is contrary to the statute and would be productive of endless confusion.* Hence, the *principle* may be stated, that where a United States patent covers an invention which has been previously patented abroad, the term of the United States patent will expire with the term of the foreign patent, although the United States patent may *claim inventions* consisting of features not described or claimed by the prior foreign patent. Clearly, therefore, the patent in suit expired on November 7, 1902, with German patent No. 53,622, before this suit was begun in July, 1904 (T., p. 76, fol. 228).

As above shown (*supra*, pp. 36-40), the expression "principal invention" was used in antithesis to an invention consisting of claimed and patentable "improvements" upon the original invention which also necessarily consisted of patentable "improvements," merely to refer to and to point out *an* invention, which was found in both the home patent and the prior foreign patent; but the relative importance of the original invention and of the invention consisting of improvements upon it was not considered or stated by the Supreme Court and *in no sense entered into the decision of the case*, which proceeded *solely* upon

the *principle* embodied in the *Statute* that the *term* of the home patent must expire with the term of the prior foreign patent, that the home patent cannot have a *plurality* of terms and "*cannot be construed as running partly from one date and partly from another.*' The decision would have been the same, under the *principle* stated as the *ground of the decision*, had the invention found in both the home and prior foreign patents been the invention consisting of improvements upon the original invention; for whether the prior foreign patent contains only the *invention* consisting of improvements or only the original invention found in the home patent the Statute must apply, since, in either case, the home patent is "granted for *an invention which has been previously patented in a foreign country*" and "*every*" such "*patent*" must expire, that is its *term* must expire, with the expiration of the term of the prior foreign patent. To hold otherwise would defeat the statute and permit an inventor to escape the statute as to inventions consisting of patentable improvements, by patenting only the improvements in a foreign country and the original invention together with the improvements in this country. This is why the lower Courts, following the *principle* of the decision of *Siemens' Adm'r.* v. *Sellers*, have without exception and repeatedly, as will hereinafter appear, directed their inquiry to ascertain whether *any one* invention claimed in the home patent is contained in the prior foreign patent, and have repeatedly stated that "*a patent cannot expire in parcels*," "*cannot expire in part and survive in part.*"

The expression "principal invention" has no application to the facts of the case at bar. Claims

5 and 35, like all other claims, of the patent in suit cover merely "improvements" upon a well developed prior art Berliner was a mere and late improver in the art, and even *his* basic invention is not set forth in those claims but in expired patent No. 372,786 (T., p. 417).

(h). Broadening or narrowing of the claims of an American patent will not prevent the operation of the Statute.

In *Federal Statutes Annotated*, Vol. 5, p. 470 (published by Edward Thompson Co., 1905), the law settled by the decision of *Siemens' Adm'r* v. *Sellers* and other cases following that decision, is stated as follows;—

"*The addition of new improvements* not contained in the foreign patent, or the *broadening or narrowing* of the claims of an American patent, will not prevent the operation of the statute, as *a patent cannot be construed as running partly from one date and partly from another. Siemens' Adm'r* v. *Sellers* (1887) 123 U. S., 276; *Clark* v. *Wilson* (1886) 28 Fed. 95; *Holmes Electric Protective Co.* v. *Metropolitan Burglar Alarm Co.* (1887) 33 Fed. Rep. 254; *Accumulator Co.* v. *Julien Electric Co.* (1893) 57 Fed. Rep. 605; *Brush Electric Co.* v. *Electrical Accumulator Co.* (1891) 47 Fed. Rep. 48."

(i). The test of the question whether an American "patent is granted for an invention" previously patented in a foreign country, is whether an article made according to the description of the invention patented by the foreign patent would infringe the American patent, that is any claim of the American patent.

Judge Townsend failed to apply this test and did

not correctly state defendant's contention in the suit at bar. The learned Judge did not consider whether the "*invention*" described and claimed in the prior foreign patents was claimed in the patent in suit, but merely weighed the relative importance of the different improvements described and claimed in the patent in suit (T., p. 323). The learned Judge, moreover, quoted (T., pp. 322-323) only detached portions of the opinions in *Siemens' Adm'r* v. *Sellers*, *supra*, and in *Western Electric Co.* v. *Citizen's Tel. Co.* (*infra*, p. 141), ignoring those clear, relevant statements upon which the defendant relies and which explained and qualified the portions quoted by the learned Judge. It is respectfully submitted that the courts below failed to apply the statute or to follow the decisions of this Court in regard thereto.

In *Commercial Manufacturing Co.* v. *Fairbank Co.*, 135 U. S., 176, this Court affirmed the decree of the court below, dismissing the bill, and upon the question of identity of invention said;—

> "In regard to the foreign patents the opinion of the Circuit Court says: * * * (p. 194) 'A fair test of the question as to whether the American patent is anticipated by the foreign patents, or is included in them, we think would be: were a person in this country, after the issue of the present American patent, to commence the manufacture of oleomargarine by the precise process *described in the Bavarian or Austrian patents*, supposing that process had not been patented abroad, would the courts refuse an injunction to restrain the use of the process on the ground that it infringed that covered by the American patent? We can hardly deem it possible that any intelligent court would deny an injunction if applied for under such circumstances, and we think this

fairly illustrates the relation of the foreign to the American patent.'

"The conclusion of the Circuit Court was that the plaintiffs' *patent expired* by the *expiration* of the Bavarian and Austrian patents.

"We have carefully considered the arguments urged in the briefs of the counsel for the plaintiffs, in connection with the testimony of their experts, and are of opinion that *the views of the Circuit Court, above quoted, are correct.*"

(*j*). *In determining whether a home patent is granted for an invention previously patented in a foreign country, the precise question is whether* ANY *of the claims of the home patent include the invention or some substantive part of the invention shown by the prior foreign patent. If so, the home patent expires as to all its claims with the foreign patent since a* "PATENT CANNOT EXPIRE IN PARCELS" (*Western Electric Co. v. Citizen's Tel. Co., 106 Fed., 215; Thomson-Houston Co. v. McLean, 153 Fed., 883*).

In *Western Electric Co.* vs. *Citizen's Tel. Co.*, 106 Fed. 215, Judge Severens applied the principles of *Siemens' Adm'r* v. *Sellers* and *Commercial Mfg. Co.* v. *Fairbanks Co., supra*, in accordance with the uniform action of the lower courts following the decisions and opinions of the Supreme Court in those two leading cases. The question before Judge Severens was, whether a United States patent had expired with the expiration of several prior foreign patents to the same inventor. A prior Italian patent had been granted to the same patentee for a term of three years and had expired at the end of the three years. Prior English and French patents had also been granted to the same patentee and

had also expired. Differences existed between the United States patent and the prior foreign patents, and the precise question was whether the United States patent was granted for an invention, *any invention*, covered by the prior foreign patents, and whether the United States patent expired with the prior foreign patents. Judge Severens in deciding that case held that the United States patent was granted for an "*invention*" covered by the prior Italian patent, and, therefore, expired with the Italian patent. As stated in the head note, the *point* of the decision was, whether *any* of the claims of the home patent included any substantive part of the "*invention*" of *the foreign patent*. Head note 1 reads as follows:

> "Where *any of the* claims of a United States patent include *any substantive part of the invention*, on which an independent claim might be founded, *shown by a prior foreign patent*, the former expires with the latter under Rev. St., §4887."

In the course of his opinion, Judge Severens said (p. 217);—

> "The question then is whether the Eldred invention covered by his home patent was patented by the one taken out in Italy, *or, putting it another way, and with rather more precision, do its claims, or any of them, include the invention, or some substantive part of the invention, on which an independent claim might be founded, shown by the Italian patent.* There being no formal claims in the latter patent, it is *prima facie* to be presumed that the law of Italy does not require it. And the further inference arises that whatever is new either in a single element, or in a combination of several elements, such as might stand for a claim under our own statute, would be cov-

ered by the patent. * * * *A careful study of the Eldred Italian patent leaves no doubt that it does embody the very matter of many of the claims of his home patent; that is to say, very many of the claims of the latter could be well founded on the specification of the former.*

* * * (p. 219) "To the British patent are appended nine claims, eight, at least, of which are founded on the *details* of the single exchange office, and are for combinations and congeries thereof. Identical claims are appended to the French patent. With respect to most of those claims, if one were allowed to substitute equivalents, they could be made upon the specifications of the home patent. But, what is more directly to the point, the essence of the patent in suit *contained in the first claim thereof*, namely, the cutting out of the annunciator from the circuit employed for conversation, is embodied in the description of *the invention in the foreign patents.* The construction given in the specification necessarily involves it. The case is, therefore, brought under the operation of the rule, laid down in *Siemens' Adm'r.* v. *Sellers*, 123 U. S. 276, even though it be conceded that there are differences in some details between the foreign and the home patents upon which independent claims might be based. *If the home patent cannot expire in parcels, and the Italian patent, for instance, covered the matter of the first claim of the patent in suit, it necessarily follows that the home patent expired with the Italian patent three years after the issue of the latter, and from this it necessarily results that the complainant must fail, and that the bill should be dismissed.*"

Upon this decision defendant relies. It correctly states the law as held by this court.

The basis of this decision, as appears from the

words in italics, is that the "*home patent cannot expire in parcels,*" following the *rule* of the Supreme Court that a patent "*cannot be construed as running partly from one date and partly from another. This would be productive of endless confusion.*" Such rule is in conformity with the clear unambiguous provision of the Statute. Judge Severens summed up the whole case, when he put the question, *with precision:* Do the claims of the home patent, *or any of them*, include *the "invention" shown by the Italian patent?* Clearly Judge Townsend did not correctly interpret Judge Severens' opinion (T., p. 323), or the opinion of this Court in *Siemens' v. Sellers.*

In *Thomson-Houston Co.* v. *McLean*, 153 Fed. 883, the Circuit Court of Appeals for the First Circuit, as stated in head note 2, held that the United States patent there in suit expired with a prior British patent to the same inventor. The defendant interposed a plea, setting up the expiration of the patent, and a decree was rendered for the defendant and the bill dismissed by the Circuit Court. The Circuit Court of Appeals affirmed the decree. It appears from the opinion of the Circuit Court of Appeals that claim 12, one of the eighteen claims of the United States patent, covered the substance of claim 2 of the prior British patent. Only four of the eighteen claims were in suit, and no patentable difference was found to exist between the four claims in suit and claim 2 of the British patent. Although the precise question before the court in the suit at bar was not raised or passed upon, still it is clear from the opinion of the Circuit Court of Appeals and from the references made by the court to the decision of this Court in *Siemens'* v. *Sellers, supra,*

that the Circuit Court of Appeals was of the opinion, and such is the clear statement in the head note, that the United States *patent* and the eighteen claims thereof did, in fact, expire with the prior British patent because claim 12 of the United States patent covered the substance of claim 2 of the prior British patent. It is also clear that that Court did not regard the reported decision in the suit at bar (146 Fed. 534 and 148 *id.* 1022) as correct or in accord with *Siemens' v. Sellers, supra, as appears from the* Court's statement (153 Fed. 886 and 889) that *Siemens' v. Sellers* was opposed to the proposition that the claims of a patent could expire in parcels.

> (*k*). *The Circuit Court and the Circuit Court of Appeals for the Second Circuit have determined the question, whether a home patent was "granted for an invention which has been previously patented in a foreign country," by ascertaining whether "*ANY ONE *of the inventions" claimed in the home patent is contained in the prior foreign patent, and whether any claim of the home patent would be infringed by the structure of the invention of the foreign patent.*

In *Electrical Accumulator Co.* v. *Brush Electric Co.*, 52 Fed., 130, the Circuit Court of Appeals for the Second Circuit, following *Siemens' Adm'r* v. *Sellers* and *Commercial Mfg. Co.* v. *Fairbank Co., supra*, held that a home patent did not expire with a prior Italian patent, giving as the reason therefor, that *no one* of the *inventions* of the home patent was covered by the prior Italian patent. The Court said (p. 139);—

> "In our opinion, the Italian patent is not the

same in *its* essential particulars with *any one* of the inventions which are claimed in 337,299, and the home 'patent would not be infringed by a structure made in accordance with the provisions of the foreign patent.'"

In the court below (47 Fed., 48, 52), in the same case, Judge Coxe was clearly of the same opinion. In the course of his opinion, he said (p. 52);—

> "Whether the expiration of a foreign patent for an improvement only will operate to overthrow a domestic patent for a broad invention, which contains also a claim covering the improvement, has not, *apparently*, been decided by the Supreme Court. *The language of the Court in Siemens' Adm'r v. Sellers, supra*, is, *perhaps, comprehensive enough to cover such a contingency, but this is a question which need not now be considered.*"

The language of this Court in the *Siemens'* case was *explicit* to the effect that a patent

> *"cannot be construed as running partly from one date and partly from another. This would be productive of endless confusion."*

> *(1) Judge Brown has held, in Sawyer Spindle Co. v. Carpenter, 133 Fed., 238; aff'd, 143 Fed., 976 (1), that a patent cannot expire in part and survive in part; and (2) that a generic claim, covering the specific form of a specie claim and other forms as well, must, under any construction of the statute, expire with the expiration of the specie claim.*

In *Sawyer, Spindle Co. v. Carpenter*, 133 Fed., 238, aff'd, 143 Red., 976, Judge Brown criticized

Judge Thomas' decision in Aquarama Co. v. Old Mill Co., 124 Fed., 229, and said (p. 240);—

> "The defendant contends also that the invention of claim 5 of the patent in suit was not patented by the British patent. It is conceded that the first four claims of the patent in suit and of the British patent are substantially identical, and that the inventions covered thereby are the same. The defendant argues that, though the patent in suit may have expired as to four of its claims, it may still exist as a valid patent for the invention of the fifth claim: citing *Aquarama Co.* v. *Old Mill Co.* (C. C.) 124 Fed., 229. I do not find, however, in the opinion in that case, any reference to *Siemens' v. Sellers*, 123 U. S., 276, where a similar contention was made (page 280, 123 U. S.). The court said (page 283, 123 U. S.):
>
> "'A patent cannot be exempted from the operation of the law by adding some new improvements to the invention, and *cannot be construed as running partly from one date and partly from another. This would be productive of endless confusion.*'
>
> "But assuming *for the sake of the argument only*, that a patent may be limited *in term* by a foreign patent as to some of its claims, and not as to others—that it may expire in part and survive in part—it would still seem impossible that a single claim should in part expire and in part survive. Where the difference between two claims is merely in breadth, the first being a specific claim for a particular embodiment of an invention, and the second being a generic claim which covers the specific form of the first claim, and other forms as well, it follows, upon the expiration of the specie claim, that the specific invention claimed therein can no longer be held to infringe the patent, and that the generic claim has expired in part at least. Two patents and two claims may be regarded as for the same invention,

> though one claims only a special machine, and the other claims broadly a genus which includes the former. *Otis Elevator Co.* v. *The Portland Co.*, 127 Fed., 557 (C. C. A.); *Miller* v. *Eagle Mfg. Co.*, 151 U. S., 186; *Robinson on Patents*, § 464, 465, vol. 2, p. 45. When this is the case, *though the American claim may be broader than that of the prior British patent, it is still true that what is claimed under the generic claim has already been patented in a foreign country.* I can see no reason why the rules which are applied to determine the question of double patenting when United States patents are involved are not also applicable when the question is whether the invention has been first patented in a foreign country."

Judge Brown was clearly of the opinion that *a patent cannot expire in parcels, cannot expire in part and survive in part;* but, under the assumption made by him *"for the sake of the argument only"*, if claims 5 and 35 are generic claims, they must be held to have expired with the specie claims 24-34, covering the construction of the stylus with a wedge-shaped point, so as to permit engagement with the record, and covering the construction and mounting of the stylus, so as to permit the lateral vibrations, substantially as described, since those elements are all embodied in, and permeate, claims 5 and 35.

Although the point may not now be properly before the Court, for the sake of illustration, it may be stated that the Courts below held that the patent in suit was limited to expire with the prior Canadian patent to Berliner, as assignee of Suess (T., p. 325; petition for writ of *certiorari*, p. 42). The question, discussed under Point Nine (*infra*, p. 188), is the *length* of the *term* of the Canadian patent. But the Canadian patent claims the *gen-*

eric as well as the *specific* form of the invention (*supra*, pp. 107-108) and the *specific* form of the invention was previously patented by Berliner, as the assignee of Suess (*supra*, pp. 106-107), by U. S. patent No. 427,279 of May 6, 1890, which expired May 6, 1907, a year after the entry of the decree herein. Since according to the Canadian law (*supra*, p. 135), of which the Court perhaps can take judicial notice, (106 Fed. 215 and 175 U. S. 187, 195-197), the relevant section 8 having inadvertently been omitted from the record, the Canadian patent was limited to expire with any foreign patent for the same invention (*supra*, p. 135), it follows under Judge Brown's decision that the Canadian patent expired May 6, 1907, with the Berliner-Suess U. S. patent and with it claims 5 and 35 of the patent in suit must also have expired under the ruling of the Courts below.

> (m). *Aquarama Co. v. Old Mill Co., 124 Fed., 229 and Westinghouse Co. v. Stanley Co., 138 Fed., 123, merely held that a home patent, granted only for an invention which is a patentable improvement upon an invention covered by a prior foreign patent, or vice versa, is not granted for the invention covered by the foreign patent and does not expire therewith.*

Judge Brown was correct in stating that in Judge Thomas' opinion in *Aquarama Co. v. Old Mill Co., supra*, there was no reference to *Siemens' Adm'r v. Sellers*, 123 U. S., 276. A careful reading of Judge Thomas' opinion discloses, however, that Judge Thomas did *not* hold that a patent can expire in parcels. Such holding would have been contrary to the decision of the Supreme Court in *Siemens' Adm'r v. Sellers*, that a patent "*cannot*

be construed as running partly from one date and partly from another. This would be productive of endless confusion."

An examination of the record and briefs submitted to Judge Thomas, shows that *the only question before Judge Thomas was whether or not the inventions of the United States and of the British patents were the same.* Judge Thomas held, that the United States patent was for an invention which was a patentable improvement upon the invention shown in the English patent. Being a patent for improvements *only*, not set forth in the English patent, it was not granted for an invention previously patented by the English patent, and did not, therefore, expire with the English patent.

In *Westinghouse Co.* v. *Stanley Co.*, 138 Fed 125 (C. C. A.), it was argued by complainants' counsel (see brief on appeal, p. 27) that:—

> "There is no case which decides that a foreign patent for an *improvement* not described or suggested in a United States patent will limit the latter's term."

The court upheld this contention which was unquestionably correct. The improvement, the court said, "was a patentable improvement" and hence the invention of the prior English patent, which was for the patentable improvement, was not the same as the invention of the United States patent which did not cover the improvement for which *alone* the English patent was granted. The United States patent, therefore, was not "granted for an invention" previously patented in the foreign country and the Statute did not reply.

In *Thomson-Houston Co.* v. *McLean*, 153 Fed. 883, 889, the court that decided *Westinghouse Co.*

v. Stanley Co., supra, stated that the foregoing statement of the decision in that case is correct.

The foregoing decisions in *Westinghouse Co.* v. *Stanley Co.* and in *Aquarama Co.* v. *Old Mill Co.* are in accord with the decision of the Supreme Court in *Miller* v. *Eagle Mfg. Co.*, 151 U. S. 186, where the Supreme Court laid down the broad rule that (p. 198):—

> "The result of the foregoing and other authorities is that no patent can issue for an invention actually covered by a former patent, especially to the same patentee, although the terms of the claims may differ; that the second patent, *although containing a broader claim*, more generical in its character than the specific claims contained in the prior patent is also void. . . .
>
> (p. 199) It is also settled that an inventor may make a new *improvement* on his own invention of a *patentable* character, for which he may obtain a separate patent, and the cases cited by the appellee come to this point and to this point only, that a later patent may be granted where the invention is clearly *distinct from*, and *independent* of, one previously patented."

151

POINT SEVEN.

Berliner Patent in suit No. 534,543 of February 19, 1895, was granted for inventions previously patented by Berliner in France, by Berliner French patent No. 207,-090, of July 19, 1890. The term of the patent in suit, therefore, expired with the expiration of the term of the prior French patent on July 19, 1905, before the decree for injunction was entered.

(*Assignment of errors 4, 5 and 6, supra, p. 12*).

In the consideration of this important point, we have to do not with "minor details," as stated by the courts below, but with an INVENTION covering *two* of the *most important parts* of the *gramophone*, namely, the REPRODUCER and the RECORDER, for which Berliner secured this prior French patent. It has been shown (*supra*, pp. 35-36), that Berliner, in his lecture before the Franklin Institute, stated that the *recorder* was the *most important apparatus of the gramophone;* and that the *reproducer* is constructed on precisely the same principles as the recorder. It has also been shown (*supra*, pp. 31-36) that, in describing the features of improvement of the patent in suit, Berliner specifically stated that of the *three* principal features of his invention, the *recorder* and *reproducer* formed *two*, the third consisting of the described improvement in recording, wherein alcohol was continuously applied to the recording medium.

Section 4887 of the Revised Statutes and the authorities thereto relating have been set forth under Point Six (*supra*, pp. 127-131). It will now be shown that by this French patent Berliner *pat-*

cuted in a foreign country the important *inventions* embodied in the *two most important parts* of the gramophone, namely, the recorder and the reproducer, and thereafter applied for and obtained the patent in suit, claiming and patenting therein the "*inventions*" previously claimed and patented in the French patent. The patent in suit, therefore, expired, under the well settled law, with the expiration of the prior French patent.

(*a*). *French patent No. 207,090.*

A certified copy of the patent forms one of defendants' exhibits (stipulation, T., p. 542). A copy of the drawings and a translation of the specification of the patent are found in the record (T., pp. 126-131).

That the inventions described and covered by the French patent are identical with inventions described and covered by the patent in suit and for which the patent in suit was granted, appears upon the face of the patents and is shown by defendant's witnesses (Hicks, T., pp. 86-88, 82-85, fols. 256-262, 245-253; Ensign, T., pp. 99-101, fols. 297-363; Leeds, T., pp. 116-119, fols. 348-355).

(*b*). *French patent No. 207,090, according to the French law expired July 19, 1905.*

According to the French Law, the longest duration of a patent is fifteen years (T., p. 176, fol. 527). It appears upon the face of the French patent No. 207,090 of July 19, 1890, that it was granted for the period of fifteen years from that date, (T., p. 126, fol. 377). It was delivered to Berliner on November 11, 1890 (T., p. 126). It is clear, therefore, that the French patent is a prior patent to Berliner for inventions, for which the

patent in suit was granted, that it expired July 19, 1905, and that, if we disregard the expiration of the patent in suit on November 7, 1902, with the prior German patent, the patent in suit expired with the French patent on July 19, 1905.

(*c*). *The description and claims of the prior French patent and of the patent in suit for inventions for which the patent in suit was granted.*

Referring to the specifications and drawings (T., p. 131) the French patent No. 207,090, to Berliner, it appears that Figures 1 and 2 illustrate Berliner's recorder or recording diaphragm and stylus, and that Figures 3 and 4 illustrate Berliner's reproducer or reproducing diaphragm and stylus. Since we have just considered the reproducer in connection with the prior German patent (*supra*, pp. 116-127), it will be more convenient to consider first the reproducer and then the recorder of the French patent, and compare them with the reproducer and recorder of the patent in suit.

The reproducer shown in Figures 3 and 4 of the French patent is identical with the reproducer shown in figures 6 and 7 (T., p. 455) of the patent in suit. There is the same diaphragm B mounted in the same casing A. There is the same leaf-spring FH *bent at right angles so that the face of one part is perpendicular to the face of the other part*. The one part of the leaf-spring faces the face of the diaphragm and is secured at the end to the casing at P, while the free end of the leaf-spring crosses the diaphragm casing edgewise and is *free to vibrate laterally*, just as in the United States patent. Where the leaf-spring crosses the diaphragm casing edgewise the leaf-spring comes

in contact with the casing and presses against the casing. The French patent says (T., p. 127, fol. 381);—

> "In the reproducing sound-box, 3, 4, the extremity of the acoustic spring H, carrying a ring of caoutchouc G, presses against the casing of the sound-box. From the point of view of reproduction this is more advantageous than if the spring were free, as in the recording sound-box, 1, 2."

The leaf spring of the French patent is provided with a ring of caoutchouc or rubber G, just as is the leaf spring of the United States patent, "so that this envelope dampens the individual vibrations of the acoustic spring" (T., p. 128, fol. 383). In the French patent there is the same block M attached to the free end of the leaf spring in which, by means of the set screw N, the stylus O, having the same *wedge-shaped point*, shaped for engagement with the record, is secured in precisely the manner described in the United States patent. Also in the French patent *the leaf-spring is connected with the center of the diaphragm* by the pin I which is secured by the casing L, and the screw Q. The pin I is fixed in the same manner for the connection of the leaf spring with the diaphragm and the same means exist for fixing or regulating the *tension* between the leaf spring and diaphragm. In the tube C, leading from the diaphragm casing, is the perforated diaphragm D to render the tone more clear, just as in the United States patent the perforated diaphragm 114 is inserted in the tube 90 for the same purpose. Thus it appears that the reproducer of the French patent is identical in every particular with the reproducer of the United States patent, and would infringe claims

24-34 of the United States patent quoted *supra* under Point Six, Subdivision (*c*), pp. 118-120.

Referring now to the recorder of the French patent illustrated in Figures 1 and 2 thereof, and comparing it with the recorder of the United States patent illustrated in Figures 4 and 5 thereof, it appears that *every feature of the recorder of the French patent is embodied in and forms part of the recorder of the United States patent.* The eccentricity of the leaf spring in the recorder of the United States patent is a mere detail which, as held in *Clark* v. *Wilson*, 28 Fed. 95, and in *Thomson-Houston Co.* v. *McLean*, 153 Fed. 883, merely narrows the United States patent and brings it within the scope of the French patent.

Moreover, the leaf-spring is so mounted upon the diaphragm and diaphragm casing that its eccentricity can be done away with and the leaf spring made to extend along the line of a diameter of the diaphragm (see Fig. 4, patent in suit; Leeds, T., p. 118, fols. 353-354; Ensign, T., p. 101, fol. 301; Hicks, T., p. 83, fols. 248-249).

What then are the features of the invention of the recorder of the French patent and of the recorder of the United States patent? Referring to figures 1 and 2 of the French patent and to the specification thereof (T., pp. 126-131), it appears that there is the diaphragm B mounted in the casing AA with a tube C leading from the diaphragm casing and having a perforated diaphragm D in the tube to render the tone more clear. Extending across the face of the diaphragm is the leaf spring or acoustic spring FH, composed of two parts F and H joined together so that *the face of the part H is at right angles to the face of the part F.* It will be noted that the leaf spring in the recorder is

formed, not by twisting a single piece of metal so that the parts shall be at right angles the one to the other, but by joining together two separate thin strips of metal so that the parts shall be at right angles the one to the other. The specification of the patent states (T., p. 126, fol. 378) that the acoustic spring FH may be "composed either of two springs placed at right angles the one to the other, as in figures 1 and 2, or of a spring bent as in figures 3 and 4." It is well to observe here that in figures 3 and 4 of the French patent the reproducer is shown having a leaf spring which is bent and in figures 6 and 7 of the United States patent the reproducer is shown having the leaf spring similarly bent; but in *the recorder shown in figures 1 and 2 of the French patent and in figures 4 and 5 of the United States patent the leaf spring or acoustic spring is composed of two parts joined together at right angles* "by soldering or otherwise," as stated in the patent in suit (T., p. 458, line 54). Continuing now with the description of the recorder in the French patent, *the leaf spring is connected with the center of the diaphragm* by the pin I and nuts KK serve to regulate the *tension* between the leaf spring and the diaphragm (T., p. 127, fol. 379). One end of the leaf spring is secured to the diaphragm casing while the other end is *free to vibrate laterally* and crosses edgewise the diaphragm casing. The leaf spring faces with its flat side the face of the diaphragm. In order to dampen the individual vibrations of the leaf spring, one or more bands of rubber G are placed upon it. *The free end of the leaf spring is bent in its normal position, but opens so as to become straight when it presses upon the tablet for the*

recording of the sound waves (T., pp. 127-128, fols. 380 and 383). Such are the features of the recorder of the French patent.

The seven claims of the French patent, broadly covering both the reproducer and the recorder of the patent in suit, are as follows (T., p. 128;—

> 1. An apapratus for *recording* and *reproducing* sound-waves, composed of a diaphragm and of a vibrating spring or leaf placed transversely over the latter and of which one end is fixed while the free end is in contact with the surface recording the sound waves.
>
> 2. An apparatus for *recording* and *reproducing* sound-waves, composed of a diaphragm, of an acoustic spring placed over the diaphragm and attached to it, a spring which is in part surrounded by gutta-percha, felt or by other like material, so that this envelope dampens the individual vibrations of the acoustic spring.
>
> 3. An apparatus for *recording* sound-waves, composed of a diaphragm and of an acoustic spring connected with it, the free end of which is bent in its normal position but opens, so as to become straight, when it presses upon the tablet for the recording of the sound-waves.
>
> 4. An apparatus for *recording* sound-waves, composed of a diaphragm, of an acoustic spring placed over it and of a pin which connects the spring to the diaphragm in such manner that the tension between it and the acoustic spring can be regulated.
>
> 5. An apparatus for *reproducing* sound-waves, composed of a diaphragm, of an acoustic spring placed over it and of a casing at the free end of the acoustic spring, into which casing one point of a needle is fixed in such man-

ner as to be able to be taken out of it and replaced without difficulty.

6. An apparatus for *reproduction* of sound-waves, composed of a diaphragm, of an acoustic spring placed over it and of a casing at the middle of the spring, which casing is traversed by a separate pin establishing the connection with the diaphragm or spring.

7. An apparatus to *reproduce* sound-waves, composed of a diaphragm, of a casing for the diaphragm and of an acoustic spring placed over the diaphragm and connected to it, while its free end presses upon or against the casing.

Referring to the patent in suit and figures 4 and 5 thereof, and the description of the recorder at p. 458, lines 3-109, it appears that the recorder of the United States patent has the same casing 40 and 57, the same diaphragm 56 mounted therein, the same acoustic spring or leaf spring composed of two parts 61 and 62 joined together so that *the parts are at right angles to each other* and one end is secured to the diaphragm casing while the other is *free to vibrate laterally*. The free end 62 is *normally curved, 62', but opens so as to become straight when the stylus impinges upon the record tablet* preparatory to the making of a record (patent in suit, p. 458, lines 93-109.) *The leaf spring is connected with the center of the diaphragm*, and by means of the screw 66, the *tension* of the diaphragm may be regulated. In the tube 39 leading from the diaphragm casing is the perforated disc 67, just as in the recorder of the French patent. While unquestionably the recorder of the United States patent shows some differences and modifications, it is also unquestionably true that *every feature of the*

recorder of the French patent is embodied in, and forms part of the recorder of the United States patent, and the main features of the recorder of the United States patent are all embodied in the recorder of the French patent. In the patent in suit the main features of the invention embodied in the recorder are set forth in claims 7, 9, 10, 25 and 31, which read as follows;—

> "7. In a gramophone, the combination of a sound receiving diaphragm and an elastic recording stylus controlled by the diaphragm and *adjustable with reference to a record tablet so as to press by its own elasticity upon the same at right angles to the plane of its vibratory movements*, substantially as described."
>
> "9. In a gramophone, a recording stylus composed of a leaf spring terminating in a tracing point in combination with one or more elastic non-sonorous dampers, substantially as described."
>
> "10. In a gramophone, a recording stylus formed of a leaf spring terminating in a tracing point in combination with one or more sleeves of soft rubber upon the leaf spring for damping the same, substantially as described."
>
> "25. In a gramophone, the combination of a diaphragm and *a stylus carrier composed of a leaf spring twisted at one point so as to bring the edge of one portion at right angles to the face of the other portion, whereby it is elastic in two directions*, substantially as described."
>
> "31. In a gramophone a recording stylus pivoted to move in response to the vibrations of a diaphragm and elastic in a plane at right angles to such motions, substantially as described."

The foregoing, like the claims of the French pat-

ent, are all broad claims in no way limited by any special details or special improvements of the recorder of the United States patent. *Unquestionably, the foregoing broad claims would be infringed by a recorder made according to the invention of the French patent.*

Claims 6, 8 and 16 of the patent in suit read as follows;—

> "6. In a gramophone, a recording stylus *pressing by its own elasticity* upon the record tablet at right angles to the plane of its vibratory movements and consisting of *a leaf spring* terminating in a point of *harder material* than that of the body of the stylus, substantially as described"
>
> "8. In a gramophone a recording stylus *pressing by its own elasticity* upon the record tablet at right angles to its plane of vibratory movements, and consisting of *a leaf spring* terminating in an *iridium* point, substantially as described."
>
> "16. In a gramophone a sound receiving diaphragm and a tube for conveying sound waves thereto in combination with a recording stylus receiving motion from the diaphragm, and a screw mounted in the sound conveying tube bearing centrally upon the diaphragm for *adjusting the tension* of the latter, substantially as described."

These claims according to the decision of Judge Wheler in *Clark* v. *Wilson*, *supra*, 28 Fed. 95, and *Thomson-Houston Co. v. McLean*, *supra*, 153 Fed., 883, are mere adaptations of the recorder of the French patent not constituting any separate, patentable invention but narrowing the United States patent and bringing it within the scope of the prior French patent.

A stylus "terminating in a point of harder material" or "in an irridium point" had been described in nearly all of Berliner's prior patents and was old. (See English patent No. 7204 of 1888, p. 530, line 20; French patent 190,602, T., p. 124, which is the same as the said English patent; German patent No. 47,099, T., p. 150, fol. 448). On May 16, 1888, in his lecture before the Franklin Institute, Berliner described "an irridium pointed stylus" (T., p. 270, fol. 808; p. 268, fol. 803). To make such a point a part of the recording stylus of the patent in suit was obviously a mere adaptation of the stylus of the French patent, not amounting to a patentable invention and narrowing the United States patent and bringing it within the scope of the French patent.

Claims 11, 12, 13, 14 and 15 of the patent in suit also cover the recorder and are also narrowed by the element of the eccentricity of the stylus carrier or leaf spring. This eccentricity may be a patentable improvement, but under the decisions of the Supreme Court in *Siemens' Adm'r* v. *Sellers*, and other cases cited *supra*, under Point Six, cannot save the patent.

Clearly the *reproducers* covered by the French and United States patents are identical, and clearly the *recorders* covered by the French and United States patents are identical as to the main features thereof. Judge Townsend so found. The French patent has seven claims above quoted, *covering broadly* the recorder and reproducer (T., pp. 128-129). It is familiar law, however, that claims form no essential part of a French patent. There is no requirement for claims in the French law (T., p. 177, fols. 529-530). A French patent should, therefore, be construed as Judge Severens construed the

Italian patent without claims in *Western Electric Co.* v. *Citizens' Tel. Co.*, 106 Fed., 215, quoted *supra* under Point Six. This question, however, is not material, since, it appearing that the *inventions* covered by the French patent are inventions for which the United States patent was granted it matters not whether the claims of the one patent be broader or narrower than the claims of the other patent. The claims of the two patents are equally broad. No case can be found where identity of claims has been made the test. (*Thomson-Houston Co.* v. *McLean*, 153 Fed. 883, 889; *Clark* v. *Wilson*, 26 Fed., 95; *Siemens' Adm'r.* v. *Sellers*, 123 U. S., 276). The test is whether the United States patent was granted for an invention previously patented in a foreign country. This question is answered by determining whether a structure made in accordance with the invention of the foreign patent will infringe the United States patent, that is any claim thereof. If so, the home patent was granted for an invention previously patented in a foreign country and expires with the foreign patent.

(d). Judge Townsend found that French patent No. 207,090 covers the inventions consisting of the improvements of the patent in suit in the recorder and reproducer.

Judge Townsend, in the suit at bar, found (T., p. 320);—

> "The drawings of the German patent are substantially identical with Figures 6 and 7 of the patent in suit and the specifications describe and the claims cover these constructions. The same is true (barring the claims which are immaterial) of said French patent.
>
> * * * * * *
>
> "The French patent and the claims of the

German patent cover improvements in details of the construction of Berliner's *recorder* and *reproducer*."

POINT EIGHT.

The patent in suit and Claims 5 and 35 thereof expired, before this suit was begun, with the expiration of the prior British, French and German patents of November 8, 1887, to Berliner for the so-called "Basic Invention" covered by said Claims 5 and 35.

(*Assignment of errors 7, 8 and 9, supra, p. 12*).

This defence rests upon three prior foreign patents to Berliner, to wit;—

(1). British patent No. 15,232 of November 8, 1887 (T., p. 516), which was granted for the term of fourteen years (T., p. 190) and expired on November 8, 1901. The British patent was published December 31, 1887 and sealed February 17, 1888 (T., p. 82, fol. 244). It was, therefore, previously patented.

(2). French patent No. 186,827 of November 8, 1887 (T., p. 123), which was granted for the term of fifteen years (T., pp. 123 and 176) and expired on November 8, 1902. The description and claims of the French patent are a literal translation of the description and claims of the British patent (T., p. 123, fol. 369). As stated on the face of the French patent (T., p. 123), it was delivered to the patentee, Berliner, on January 26, 1888 and was therefore, previously patented.

(3). German patent No. 45,048 of November 8, 1887 (T., p. 132), which was granted for the term of fifteen years (T., pp. 179 and 145) and ex-

pired on November 7, 1902 (T., pp. 145 and 151). As stated on the face of the German patent (T., p. 132), it was published November 2, 1888 and was, therefore, previously patented.

The drawings of the French and German patents are identical with the drawings of the British patent (T., p. 526); therefore, by stipulation (T., p. 540, fol. 1620), only the drawings of the British patent have been reproduced, and by the same stipulation (T., p. 542, fol. 1624), only the translations of the French and German patents have been reproduced in the transcript of the record on appeal.

Since the British, French and German patents cover one and the same invention, we need consider only the British patent under this point.

Referring to U. S. patent No. 564,586, granted July 28, 1896, to Berliner, on an application filed November 7, 1887 (T., p. 466), it will be seen that Berliner there states (T., p. 466, lines 8-17) that *the invention of that patent, which includes Fig. 10 thereof upon which claims 5 and 35 of the patent in suit are alleged to rest, was previously patented by British patent* No. 15,232 of November 8, 1887, and was an improvement upon the invention described in his first U. S. patent No. 372,786 of November 8, 1887 (T., p. 416).

If the Circuit Court of Appeals was right in holding, in the prior suit, that the application for the patent in suit was a *continuation* of the application for No. 564,586, and that, therefore, Berliner's application for the patent in suit antedated the public use urged as a defence (T., p. 74), then the patent in suit and No. 564,586 must be treated as *one patent* (*Benjamin Co. v. Dale Co.*, 158 Fed. 617; *Barb Wire Patent Case*, 143 U. S. 281; *West-*

inghouse Co. v. Dayton Co., 106 Fed. 726) covering the invention described in the application for No. 564,586, and, since that invention was previously patented by the three foreign patents, the patent in suit expired therewith. Under the reasoning of the Circuit Court of Appeals, either the defence of prior public use (*infra*, p. 215) is good or the patent in suit expired with the three prior foreign patents. It is, however, submitted that both defences are good.

It has been shown (*supra*, pp. 21, 24) that Berliner's British patent described and claimed Berliner's original invention and a second or improved form of the original invention and that in the United States Berliner obtained patent No. 372,786 for the original invention and patent No. 564,586 for the second and improved form thereof. Referring to Judge Hazel's opinion in the prior suit, it will be seen that the defendant in that suit "freely admitted" that the invention covered by claims 5 and 35 of the patent in suit was disclosed in Fig. 10 (T., p. 465) of patent No. 564,586. Judge Hazel said (T., p. 71);—

> "As already appears, the patent in suit was issued upon a later application than patent No. 564,586. *Why the broad claims of the former were not made a part of the earlier application and specification* does not appear."

Upon the same point the Circuit Court of Appeals, in the prior suit, said (T., p. 74;—

> "The specifications in that application (for 564,586) were full enough to warrant the making of the claims here in controversy (5 and 35); at any time the application might have been amended by adding such claims, and in our opinion it is immaterial that instead of

> thus amending it, he took the *broader* claims on another application filed while the first was pending. The second may fairly be considered a *continuation* of the first, and thus Berliner's application antedates the public use."

It will be seen that both Judge Hazel and the Circuit Court of Appeals regarded claims 5 and 35 of the patent in suit as *broad claims* for the invention of patent No. 564,586 and that the Circuit Court of Appeals held said claims to be "*broader*" than any claim contained in patent No. 564,586.

It has already been shown that the alleged *broad* invention of claims 5 and 35 was anticipated by Edison (*supra*, p. 65) and by Bell & Tainter (*supra*, p. 80); that the sound reproducing machine described in the patent in suit and illustrated in Fig. 3 thereof was the invention of Suess and not of Berliner (*supra*, p. 96), except in so far as Berliner incorporated in the Suess machine of Fig. 3 the reproducer of Figs. 6 and 7 previously patented in the German and French patents considered under Points Six and Seven (*supra*, pp. 114, 152); and that complainant's contention in support of the alleged novelty of claims 5 and 35 rests *solely* upon the disclosures made by Berliner in the specification of patent No. 564,586, for which he made application on November 7, 1887 (*supra*, p. 97).

Complainant's contention is that claims 5 and 35 of the patent in suit can be read upon the specification of patent No. 564,586, and Judge Hazel and the Circuit Court of Appeals so held. Claims 5 and 35, moreover, are, according to complainant's contention, and the rulings of Judge Hazel and the Circuit Court of Appeals, "*broader claims*" for the invention of patent No. 564,586, than any claim contained in No. 564,586.

Conceding the correctness of such contention and rulings, it follows that claims 5 and 35 *broadly* claim the *invention* claimed in No. 564,586. Since that invention was previously patented by the British, French and German patents of November 8, 1887, the legal conclusion is that the patent in suit and claims 5 and 35 thereof expired with the expiration of each of the said three prior foreign patents.

It has been shown under Points One and Three (*supra*, pp. 45, 65) that in British patent No. 1644 of 1878 Edison described and *claimed* the sound reproducing apparatus of claims 5 and 35 of the patent in suit and showed that such a sound reproducing apparatus was *equivalent*, in its construction and mode of operation, to a sound reproducing apparatus wherein the pivoted arm carrying the reproducing stylus was connected either with a pin travelling in a spiral guide-groove or with a feed-screw. In Figs. 34 and 37 (T., p. 486) Edison showed a reproducing stylus "free to be vibrated and propelled" by the spiral disc record-groove in the *reproduction* of sound. The devices of Figs. 34 and 37 could not be used for the *recording* of sound in a spiral record-groove, since they were not provided with means to enable a recording stylus to *record* in a spiral line. In Figs. 1, 2 and 11 (pp. 484-485) Edison showed a stylus "free to be vibrated and propelled" by the spiral disc record-groove in the *reproduction* of sound, but the freely-swinging pivoted arm carrying the stylus was connected with a pin travelling in a guide-groove so that the *same instrument* could also be used for the recording of sound. In Figs. 6-10 (T., p. 484) Edison showed a stylus "free to be vibrated and propelled" by the spiral disc record-groove in the

reproduction of sound, but the pivoted arm carrying the stylus was connected with a feed-screw in order that the *same instrument* might also be used for the recording of sound.

As shown under Point Three (*supra*, p. 65), Edison in the first claim of his said British patent of 1878 *claimed all such constructions as equivalents*. The said first claim reads as follows (T., p. 482);—

> "First. The combination with the diaphragm and *point* of a *flat* receiving surface and means for *revolving* the receiving surface, and *causing the point to follow a volute or spiral line*, substantially as represented in Figs. 1, 2, 6, 7, 8, 9, 10 and 34."

The equivalency of the figures referred to in Edison's said claim 1 may be expressed as follows;—

Figs. 1 and 2 equal Figs. 6, 7, 8, 9 and 10, which in turn equal Fig. 34.

From this it appears that the means shown, in the several figures referred to, for *causing the point or stylus to follow the volute or spiral line* of the revolving, flat or disc record were equivalent means. When the instruments were used for *reproduction*, and that of Fig. 34 could be used for *reproduction only*, it was the volute or spiral line of the *record-groove itself* that caused the point or stylus to vibrate and to be propelled along and across the record-groove as the stylus followed the spiral disc record-groove. As explained under Points One and Three (*supra*, pp. 45, 65), the pin moving in the spiral guide-groove of Figs. 1 and 2 and the feed-mechanism of Figs. 6-10, performed no function in the *reproduction* of sound other than that of *permitting* or making the stylus free to follow the spiral, disc record-groove and to be

vibrated and propelled by the revolving *record-groove itself* in precisely the manner of Fig. 34, where no spiral guide-groove or feed-screw was employed. In these *three* different ways Edison *mounted* the reproducing stylus so that it was "free to be vibrated and propelled" by the revolving, spiral, disc record-groove and he described and *claimed* them as *equivalents* in sound reproducing apparatus. So did Bell & Tainter (*supra*, Point Four, p. 80); and *so did Berliner*, as will now be shown.

With this knowledge of the prior art, we are in a position to understand Berliner's description of the second or improved form of his gramophone, set forth in U. S. patent No. 564,586 (T., p. 463) and in the prior British patent No. 15,232 of 1887 (T., p. 516). It is conceded and asserted by complainants that the alleged invention of claims 5 and 35 of the patent in suit was set forth in No. 564,586.

Referring to No. 564,586, it will be seen that the original form af the gramophone shown in No. 372,786 was cylindrical, but that the second or improved form was a *disc* machine (T., p. 466, lines 40-52). The disc machine is shown in Figs. 1 and 10 (T., pp. 463, 465). The machine of Fig. 1 is adapted both for recording and for reproducing. It is, therefore, provided with feed-mechanism to enable the *recording* stylus to record in a spiral record-groove, but the feed-mechanism leaves the reproducing stylus "free to be vibrated and propelled" by, that is to follow, the spiral record-groove when the *same instrument* is used for the reproduction of sound. In Fig. 1, the feed mechanism moves the *recording-tablet* with reference to the point of the recording stylus, while in Fig. 1 of the patent in

suit (T., p. 452) the feed-mechanism moves the *recording stylus* with reference to the recording-tablet, but this variation is immaterial, since the two forms were equivalents, having been described as equivalents for the purpose of recording in a spiral groove, by Edison in 1878 (compare Figs. 2 and 15, for example, with Figs. 12 and 14, T., pp. 484-485), and, as stated by Judge Hazel in the prior suit (T., p. 68, fol. 202), by Bell & Tainter in 1885 (compare, for example, Figs. 1 and 13 of U. S. patent No. 341,-214, T., pp. 387-388). Obviously, whether the recording medium moved under the recording point or the recording point moved over the recording medium, as the tablet revolved in order that a spiral line might be recorded, was immaterial.

In describing the drawings of patent No. 564,-586, Berliner said;—

> "Fig. 1 is a perspective view of my improved gramophone" (T., p. 467, line 7).
>
> "Fig. 10 is a sectional elevation of a *modified form* of my reproducing apparatus" (T., p. 467, line 22).

In other words, *Fig. 10 is described as a modified form of Fig. 1.*

After describing, as he does in the patent in suit, the deposition of a suitable layer of ink upon the disc tablet of glass to form his improved recording medium, and the making thereon of a lateral or phonautographic record by recording, and the copying of that record in solid resisting material by the process of photo-engraving (T., p. 468, line 55, to p. 469, line 45), and the centering of the copied record, which was a metal disc, upon the rotatable support therefor (T., p. 469, lines 46-80), Berliner then describes (*a*) how the disc gramophone of No. 564,586, shown in Fig. 1 and used for recording

the record, may also be used for reproducing sound from the record after it has been copied in solid resisting material and (*b*) how the arrangement shown in Fig. 10 is a mere modification or well known equivalent of the arrangement shown in Fig. 1. Referring first to Fig. 1 and then to Fig. 10, Berliner says (T., p. 469, lines 80-99);—

> "The *stylus* is then adjusted with its point *in engagement* with the outer end of the *record-groove*, and the weight 26 is allowed to descend. It will now be clear that *the stylus will be forced positively to follow the undulations of the record*, and that the diaphragm *vibrating under the stylus* will emit the same sounds which produced the original record, which sounds can be distinctly heard at the ear-piece 34.
>
> Both the process and the *apparatus* thus far described may be *modified in various ways without departing from the main features of my invention*. So, for instance, I can dispense with the centering device and can rotate the record upon a stationary axis, if the diaphragm with its attached stylus is mounted in a manner to make it *follow the spiral record*. An arrangement of this character is shown in Fig. 10."

When the weight 26 of Fig. 1 or of Fig. 10 (T., p. 469, line 109) was allowed to descend, the disc record-tablet provided with a spiral record-groove was, in each case, thereby caused to revolve. The reproducing stylus, being *"in engagement"* with the spiral record-groove was, in each case, *as stated* in the above quoted passage, *"forced positively to follow the undulations of the record,"* or made "to follow the spiral record," solely by the pressure exerted upon the point of the stylus by the walls of the revolving, spiral, record-groove. The two

arrangements, by which there was obtained the freedom of the stylus to follow the record, that is to be vibrated and propelled by the revolving, spiral record-groove, involved in each case the main features of Berliner's invention. The two arrangements were, as above shown, well known equivalents in the art and were recognized by Berliner to be equivalents, since he stated that the described apparatus of Fig 1 might be modified *in various ways* without departing from the main features of his invention.

In claim 8 of the patent No. 564,586 (T., p. 470) Berliner broadly claimed the invention embodied in the two equivalent forms of sound reproducing apparatus illustrated in Figs. 1 and 10. Claim 8 reads as follows (T., p. 470);—

> "In a gramophone, the combination of a sound-receiving *sonorous body;* with a *pivoted stylus* controlled by and controlling the same, and a support adapted to carry a phonautogramic recording-surface, *or a copy of such record* in solid resisting material, *traveling in the plane of vibration of the point of the stylus;* substantially as described."

The above-quoted claim 8 is to be read upon Figs. 1 and 10 of patent No. 564,586 and upon Fig. 3 of the patent in suit. It is also to be read upon Fig. 1 of the patent in suit.

In other words, the invention of Fig. 10 covered by claims 5 and 35 of the patent in suit is also covered by claim 8 of patent No. 564,586. Since claim 9 of the prior British patent No. 15,232 of 1887 (T., p. 524) is identical with the above quoted claim 8 and covers the same invention, it follows necessarily that the patent in suit and claims 5 and 35 thereof expired on November 8, 1904, before

this suit was begun, with the expiration of the legal term of the prior British patent.

An analysis of the elements of claim 8 shows that the "sound-receiving sonorous body" is the diaphragm of said Figs. 1, 10 and 3; that the "pivoted stylus controlled by and controlling the same" is the reproducing stylus of the same three figures; that the "support adapted to carry a phonautogramic recording-surface" or "the copy of such record in solid resisting material" is the rotating glass disc carrying the recording-surface, or the copy of the record in solid resisting material of the same three figures; and that in each of said three figures the copy of the record in solid resisting material, *being a flat disc*, travels, *by rotating*, "*in the plane of vibration of the point of the stylus.*"

It is the *disc* gramophone in its improved form, illustrated in said Figs. 1, 10 and 3, which Berliner claims in claim 8 of patent No. 564,586 and in claim 9, hereafter to be considered, of the prior British patent No. 15,232 of 1887. In *each* of said three figures, the pivoted stylus vibrates *laterally* in the *plane* of the revolving disc record-tablet. The "*vibration* of the point of the stylus" is, in *each* figure, caused solely by the pressure exerted upon the point of the stylus by the walls of the revolving, spiral record-groove which pressure causes or "*forces*," as *stated* in the specifications of both patents, No. 564,586 and No. 534,543, the stylus of *each* of said three figures to follow the spiral record-groove and thus to be propelled across the face of the record.

While it may be true that claims 5 and 35 of the patent in suit are "broader claims" than is claim 8 of No. 564,586, *it is unquestionably true that*

the invention of claims 5 and 35 is covered by claim 8. In claim 8 the diaphragm and the fact that it controls and is controlled by the stylus are mentioned, but all this is implied in claims 5 and 35. In claim 8 the "*traveling*" disc record-tablet is mentioned, and so it is in claims 5 and 35. In claim 8, as well as in claims 5 and 35, the arrangement of the "*travelling*" spiral record-groove and of the reproducing stylus is such that the stylus is in engagement with the record-groove and free to be vibrated and propelled by the walls of the revolving, spiral, record-groove itself. In claim 8, as well as in claims 5 and 35, the "traveling" record-tablet *must* be a *rotating* record-tablet, but no other limitation of the *travel* of the record-tablet is mentioned in or can be assigned to any one of the three claims, *since claim 8, like claims 5 and 35, is to be read upon Fig. 10 as well as upon Fig. 1,* in which the record-tablet rotates upon a stationary or upon a moving axis.

Because the undulations of the spiral record-groove alone vibrate the reproducing stylus, it is the walls of the spiral record-groove which *alone* force the vibrating stylus to follow the spiral groove of the record and to be propelled across the face thereof. If anything other than the record-groove propelled the *stylus*, the undulations of the record-groove could not vibrate the stylus and reproduce the recorded sound. In the reproduction of sound, therefore, the mode of operation of Fig. 1 is precisely the same as that of Fig. 10 and of Fig. 3 of the patent in suit and for this reason Berliner described Figs. 1 and 10 as equivalents and claimed them as such in claim 8.

The novelty, if any, of claims 5 and 35 rests solely, as heretofore shown (*supra*, pp. 49, 54), upon

the freedom of the stylus to be vibrated and propelled by the record. The well-known equivalent means of securing such freedom, explained and referred to by Berliner, are included in claim 8 as well as in claims 5 and 35. The equivalency of such means cannot be open to question because Berliner covered Fig. 1 and Fig. 10 by claim 8.

It being clear that the invention of claims 5 and 35 of the patent in suit is covered and patented by claim 8 of patent No. 564,586, it remains to show only that the same invention was previously patented in the prior British patent No. 15,232 of 1887, of which claim 9 reads as follows (T., p. 524);—

> "9. In a gramophone, the combination of a sound receiving diaphragm or other *sonorous body;* with a *pivoted stylus* controlled by a diaphragm, and controlling the same, and a support adapted to carry a phonautographic record sheet *or a copy of such record*, in solid resisting material, *traveling in the plane of vibration of the point of the stylus*, substantially as described."

Claim 9 of the British patent is identical with claim 8 of the home patent, the "phonautographic record sheet" of the one being the same as the "phonautogramic recording-surface" of the other. For comparison claims 5 and 35 of the patent in suit are here repeated;—

> "5. The method of reproducing sounds from a record of the same, which consists in *vibrating* a stylus and propelling the same *along* the record by and in accordance with the said record, substantially as described."

> "35. In a sound reproducing apparatus consisting of *a traveling tablet* having a

sound record formed thereon and a reproducing *stylus* shaped for *engagement* with said record and *free to be vibrated and propelled* by the same, substantially as described."

Claims 5 and 35, like claim 8, are concededly to be read upon Fig. 10 and the description thereof in patent No. 564,586. They are also to be read, as above shown, like claim 8, upon Fig. 1 and the description thereof in the same patent. In claim 8 of patent No. 564,586, Berliner broadly claimed the main features of his invention, illustrated in Figs. 1 and 10. *The mounting of the stylus in a manner to make it follow "along" the spiral record, or, in other words, so that it should be free to be vibrated and propelled by the spiral record, was inseparately involved in the combination claimed in claim 8 of patent No. 564,586 and in the identical claim 9 of the prior British patent.* The three following propositions are, therefore, clear;—

(1). That *one and the same invention* was claimed by claims 5 and 35 of the patent in suit, by claim 8 of patent No. 564,586 and by claim 9 of the prior British patent.

(2). That the *main features* of one and the same invention were claimed by the said four claims of the said three patents.

(3). That, *therefore*, the patent in suit and claims 5 and 35 thereof expired with the prior British patent.

Complainants attempt to meet this defence by pointing out that Fig. 10 is not shown in the prior British, French and German patents of November

8, 1887. Such fact, however, is clearly immaterial, since none of the four claims under consideration were limited by the details shown in any *specific* device. *Fig. 10 was not shown in the patent in suit any more than it was in the prior foreign patents.* In the patent in suit, to illustrate the invention in question, Berliner chose *Suess' improvement* upon Edison's sound reproducing apparatus of 1878, an improvement consisting in mounting the reproducer upon the horn or sound-conveyer, carried by *Edison's* pivoted, swinging arm (*supra*, pp. 105-106). In patent No. 564,586, Berliner chose the equivalent arrangements shown in Figs. 1 and 10 thereof to illustrate the same invention, broadly claimed in claim 8 thereof. In the prior British patent Berliner chose the same Fig. 1 of patent No. 564,586 (T., p. 526, Fig. 8) to illustrate the same invention, broadly claimed in claim 9 of the British patent which is identical with said claim 8. *The pivoted, swinging arm 88 of Fig. 3 of the patent in suit* (T., p. 454) *was not the invention of Berliner.* To it Berliner can lay no claim whatever. It was first employed by Edison in 1878 and later by Bell & Tainter in 1885 and by Suess in 1888. Berliner took Fig. 1 of the Suess Canadian and United States patents (T., p. 446) and used it as Fig. 3 of the patent in suit, merely substituting therein his reproducer of Figs. 6 and 7 of the patent in suit.

Complainants cannot successfully distinguish the alleged invention of claims 5 and 35 of the patent in suit upon the ground that the Edison-Suess machine of Fig. 3 of the patent in suit differs from machines illustrated in other patents. Whatever else Berliner may have done he did *not* devise the machine of Fig. 3. Claims 5 and 35

must, therefore, if they can be upheld at all, be construed with reference to the known equivalent methods of vibrating a stylus and forcing or propelling it to follow a record-groove.

The decision of this court in the leading case of *Miller* v. *Eagle Mfg. Co.*, 151 U. S., 186, from which the courts below have attempted to break away, is clear authority in support of the present defence. In that case Mr. Justice Jackson, speaking for this court, said;—

> (p. 198). "The result of the foregoing and other authorities is that no patent can issue for *an invention* actually covered by a former patent, especially to the same patentee, *although the terms of the claims may differ:* that the second patent, although containing a *broader claim,* more generical in its character than the specific claims contained in the prior patent, is also void; but that where the second patent covers matter described in the prior *patent essentially distinct and separable* from the *invention covered thereby* and claims made thereunder, its validity may be sustained.
>
> "In the last class of cases it must *distinctly appear* that the invention covered by the later patent was a *separate invention* distinctly different and *independent* from that covered by the first patent; in other words, it must be something substantially different from that comprehended in the first patent. It must consist in something more than a mere distinction of the breadth or scope of the claims of each patent. If the case comes within the first or second of the above classes, the second patent is absolutely void.
>
> "*It is insisted on the part of the appellee that 'whether this invention shall be protected in part of its features by one patent, and as to the rest by another, or shall be completely pro-*

tected by a single patent, is a matter which concerns solely the patent office and the inventor.' Under the rule announced in the foregoing authorities this proposition cannot be sustained.

. . . . "It is settled also that an inventor may make a new improvement on his own invention of a patentable character, for which he may obtain a separate patent, and the cases cited by the appellee come to this point *and to this point only*, that a later patent may be granted where the invention is clearly distinct from, and *independent of* one previously patented."

Under this decision, it would be idle to contend that claim 8 of patent No. 564,586 is not void, since it covers the invention of claims 5 and 35 of the patent in suit, which was previously granted. Hence, the patent in suit necessarily expired with the prior British patent, because claim 9 of the prior British patent is identical with said claim 8.

In the *Miller* case this court held, as will be seen from the passage above quoted from the opinion, that *three classes* of cases must be considered in determining the question whether a patent is granted for an *invention* covered by a prior patent to the same patentee. The three classes are the following;—

First class, in which it is held that the second patent is void if issued for an *invention* actually covered by a former patent, *although the terms of the claims of the two patents may differ.* In other words, it is *the invention*, the main features or substance of the invention, to which we must look and not to the terms of the claims, because although the terms of the claims may differ, the claims may, nevertheless, cover the *same invention*. A patentee

cannot patent by one patent *some features* of his invention and thereafter secure a second valid patent for *other features* of the *same* invention. An inventor can secure only one valid patent for *all* the different features of one invention.

Second class, in which it is held that although the second patent contains a *broader claim* than any claim contained in the first patent, the second patent is void because by patenting the *specific* embodiment of the invention in the prior patent, the patentee's right to protect the invention is exhausted.

Third class, in which it is held that a valid second patent may be obtained for matter described in a prior patent only when it distinctly appears that the invention covered by the later patent was *a separate invention distinctly different from and independent of the invention* covered by the first patent.

Applying these principles to the suit at bar, it is clear that by claim 8 of patent No. 564,586, by the identical claim 9 of the prior British patent, and by claims 5 and 35 of the patent in suit, Berliner patented the same invention and the main features of the same invention.

Berliner said that the apparatus embodying the invention might be modified *in various ways*, two of which he illustrated in Figs. 1 and 10, without departing from the main features of the invention, and such statement was clearly correct in view of the then existing state of the prior art. Under such circumstances, Berliner could not differentiate the one invention, or the different features of the one invention, by illustrating the invention in one patent by one form of apparatus and by illustrating

the same invention in another patent by another form of apparatus which, in the first patent, he said was a mere modification and equivalent of the first form of apparatus. Still more clearly is it true that Berliner in the patent in suit could not *five years later*, in 1892, differentiate the same invention by illustrating it by an entirely different apparatus devised by Suess, who in 1888 supported the reproducer upon the sound-conveyer or horn carried by Edison's freely swinging, pivoted arm of 1878.

The result reached by the courts below is one not permitted by the patent laws, for under their holding, Berliner has secured a monopoly of the *function* of a machine, since claims 5 and 35, as construed by the courts below, cover not only the prior, broad invention of Edison, but also Suess' improvement upon Edison's broad invention. All this Berliner has obtained upon the basis of Fig. 10 which disclosed an impractical apparatus. Fig. 10 is not provided with a reproducing stylus mounted upon a freely swinging, pivoted arm so as to be free to be vibrated and propelled by the spiral record-groove as in the Edison-Suess machine of Fig. 3 of the patent in suit; nor is it, like the Edison-Suess machine of Fig. 3, provided with a universal joint permitting the reproducing stylus to bear or rest by gravity and with yielding pressure upon the record-groove. Fig. 10 does not, therefore, like Fig. 3, permit of the vertical adjustment of the stylus with the record-groove; nor does it, like Fig. 3, disclose any means for supporting the sound-conveyer or horn.

In *McClain* v. *Ortmayer*, 33 Fed., 284, affirmed 141 U. S., 419, a second patent was held void because in it the inventor attempted to patent a part

of the invention previously patented (118 Fed., 573-574). In the second patent a *single* spring and in the first patent a *double* spring, was employed to secure a pad to a horse-collar. Having claimed *two springs* in the first patent, McClain could not obtain a second, valid patent for a single spring. In the Circuit Court, Judge Blodgett held, as stated in head note 2, as follows (33 Fed., 284);—

> "A patent obtained upon a device, upon which a patent had already been obtained, in combination with another exactly similar but *unnecessary* device, *which it required no invention to dispense with, there being no material difference in the mode of operation and result*, presents no patentable novelty, and for that reason is void."

This court was of the same opinion. Obviously in the suit at bar, in view of the prior art and of Berliner's statement of the equivalency of Figs. 1 and 10, of patent No. 564,586, it involved no new invention and created no new mode of operation or result to employ Fig. 10 rather than Fig. 1 in the reproduction of sound. By claim 8 he patented both constructions as equivalents and claim 9 of the prior British patent is identical with claim 8.

In *Miller* v. *Eagle Mfg. Co.*, *supra*, the second patent was held void because the first patent claimed the spring adapted both to lift and to depress the beam, while the second patent claimed the spring adapted to lift the beam. The first patent clearly included the second.

In *Thomson-Houston Co.* v. *Hoosick Ry. Co.*, 82 Fed. 461,468 (C. C. A.), a second patent was held to be void on the authority of the *Miller* case because both patents were intended to secure to the patentee "the same general inventions."

In *Williams Co.* v. *Neverslip Co.*, 136 Fed., 210, 212, Judge Archbald, citing the *Miller* and other cases, decided by this court, held that a mechanical patent for a horseshoe calk was void because a design patent had previously been secured therefor. Judge Archbald said that there was only *one invention* and that the power to protect that invention was exhausted when the design patent was obtained.

In *Dayton* v. *Westinghouse Co.*, 118 Fed. 562, 574, the Circuit Court of Appeals for the Sixth Circuit, following the *Miller* case, said;—

> "This second patent was held void, for the reason that there was no new invention; the inventor having patented *simply a part* of the invention previously patented. . . . .
>
> "And in the *Palmer Pneumatic Tire Co.* case (90 Fed. 732), this court, following the *Miller* case, said:
>
> 'That decision shows that it is not necessary to the rule that patents should be for *co-extensive* inventions, *or that the subject matter thereof should be technically the same.*' "

In *Otis Co.* v. *Portland Co.*, 127 Fed. 557, 559, the Circuit Court of Appeals for the First Circuit said;—

> "Two patents may be regarded as for the same invention, though one claims only a *special* machine, and the other claims broadly a *genus* which includes the former. *Miller* v. *Eagle Mfg. Co.*, 151 U. S., 186, 198."

In *Sawyer Spindle Co.* v. *Carpenter*, 133 Fed., 238, 240, Judge Brown said;—

> "Two patents and two claims may be regarded as for the same invention, though one claims only a special machine and the other

claims broadly a genus which includes the former. *Otis Elevator Co.* v. *Portland Co.*, 127 Fed., 557 (C. C. A.), *Miller v. Eagle Mfg. Co.*, 151 U. S., 186."

Within the authorities above cited claims 5 and 35 of the patent in suit expired with the prior British patent because

(1). Claims 5 and 35 of the patent in suit clearly cover (*a*) the *invention*, and (*b*) *the main features of the invention*, covered by claim 9 of the prior British patent which is identical with claim 8 of patent No. 564,586.

(2). Claims 5 and 35 of the patent in suit being broad, *generic* claims, as held by the courts below, broader than any claim contained in patent No. 564,586 or in the corresponding prior British patent, cover the invention of claim 9 of the prior British patent, which is identical with claim 8 of patent No. 564,586.

Futile effort of complainants' counsel in the courts below to misinterpret claim 9 of the prior British patent and claim 8 of Patent No. 564,586.

Complainant's counsel, in the Circuit Court of Appeals, while admitting that the word "traveling" used in claims 1, 2, 3, 7 and 13 of Patent No. 564,586 referred to the travel of the surface of a tablet due to rotation only, contended that in claim 8 the word "traveling" has a different meaning and refers not to "*a copy of such record in solid resisting material*," but to the support 7 of Fig. 1 of Patent No. 564,586.

Referring to claim 8 of Patent No. 564,586 and to claim 9 of the British patent, it is clear that the combination of those claims consists of the diaphragm, which is the "sonorous body," of the stylus

which is pivoted and which is controlled by and controls the diaphragm, and *either* "a support adapted to carry a phonautographic record-sheet," *or*, "a copy of such record in solid resisting material," *traveling in the plane of vibration of the point or end of the stylus*, substantially as described. The word "traveling" means "rotating" and modifies *either* "a support adapted to carry a phonautographic record-sheet," *or*, "a copy of such record in solid resisting material." The "traveling" referred to is stated to be "in the plane of vibration of the point or end of the stylus." The point or end of the stylus vibrates only in the plane of the glass disc supporting the recording medium or record-sheet or in the plane of the copy of such record. The word "traveling," therefore, refers to the rotation either of the disc supporting the recording medium or of the copy of the record in solid resisting material. In Fig. 10 of Patent No. 564,586, the word "traveling" can have no meaning other than "rotating," since the only way in which the copy of the record in solid resisting material of Fig. 10 can travel is by rotating.

The contention of complainant's counsel that the word "traveling" modifies only the word "support" and that the word "support" refers to the support 7 shown in Fig. 1 of the home patent No. 564,586 and in Fig. 8 of the British patent is untenable. The support mentioned in claim 8 of the home patent is "a support adapted to carry a phonautogramic recording-surface" which is the same as "a support adapted to carry a phonautographic record-sheet" in claim 9 of the British patent. That the support 7 is not a support adapted to carry a phonautogramic recording-surface, *a deposit of ink*, is clear from a reading of the specifications of the

British and home patents. The support 7 serves as a bearing for the bevel-gear 9 (home patent, T., p. 467, lines 43-44; British patent, p. 520, lines 50-51). In the specifications (home patent, p. 466, lines 62-67; British patent, p. 520, lines 24-26) Berliner describes specifically what is meant by a support adapted to carry the phonautographic recording-surface or record-sheet. He says:

> "I have further improved the process by using a transparent plate as a *support* for the non-resisting medium. This plate is, therefore, made either of glass or some other like substance whereby I secure several important advantages."

That the non-resisting medium forms the recording-surface or record-sheet is also specifically described by Berliner (home patent, p. 466, lines 88-91; British patent, p. 520, lines 36-38) as follows:

> "In my improved process, I employ a layer of semi-fluid ink or paint, of such consistency and thickness that it will neither subside or flow spontaneously."

The support referred to in claim 8 of the home patent and in claim 9 of the British patent is, therefore, the support 13 shown in Fig. 1 of the home patent and Fig. 8 of the British patent, being a plate of glass or other like transparent material adapted to carry the recording medium, a layer of semi-fluid ink or paint. The word "traveling" is used in claims 1, 4, 5, 9, 10 and 14 of the British patent and in claims 1, 2, 3, 4, 7, 8 and 13 of the home patent. Reference to these claims shows beyond all question that the support mentioned in claim 8 of the home patent and in claim 9 of the British patent is the traveling plate, the traveling

support, the traveling plate of glass, the traveling support of glass, the rotating disc of glass, &c. In the claims referred to, as well as in the descriptions of the patents, it is distinctly stated that a deposit of ink or like material is put upon the surface of the traveling plate, disc or support and removed therefrom by and in accordance with sound vibrations. Hence it is clear that the word "traveling" used in claim 8 of the home patent and claim 9 of the British patent modifies, and the punctuation shows that it modifies, either "a support adapted to carry a phonautogramic recording-surface," or "a copy of such record in solid resisting material," and that the word "traveling" means "rotating" and that the copy of the record in solid resisting material shown in Fig. 10 can travel only by rotating.

POINT NINE.

Berliner Patent in suit, No. 534,543 of February 19, 1895, expired February 11, 1899, before this suit was begun, with the expiration of the term of six years for which the prior Berliner-Suess Canadian Patent No. 41,901, of February 11, 1893, was granted, and beyond which it was not prolonged.

(*Assignment of error 16, supra, p. 12*).

It is respectfully submitted that the question presented by this point was *decided* by this Court in *Commercial Mfg. Co. v. Fairbank*, 135 U. S., 176, and that the decision of this Court in that case was *binding* upon the Courts below and that they *failed* to follow it.

In that case, a prior *Austrian* and a prior *Bavarian* patent had expired. The original term granted for the Austrian patent was one year from October 31, 1869 and the patent was "*prolonged*" from year to year, and then *permitted* to expire on May 26, 1876 (see record on appeal, pp. 484-486). The Bavarian patent was granted April 8, 1873, "for the space of two years." It was then "*prolonged* (renewed) from April 8, 1875, for another year" and "became void on the 8th of April, 1876, on account of expiration of the granted term" (record on appeal, p. 487). Upon the argument in this Court, as appears from page 3 of appellant's brief by Mr. Offield, the "asserted error" was that the Court below dismissed appellant's bill upon this ground alone, namely, "that the complainant's patent expired April, 1876, by the *expiration* of the Bavarian and Austrian patents."

This court said (135 U. S., 176, 194);—

> "The conclusion of the Circuit Court was that the plaintiffs' patent *expired* by the *expiration* of the Bavarian and Austrian patents.
>
> "We * * * are of opinion that the views of the Circuit Court, above quoted, are correct."

The case came before this Court shortly after the decision in *Bate v. Hammond*, 129 U. S. 151, and immediately after that in *Pohl v. Anchor Brewing Co.*, 134 U. S. 386, and Mr. Justice Blatchford wrote the opinion as he did in the *Bate* and *Pohl* cases, and could not by any possibility have overlooked the point necessarily involved.

According to the Austrian law, in force at the time, (See Carpmael, *Patent Laws of the World*, London, 1885, p. 23), it was provided, by §25, that

"the *longest duration* of privileges is fixed at fifteen years," and, by §27, that "every patentee whose privilege has been granted for a shorter period than the longest (§9 c) may claim its *prolongation* for one or more years within the fixed longest period," and, by §9 c, "that number (of years) cannot exceed fifteen except by a special grant of the Emperor."

In *Gramme Electric Co. v. Arnoux*, 17 Fed. 838, 840, Judge Blatchford had previously ruled upon the precise question and, in holding that a home patent expired with a prior Austrian patent *at the end of the tenth year of prolongation* of the latter, had said that;—

> "*A capacity of being prolonged so as to have a duration of fifteen years is not equivalent to having a term of fifteen years when the patent is granted for one year and then is prolonged so as to expire at the end of ten years.*"

Judge Blatchford's opinion in the *Gramme* case was cited with approval in *Bate v. Sulzberger*, 157 U. S. 1, 31, upon the point of the meaning of "previously patented."

Unquestionably Congress intended, by the enactment of Rev. St. §4887, as stated in *Bate v. Sulzberger*, *supra*, that an invention previously patented in a foreign country should become "free to the American people, whenever, by reason of the expiration of the foreign patent, it becomes free to the people abroad."

Judge Blatchford's opinions in the *Commercial Mfg. Co.* and *Gramme* cases explain clearly why in *Bate v. Hammond*, *supra*, as stated in *Pohl v. Anchor Brewing Co.*, *supra*, this Court limited itself to the *precise* question involved, the Canadian

patent in the *Bate* case having been kept alive for the full period of 15 years and not having been permitted to expire at the end of the original term of five years. The House of Lords in England, in construing the Canadian patent act, has held that a British patent "*expires*" through failure to pay the government fees required to keep a British patent in force and that a Canadian patent for the same invention "*expires*" therewith, (*Dominion Cotton Mills Co. v. General Engineering Co.*, L. R. App. Cas. (1902), p. 570, (quoted *supra*, p. 134), and this Court has left open the question of the "*expiration*" of a British patent under such circumstances (*Hobbs v. Beach*, 180 U. S. 383, 398). Whatever may be the persuasive force, if any, of this decision of the House of Lords, in the construction of Rev. St. §4887, it is clear from the decision in the *Commercial Mfg. Co.* case that the decision in the *Pohl* case does not apply to Austrian, Bavarian or Canadian patents.

> (*a*). *Judge Townsend found that the Berliner-Sucss Canadian patent "discloses and broadly claims the invention covered by the claims here in suit," and "that if this patent expired, as claimed in 1899, the patent in suit expired at the same time."*

The Canadian patent is to be found at pp. 155-175 of the transcript of the record. By stipulation (T., p. 541, fol. 1621), its drawings are the same as those of U. S. patent No. 427,279 (T., p. 446).

Not only does Judge Townsend say in his opinion that this Canadian patent "discloses and broadly claims the invention covered by the claims here in suit" (T., p. 324, fol. 971), but he also says (T., p. 325);—

"But the Canadian patent in terms describes and claims the *broad generic* invention of Berliner covered by the claims here in suit, as will be seen from the following claims:

'5. In an apparatus for reproducing sounds from a record tablet, the combination with a reproducer mechanism consisting of a sound conveying tube and a diaphragm and stylus mounted at one end of the tube; of a freely swinging supporting frame for the said reproducer mechanism, substantially as described.

'7. In an apparatus for reproducing sounds from a record tablet, the combination with a reproducer mechanism consisting of a sound conveyer, and a diaphragm and stylus mounted at one end thereof; of a supporting frame for the said reproducer, loosely pivoted to swing freely both laterally and vertically, substantially as described.

'11. In an apparatus for reproducing sounds from a rotating record-tablet, a reproducing stylus mounted to have a free movement over the surface of the record tablet, substantially as described.'

"I think, therefore, that if this patent expired as claimed in 1899 the patent in suit expired at the same time, upon the authority of the decisions cited above."

Judge Townsend further said (T., p. 327):—

"But . . . . . *if the expiration of the Suess Canadian patent is a complete defense* . . . . . yet I am constrained to grant the injunction in order to permit an appeal and a determination of the questions at the earliest possible moment."

(b). Assuming, as Judge Townsend found, that the Berliner-Suess Canadian patent "dis-

closes and broadly claims the invention covered by the claims here in suit," the patent in suit expired on Feb. 11, 1899, with the expiration of the six year term for which the Canadian patent was granted.

Unquestionably the Canadian patent covers "in an apparatus for reproducing sounds from a rotating record tablet, a reproducing stylus mounted to have a free movement over the surface of the record tablet, substantially as described" (T., p. 167, claim 11). For the movement of the stylus over the surface of the rotating record tablet as described, Suess states that he relies upon the "control of the stylus by the walls of the record groove for the movement of the stylus across the face of the disc, there being no positive feeding mechanism for thus moving the stylus" (T., p. 158, fol. 474). Other claims and other parts of the specification of the Canadian patent likewise show that Suess was the inventor of machines such as the machine of Fig. 3 of the patent in suit and complainants' exhibits of defendant's machines

(c). The invention of the Berliner-Suess Canadian patent was, under the statute and decided cases, patented and caused to be patented by Berliner, the patentee of the patent in suit.

In order that a United States patent shall, under §4887, be limited by a prior foreign patent, it is not necessary that the foreign patent be taken out by the inventor and patentee of the United States patent, but it is sufficient if he *causes* the foreign patent for the same invention to be issued.

The language of §4887 is very broad. It reads as follows:—

> "No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, *by reason of its having been first patented or caused to be patented* in a foreign country, unless the same has been introduced into public use in the United States for more than two years prior to the application. But every patent granted for *an invention which has been previously patented* in a foreign country shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the *shortest term*, and in no case shall it be in force more than seventeen years."

All that is necessary is that the invention be first patented or *caused* to be patented in a foreign country by the patentee or inventor of the United States patent. In *Hobbs* v. *Beach*, 180 U. S., 383, 397, the Supreme Court stated that §4887 "evidently means that the patentee shall not be debarred from *his* patent by reason of *his* having first patented or *caused his* invention to be patented in a foreign country." In *Wilcox Co.* v. *Industrial Co.*, 110 Fed. 210, 214, Judge Gray said "We do not think that §4887 of the Revised Statutes applies to a patent taken out by another than the patentee of the patent whose term is sought to be shortened and *without his acquiescence or consent.*"

Berliner as assignee of Suess took out the Canadian patent, and if claims 5 and 35 of the patent in suit are broad enough to cover the invention of the Canadian patent, since the Canadian patent is a prior foreign patent to Berliner, the patent in suit expired with the Canadian patent on February 11, 1899.

(*d*) *Under the patent act of Canada, a*

Canadian patent "expires," within the meaning of §4887 of the Revised Statutes, at the expiration of the term for which the fee to the Government has been paid, unless a further fee for a "further term" is paid. The patent does not lapse and is not forfeited, but its term expires. The Berliner-Suess Canadian patent was granted for a term of six, and not of eighteen, years, since the granted term depends solely upon the provisions of the patent act.

The material parts of the patent Act of Canada is one of defendant's exhibits (T., pp. 181-188).

According to § 22 of the Patent Act of Canada (p. 184) and of § 39 thereof (p. 187), the applicant has the option of paying the fee for eighteen, twelve or six years. The term of the Canadian patent cannot exceed eighteen years (§ 22 p. 184). In other words, eighteen years is the *limit* of the duration of *any term* of a Canadian patent, but at the option of the applicant the patent may be issued for a shorter term of six years or of twelve years. Sub-division 2 of § 22 of the Patent Act of Canada provides (p. 185);—

> "2. If a partial fee only is paid, the proportion of the fee shall be *stated in the patent* and the patent shall, *notwithstanding anything therein or in this act contained*, cease at the end of the *term* for which the partial fee has been paid, unless, before the *expiration* of the said *term*, the holder of the patent pays the fee required for the *further term* of six or twelve years."

In accordance with this provision of the Canadian act, the grant of the Canadian patent contains the following provision (p. 156, fol. 467);—

> "The partial fee required for the *term* of six

> years having been paid to the Commissioner of Patents, this Patent shall cease at the end of six years from date, unless at, or before the *expiration* of the said *term*, the holder thereof pay the fee required for the *further term* or *terms* as provided by law."

Clearly the payment of the further fee for the further term was a *condition precedent* (*Doepfner v. Bowers*, 55 Misc., 561 and cases cited).

The certificate of the Canadian Patent Office states (p. 169, fol. 507);—

> "that the said patent *expired* upon the 11th day of February, 1899, by reason of the non-payment of the fee for the second *term* of six years."

Under the above quoted provisions of the Patent Act of Canada and of the grant of the Canadian patent, it required no act on the part of the Canadian government to terminate the patent at the end of the six year term.

The grant (p. 156) of the Berliner-Suess Canadian patent "for the period of eighteen years from the date of these presents . . . . provided, that the *grant hereby made is subject to the conditions contained in the acts aforesaid*," means, as stated in the act, that "the patent shall, *notwithstanding anything therein or in this act contained*, cease at the end of the *term* for which the partial fee has been paid, unless before the *expiration* of the said *term*, the holder of the patent pays the fee required for the *further term* of six or twelve years." Clearly the Canadian patent *expired*, under these provisions at the "*expiration of the said term*", *six years*, for which alone it was granted at the *time of its issue*. *Not having been prolonged, renewed or extended, it never had any other term.*

Eighteen years was the limit of time to which it might have been prolonged, but no *further term*, beyond the original term of six years, having been obtained, the patent had but one term of six years and "*expired*" at the "*expiration of the said term.*"

Thus the provisions of the Canadian Patent Act clearly show that a patent may be issued for the term of six years, for the term of twelve years, or for the term of eighteen years, and that in case of a patent issued for the term of six years, the patent will expire by the "*expiration of the said term,*" unless a further fee is paid for a "*further term.*" A patent is a *contract* between the government and the patentee, and the rules for the construction of contracts control in its interpretation (*Seymour v. Osborne*, 11 Wall. 516, 533; *American Co. v. Denning Co.*, 160 Fed. 108, 115). There is *no obligation* by *contract* or otherwise, to pay the further fee for the further term and there is *no forfeiture or lapse* of the patent if the further fee for the further term is not paid. If the further fee for the further term is not paid, the granted term "*expires,*" like the *term* of a *lease* where the option to renew has not been exercised, and the patent, in the language of the Act, will "cease at the end of the *term* for which the partial fee has been paid, unless before the *expiration* of the said *term* the holder of the patent pays the fee required for the further term of six or twelve years." The certificate above quoted says "the said patent *expired.*" For the *lapsing* and *forfeiture* of patents through the non-performance of a condition subsequent or the like, the Canadian Patent Act makes special provision under the separate head of "Forfeiture of Patents" (§ 37, pp. 186-187). Suit is to be

brought by the Attorney General of Canada, etc. (T., p. 186, fol. 558).

> (e). *Under the provisions of the patent act of Canada payment of a further fee for the prolongation of the patent for a further term is a* CONDITION PRECEDENT *to the existence of a term beyond the original term of six years, and not a* CONDITION SUBSEQUENT *operating on non-performance to forfeit the unexpired portion of a term previously granted.*

In *Pohl v. Anchor Brewing Co., supra*, this Court likened the *term* of a *patent*, under Rev. St. §4887, to the *term* of a *lease*, and cited *Oakley v. Schoonmaker*, 15 Wend. 226; *Beach v. Nixon*, 9 N. Y. 35; and *Farnum v. Platt*, 8 Pick. 339, in support of the holding that "expiration" of a prior foreign patent meant expiration of the *term* of the patent by "*lapse of time*" and not the forfeiture or lapsing of the patent by reason of a condition subsequent.

In *Davis v. Gray*, 16 Wall. 229, this Court said;

> "There is a wide distinction between a *condition precedent*, where no title has vested, and *none is to vest until the condition is performed*, and a *condition subsequent*, operating by way of a defeasance. In the former case equity can give no relief. The failure to perform is an inevitable bar. No right can ever vest. The result is very different where the condition is subsequent. There equity will interpose and relieve against the forfeiture, upon the same principles of compensation, where the principle can be applied, giving damages, if damages should be given, and the proper amount can be ascertained."

To the same effect is *Giddings v. Insurance Co.*, 102 U. S., 111.

In accordance with the above stated principle, the distinction between *the forfeiture of a lease*, by reason of a *condition subsequent*, and failure to exercise a right *to renew or prolong a lease*, by performance of a *condition precedent*, is well settled. In *Doepfner v. Bowers*, 55 Misc. 561, the Supreme Court of New York, citing the two above cited decisions of this Court and *Kerr v. Purdy*, 51 N. Y., 629, *Precht v. Howard*, 187 N. Y. 136 and other cases, held that, under a lease containing a covenant for the renewal or prolongation of the lease upon the giving of notice prior to the date of the expiration of the term of the original lease, the giving of the notice within the time stated was a *condition precedent*. The condition not having been performed, the lease and the term thereof expired, no title to a renewal or extension vested, and equity was powerless to grant relief.

Clearly under the provisions of the Patent Act of Canada and of the grant of the Berliner-Suess *Canadian* patent, quoted *supra*, pp. 195-196, the payment of a further fee for a further term was a *condition precedent* to the existence of any term beyond the original term of six years, and the condition precedent not having been performed the six-year term of the Canadian patent, the *only* term it ever had, expired by *lapse of time* at the end of the six years. There was no forfeiture or lapsing of any part of the term of the patent by reason of a condition subsequent or other cause. This is in accordance with the opinions of Mr. Justice Blatchford in the *Gramme*,

Commercial Mfg. Co., *Bate* and *Pohl* cases, cited *supra*.

(f). Judge Townsend erred in holding that the legal term of the Canadian patent did not expire but lapsed or became forfeited in 1899. The Bonsack case, cited by Judge Townsend in support of his ruling, is directly opposed thereto, and the Welsbach case, cited by him in support of his ruling, in no way involved the question at issue.

Judge Townsend correctly stated the rule of law when he said (T., p. 326);—

> "The rule in such cases as I understand it is that the duration of the United States patent is limited by the duration of the legal term of the foreign patent and that it is not limited by any *lapse* or *forfeiture* of any portion of said term by means of any *condition subsequent*.
>
> *Pohl* vs. *Brewing Co.*, 134 U. S., 386.
>
> "In *Bate Refrig. Co.* vs. *Sulzberger*, 157 U. S., 1, the Supreme Court says as follows:
>
> "'But the American patent will be granted upon the condition that, if you obtain the foreign patent first, your invention shall be free to the American people whenever, by reason of the *expiration of the foreign patent*, it becomes free to the people abroad.'"

He erred, however, in considering that the legal term of the Canadian patent did not *expire* but *lapsed* or became *forfeited* by means of a *condition subsequent*. Judge Townsend based his ruling upon the decision of Judge Simonton in *Bonsack Machine Co.* v. *Smith*, 70 Fed. 383, and of the Circuit Court of Appeals for the Second Circuit in *Welsbach Light Co.* v. *Appollo Co.*, 96 Fed., 332.

It is not surprising that Judge Townsend reached his conclusion as he says "*with some hesitation*" (T., p. 326), because his conclusion is directly contrary to Judge Simonton's decision in the *Bonsack* case, and the question decided in the *Welsbach* case was entirely different from the question here involved, as will be seen from the following statement of the decisions in those two cases.

Before taking up the decision in the two cases mentioned, attention should be directed to the word "*permitted*" used by this Court in *Bate Refrig. Co. v. Sulzberger*, 157 U. S. 1, 36, just before the part quoted, as above stated, by Judge Townsend. This Court said;—

> "the American patent expired with the foreign patent, and thereby the American public became entitled to use the invention from the time the foreign public were *permitted* to use it."

As pointed out by Judge Simonton, in the *Bonsack* case as will presently be shown under subdivision (*f*), an inventor "*permits*" the foreign public to use his invention, when by his *voluntary* act he does not avail himself of the *privilege* of prolonging or renewing the original term of the foreign patent, but permits the patent to expire through *lapse of time* at the end of the original term thereof. In the case of a *lapse* or *forfeiture* through *breach of a condition* subsequent, the inventor is *deprived* of his foreign patent and does not, by his voluntary act, *p* *it* the foreign public to use the invention.

> (*g*). *In the Bonsack case it was squarely held that a Canadian patent for which the fee for a five year term only had been paid and*

which was not prolonged by payment of a further fee for a further term before the expiration of the original five year term expired with the expiration of the original five year term and did not lapse or become forfeited.

In *Bonsack Machine Co.* v. *Smith*, 70 Fed., 383 Judge Simonton held that a United States patent expired with the expiration of the five year term of a Canadian patent. At that time, under the Canadian Patent Act, the duration of a Canadian patent could not exceed fifteen years, but the applicant at his option could obtain a patent for the term of five years, or for the term of ten years, or for the term of fifteen years by paying the fee required, and he could, before the expiration of the five year or the ten year term, obtain an extension for another period or term of five years by paying a further fee. That was under § 17 of the Canadian Patent Act which is quoted by Judge Blatchford in *Bate* v. *Hammond*, 129 U. S., 151, 165. Although the duration of the terms was changed at the time the Canadian patent to Berliner was issued from five, ten and fifteen years to six, twelve and eighteen years, nevertheless *the substance of the provisions is identical under each act*, and it is clear that in each case if at the end of the first term a further fee is not paid and a further term secured, the patent ceases through the *expiration of the term* and not by forfeiture or lapsing through the non-performance of a condition subsequent. Judge Simonton, in *Bonsack Machine Co.* v. *Smith*, *supra*, held that under the decision of this Court in *Pohl* v. *Anchor Brewing Co.*, 134 U. S., 381, the word "expire" means "cease to exist because of the termination of the duration of the original grant, and not to mean

cease or determine by reason of some penalty or forfeiture for the non-performance of some condition subsequent." Referring to the cases cited by the Supreme Court to show that the words "expiration of term" mean "expiration by lapse of time" (134 U. S., 381), Judge Simonton in the *Bousack* case also said that "in those cases it was held that the words 'expiration of term' do not mean expiration of term through a forfeiture by breach of a condition, but mean expiration by *lapse of time.*" Accordingly Judge Simonton held that the Canadian patent having been granted for five years and having expired at the end of the five years, and not having been renewed for a further term, had expired, not by forfeiture, but *by lapse of time*, and that, in consequence, the United States patent expired with the expiration of the five year term of the prior Canadian patent. Judge Simonton's decision is the last reported decision upon the point so far as defendant's counsel has been able to ascertain.

In pages 392-395, Judge Simonton exhaustively considers and discusses; first, what is the *term* of a Canadian patent; second, what is the meaning of the word "*expire*" in § 4887 of the Revised Statutes; and, third, when does a Canadian patent, under the Patent Act of Canada *lapse* or become *forfeited*. Judge Simonton's conclusion was; first, that although a Canadian patent could be *prolonged* for successive terms of five years each, not to exceed in the aggregate fifteen years, yet "*each duration of five years is a term independent.* This clearly appears from the language of the act of 1872, and that of the act of 1883 in *pari materia*" (p. 393); second, that the word, "*expire*," as used in § 4887 of the Revised Statutes, means expira-

tion of the term by *lapse of time* and not through a *breach of a condition*, resulting in a *lapse* or *forfeiture* (p. 392), and he pointed out that in *Bate* v. *Hammond*, 129 U. S., 151, the Canadian patent there in question did not "expire" at the end of the original five year term because the patentee, having exercised "the privilege of renewing and extending the term," the original term of five years was converted into a continuous term of ten years and then of fifteen years, and the patent could not be said to "expire" until the expiration of the fifteen years (p. 394); and, third, that where, by the law of Canada, a patent is granted for five years and the privilege of renewing and extending the term is not exercised and the five year term expires, such an expiration of the five year term is not, under the law of Canada, a breach of a condition resulting in a lapse or forfeiture, but *an expiration of the granted term*, because the conditions of forfeiture and penalty are not incurred as they would have been if a patentee had failed to put his invention into operation within two years or had introduced a patented machine from abroad after twelve months, and *because the patentee had never put himself under any obligation by contract or otherwise* to pay the additional sum of money or fee as a *condition precedent* to the exercise, entirely of his own volition and option, of the privilege of renewing and extending the five year term (pp. 394-395). So Judge Simonton concluded that the patentee of the Canadian patent had held his patent five years *"until the term fixed by law had expired by its own limitation"*; that in the *Pohl* case, *and this marks the distinction*, the prior German patent was forfeited because the patentee failed to fulfill a positive *duty* enjoined upon him by statute or by

contract, to wit, the *obligation* to pay the taxes; and that the language of the Supreme Court in *Bate* v. *Sulzberger;*

> "If you have a foreign patent your patent shall cease to protect you, when, by reason of the expiration of the foreign patent your invention becomes free to people abroad"—

applied, since the patentee of the Canadian patent in question—

> "Knowing the condition on which he held his United States patents, he, of his own volition, allowed the new term to *expire* in 1891, not to *lapse* nor become *forfeited*. By his own act he made his invention free to people abroad. It became free thereupon to the people of this country. He lost the protection of Section 4887."

It is difficult to understand how Judge Townsend could have reached his conclusion in the suit at bar, even "with some hesitation" upon Judge Simonton's decision in the *Bonsack* case. If the decision in the *Bonsack* case was correct, the Berliner-Suess Canadian patent *expired* and did *not lapse* or become *forfeited* in 1899, and the patent in suit expired therewith.

> (*h*). *In the Welsbach case the only question involved was whether, where a prior French patent had been forfeited before the grant of the home patent, but after the filing of the application therefor, the home patent was invalid upon the ground of abandonment or other ground arising out of those facts only. The question whether the prior French patent had been forfeited or had expired was not involved, for, concededly, it had been forfeited.*

In *Welsbach Light Co.* v. *Apollo Co.*, 96 Fed., 332, in which defendant's counsel in the suit at bar filed a brief upon the question involved on behalf of the *Kex Incandescent Light Company*, the question, and the *only* question, was whether where a prior French patent had been forfeited *before* the *grant* of the home patent, but *after* the filing of the *application* therefor, the home patent was invalid under the authority of *Huber* v. *Nelson Mfg. Co.*, 148 U. S., 270. An examination of the briefs of Messrs. Choate, Bennett and Wetmore, filed in the Circuit Court of Appeals, shows that the argument proceeded principally upon the question whether the decision of the Supreme Court in the *Huber* case rested upon *abandonment* or whether that decision was broad enough to make invalid any home patent granted after the forfeiture of a prior foreign patent, although the application for the home patent had been filed before the forfeiture of the prior foreign patent. The Circuit Court of Appeals held that the *Huber* case rested upon *abandonment* and that the home patent having been *applied for* before the forfeiture of the prior foreign patent, abandonment was not shown.

Clearly in the Welsbach case, upon which Judge Townsend also relied, *the question here presented was not involved.* The question here is whether the Canadian patent *expired* in 1899, which was four years after the grant of the patent in suit, or whether the Canadian patent became *forfeited* at that date. If there was a mere forfeiture then the decision of the Supreme Court in *Pohl* v. *Anchor Brewing Co.*, 134 U. S., 386, settles the question; but if there was, *by lapse of time, an expiration of the term* for which the Canadian patent was granted, and Judge Simonton so held in the *Bon-*

sack case, then the decision of the Supreme Court in *Bate* v. *Sulzberger*, 157 U. S. 1, applies and the patent in suit expired with the expiration of the term of the Canadian patent in 1899. It is clear, therefore, that Judge Townsend overlooked the question here involved. His examination of the authorities was brief, he says, and this, undoubtedly, accounts for his incorrect statement of the points decided in the *Bonsack* and *Welsbach* cases above referred to.

Under the *principle* of the decision of this Court in *Huber v. Nelson Mfg. Co.*, 148 U. S. 270, Berliner *abandoned* the alleged invention of claims 5 and 35 in suit, when he voluntarily permitted the Canadian patent to expire through his failure to perform the *condition precedent* necessary to secure a *further term* and to prevent the Canadian patent from *expiring*. We learn from the later decisions in *Huber v. Nelson Mfg. Co.*, *Commercial Mfg. Co. v. Fairbank* and *Bate v. Sulzberger*, *supra*, that the decision in *Pohl v. Anchor Brewing Co.*, *supra*, is not to be extended. It was the clear purpose of Congress that an invention, previously patented in a foreign country, should become free to the American people whenever the patentee should permit it to become free to people abroad.

(*i*). *The distinction under § 4887 of the Revised Statutes, between patents granted for a short term and not prolonged before the expiration of the short term for a further term by reason of which the short term and the patent expire by lapse of time, and patents granted for a fixed term subject to forfeiture as a penalty upon breach of a condition subsequent during the term for which the patent*

was granted is well settled by authority in the patent law of this country. Judge Townsend erred in not recognizing this distinction and in not holding under the doctrine of stare decisis that the Canadian patent expired in 1899 with the expiration of the six year term for which it was granted, and which was the only term it ever had.

It is respectfully submitted that it is impossible upon the facts before the court, in view of the express provisions of the Canadian statute, to hold that the Canadian patent lapsed or became forfeited in 1899 and did not expire by lapse of time, within the meaning of §4887 of the Revised Statutes. As will be seen from the cases hereinafter cited the courts have uniformly held, and as Judge Simonton said, this marks the *distinction*, that *where a prior foreign patent is granted for a stated number of years upon the payment of a fee fixed for a term of that number of years, with a right to renew or prolong the patent for a further number of years and up to a number of years beyond which the patent cannot be prolonged, by payment of a further fee as a condition precedent, in such cases, if the patentee does not exercise his right to renew or prolong the patent for a further term or a further number of years, the patent expires by lapse of time, like the term of a lease where the option to renew has not been exercised, and carries with it a United States patent subsequently granted for the same invention. Where, however, a prior foreign patent is granted for a fixed term stated in the original grant and without provision for renewal or prolongation of the term, and the patentee, by reason of the contract*

with the government under which the patent is granted becomes obligated to perform certain conditions such as the payment of an annual tax or to work his invention within a fixed period after the grant of the patent, or is prohibited from introducing the patented article into the country granting the foreign patent, in such case, if the patentee does not pay the annual tax which he is under contract obligation to pay, like the payment of rent under a lease, or otherwise commits a breach of the conditions under which the patent was granted, the patent does not expire by lapse of time, but lapses and becomes forfeited by reason of the breach of condition subsequent. In *Pohl v. Anchor Brewing Co., supra*, the prior foreign patents were French and German patents granted each for the term of fifteen years *under penalty of forfeiture, as a condition subsequent, if the patentee should allow any year to elapse without paying the tax* (Law of France, T., p. 176). Because the patentee failed to pay the annual taxes, the French and German patents became forfeited because of the breach of condition *subsequent;* and, since there was no expiration by *lapse of time* of the terms for which the patents were granted, the Supreme Court held that § 4887 of the Revised Statutes did not apply and that the home patent did not expire at the time when the French or German patent became forfeited.

In the suit at bar, however, the Canadian patent clearly expired by reason of expiration through lapse of time. The term of the Canadian patent, the only term which the Canadian patent ever had, expired by lapse of time. This, as the Court will

see from the authorities cited, brings the case within the statute.

(j). Additional cases in the lower courts, following Judge Blatchford's opinions in Commercial Mfg. Co. v. Fairbank and Gramme Electric Co. v. Arnoux.

In *Western Electric Co.* v. *Citizens' Tel. Co.*, 106 Fed. 215, Judge Severns held, in accordance with the decision of this Court in *Commercial Mfg. Co. v. Fairbank Co., supra*, that a United States patent expired with the expiration of a three year term of a prior Italian patent. According to the law of Italy, the duration of a patent could not in any case exceed fifteen years (Pat. Laws of the World, Carpmael, 1885, p. 288, Art. 11); and "patents granted for less than fifteen years may be *prolonged* for one or more years; the duration, however, of the prolongation added to the duration of the original patent shall in no case exceed fifteen years" (Carpmael, p. 289, art. 12). It is believed that Judge Severen's decision is the last decision involving the principle relied upon.

In *Electric Accumulator Co.* v. *Brush Electric Co.*, 52 Fed. 130, 139, the Circuit Court of Appeals for the Second Circuit assumed under the authority of *Commercial Mfg. Co. v. Fairbank Co., supra*, as Judge Severens held, that, where an Italian patent was previously granted "for the term of three years from September 30, 1882, and *was not prolonged*" (p. 139) and was in force when U. S. patent No. 337,299 was issued (p. 139), the United States patent would have expired with the expiration of the three year term of the Italian patent, if the Italian patent had been granted for "any one of

the inventions" for which the home patent was granted (p. 139).

Judge Coxe, in the same case in the court below, stated the question involved as follows (47 Fed. 48, 52);—

> "Did patents Nos. 337,299 and 265,090 expire with the Italian patent? The Italian patent was * * * issued for a term of *three years* from September 30, 1882. It expired September 30, 1885, never having been *prolonged, renewed or extended.*"

Upon these facts, the only question considered open by Judge Coxe and the Circuit Court of Appeals was whether the home patents and the Italian patent were for the same invention. The question of identity of invention was, therefore, exhaustively examined by both courts, and it appearing, as the Circuit Court of Appeals said, that "the Italian patent is not the same in its essential particulars with *any one* of the inventions which are claimed in 337,299, and the home 'patent would not be infringed by a structure made in accordance with the provisions of the foreign patent'" (52 Fed. 139), it was held that the home patent did not, *for this reason only*, expire with the Italian patent.

In *Edison Co. v. United Co.*, 52 Fed. 300, the Circuit Court of Appeals for the Second Circuit, held (head note 5) that "a prior Canadian patent, issued for 5 years, and extended for the further period of 10 years, should be regarded as having a continuous term for the entire period, and as not limiting the United States patent to any shorter term", following *Bate* v. *Hammond*, 129 U. S. 225, where the Canadian patent had been

kept alive for the full period of 15 years and where as the Supreme Court said later in the *Pohl case* (134 U. S. 381, 385) the court limited itself to the *precise question* involved in view of the fact that the Canadian patent did *not* expire, and that its term was kept continuous by renewals, until the end of the 15 years. Nevertheless the court *again assumed* (52 Fed. 312), that had the renewal of the Canadian patent become impossible at the end of the original term of five years, as contended by defendants, by reason of the lapse of a certain Swedish patent, the United States patent would have expired with the expiration of the 5 year term of the Canadian patent. It cannot reasonably be contended that the Court proceeded on any other theory or principle, since if such was not the theory of the court, it would not have exhaustively examined, in order to decide, the question whether the Canadian patent was effected in duration by the Swedish patent which did not exist when the Canadian patent was granted but was issued afer the grant of the Canadian patent. The court expressly said (p. 312) that "*the soundness of the defendant's contention depends on the meaning under the Canadian law, of the phrase 'where a foreign patent exists,' as used in this (the Canadian) statute.*"

It may be remarked that in the *Edison Co.* case, *supra*, the Circuit Court of Appeals misconstrued the phrase "where a foreign patent exists", as will be seen from the opinion of the House of Lords in *Dominion Cotton Mills Co. v. General Engineering Co.*, quoted *supra*, p. 134, because, instead of following *the clear words of the statute*, the court construed the phrase according to the meaning which

certain Canadian lawyers *supposed* to be the intention and effect thereof.

In *Pohl* v. *Anchor Brewing Co.*, 134 U. S. 381, 385, the court said that the question involved in that case was not the same as that decided in *Bate* v. *Hammond* and was not controlled by the decision in that case, where the court limited itself to the *precise* question involved. In *Bate* v. *Hammond* the Canadian patent had been kept alive for the full period of 15 years and, therefore, it did not expire at the end of the original term of five years. Where, however, the original term is permitted to expire by *lapse of time*, following *Oakley* v. *Schoonmaker*, 15 Wend. 226; *Beach* v. *Nixon*, 9 N. Y., 35 and *Farnum* v. *Platt*, 8 Pick. 339, and is *not forfeited* by breach of a condition subsequent, this Court said in the *Pohl* case and squarely held in the *Commercial Mfg. Co.* case, and the lower Courts following those decisions have held, that the United States patent expires with the expiration of the term for which the prior foreign patent was actually granted and extended, although when the foreign patent expired, the patent might have been extended under the foreign law for a further term. Although in the earlier decisions, among them one by Judge Townsend and one by Judge Wheeler, there was considerable conflict and confusion upon this question, the recent decisions of the courts show that the rule is now uniformly applied as above stated, in accordance with the meaning above explained of the expression "expiration of term" by "lapse of time."

The *term* of a lease *expires*, by *lapse of time and limitation*, if the privilege of renewal is not exercised. In such case, it would be absurd to say that there was a forfeiture by breach of a condi-

tion subsequent. If the privilege of renewal depends upon the optional payment of a certain sum, payment thereof is a *condition precedent* to the existence of, or right to, a new term. Such a payment is widely different from payment of rent during the term of the lease and under the contract *obligation* thereof. Failure to pay rent will act as a *condition subsequent* to forfeit the lease.

The *distinction* between patents, such as French and German patents, which become *forfeited* because of the breach of a condition subsequent, in the non-payment of annual taxes, according to the *contract* under which the patent is granted imposing an *obligation* upon the patentee, and patents which *expire* by lapse of time, such as Austrian, Bavarian, Italian and Canadian patents, because granted for a limited period and not prolonged, renewed or extended by the patentee *at his option*, in the exercise not of a duty but of a privilege, is clear and *well settled* in the patent law of this country. Judge Townsend erred in holding that the patent in suit did not expire in 1899 with the Canadian patent because he overlooked this well settled distinction upon which defendant, under the rule of *stare decisis*, had a right to rely in the investment of its capital and in the conduct of its business, without being subjected to the *disastrous results* of some new interpretation of the law, set forth with great "*doubt*" and "*hesitation*" in order to grant an injunction, destructive of its property and of its right, to permit an appeal to be taken.

POINT TEN.

Claims 5 and 35 of the patent in suit are void because of the public use in 1888, in this country, of the alleged invention thereof, more than two years prior to the filing of the application for the patent in suit on March 30, 1892.

(*Assignment of Errors 24 and 25, supra, p. 12*).

The application for the patent in suit was filed on March 30, 1892 (T., p. 456). The alleged invention of claims 5 and 35 thereof was publicly used in this country in the year 1888, *by Mr. Berliner and by Mr. Martin*, nearly four years before the filing of the application.

In support of this defence the following evidence is relied upon;—

(1). Testimony of Berliner (T., p. 231, Qs. 6-15).

(2). Berliner's lecture of May 16, 1888 before the Franklin Institute (T., p. 269, "Reproducing Apparatus, May, 1888" and p. 268, fols. 802-809).

(3). The article entitled "The Improved Gramophone" published in the *Electrical World* August 18, 1888 (T., p. 274).

(4). Testimony of Mr. Martin, editor of the *Electrical World* (T., p. 191) and of Mr. Wetzler, who wrote the article of August 18, 1888 (T., p. 194), both of whom witnessed and took part in the public use described in said article.

The evidence referred to proves the public uses by *Mr. Berliner* and *Mr. Martin* with the knowledge of the public. Section 4920 of the Revised

Statutes provides that in any action for infringement of a patented invention, the defendant may plead, *inter alia*, as follows;—

> "Fifth. That it had been in *public use* or on sale in this country for more than two years before his application for a patent, or had been *abandoned* to the public."

This provision is the same as section 4886, which provides that an inventor may secure a patent for an invention "not in *public use* or on sale for more than two years prior to his application, unless the same is proved to have been *abandoned*." The public uses by Berliner and Martin, relied upon are set up in the answer (T., p. 37, fols. 111-112).

The well settled law in regard to public use under the Revised Statutes of 1878, incorporating said sections 4920 and 4886, from the law of July 8, 1870, was stated in *Thomson-Houston Co.* v. *Lorain Co.*, 117 Fed., 249, C. C. A., affirming 110 Fed. 654, as follows (head note 1, 117 Fed. 249);—

> "The use of an invention by a subsequent patentee, with the knowledge of the public, more than two years before the filing of his application, renders the patent void for prior public use, unless it is shown by proof that is full, unequivocal, and convincing that such use was experimental for the purpose of perfecting the device; the fact alone that the use was *by the inventor himself* and without profit does not prevent it from being a bar to a patent."

In Walker on Patents (3rd ed., § 94(it is said;—

> "To constitute public use, it is not necessary that more than one specimen of the thing invented should have been publicly used (*Consolidated Fruit Jar Co. v. Wright*, 94 U. S. 94, 1876; *Jones v. Barker*, 11 Fed. Rep. 597,

1882), nor that more than one person should have known of that use (*Egbert v. Lippmann*, 104 U. S. 336, 1881)."

In *Jones v. Barker*, *supra*, Judge Lowell held (11 Fed., 597);—

"Public use, in the sense of the patent law, is proved by a single use by any person not the inventor, or by the inventor in an open way, provided the use is not experimental."

In *Eastman* v. *Mayor*, 134 Fed., 844, 858 (C. C. A.), the court deduced from the decided cases the following propositions upon the question of prior public use;—

"First. An inventor has a reasonable time in which to experiment for the purpose of perfecting the invention and demonstrating its utility.

"Second. The time thus spent, if in good faith, is no part of the two-year statute of limitations.

"Third. The experiments must be made in perfecting the invention as described and shown.

"Fourth. *Experiments made in testing parts of the machine not covered by the invention will not have the effect of extending the two-year period.*

"Fifth. As soon as the invention is completed, viz.: '*in such a condition that the inventor can apply for a patent for it*,' the two-year period begins to run and the application must be made within this period.

"Sixth. *The fact that the invention has been improved since its original embodiment does not demonstrate that it was then embryonic or incomplete.*

> "Seventh. *When a clear case of prior public use is established the burden is on the inventor to prove by convincing proof that the use was experimental.*"

In his lecture of May 16, 1888 before the Franklin Institute, Berliner publicly used the Suess sound reproducing apparatus of May, 1888, which is shown in the cut (T., p. 269). In the course of his lecture Berliner stated to his audience that while he was completing, by etching, the preparation of a sound record, he would let them listen to some phonautograms which he had prepared in Washington within the previous two weeks (T., p. 268, fol. 802). Referring to Suess, who was with him at the time, Berliner described in his lecture the Suess sound reproducing apparatus employed by him during his lecture for the reproduction of sound from sound records, as follows (T., p. 270, fol. 809);—

> "He suggested to mount the sounder on a pivot at some distance from the disk and then let the reproducing groove guide the sounder across the disc over an arc of flat amplitude. This happy idea is embodied in the *present* apparatus, and is a very ingenious adaptation indeed."

In his testimony Berliner said that he employed the Suess "reproducing apparatus, May, 1888" during his said lecture for the reproduction of sound from sound records previously prepared by him (T., p. 232, Q. 13) and he described the construction and operation of the said Suess reproducing apparatus as follows (T., p. 232, Q. 14);—

> "The reproducing diaphragm sound-box was mounted *at the end of a pivoted lever*, to it attached was a *rubber tube* which led to a

horn mounted on the violin music stand. The stylus of the reproducing sound-box was placed into the outer circle of the spiral of the record, and upon turning the table, upon which the record was mounted, *the sound-box was propelled freely across the record-disc by and along the volute of the record.*"

Referring to the article entitled "The Improved Gramophone" published in the Electrical World for August 18, 1888 (T., p. 274), it will be seen that a clear cut illustrating the Suess sound reproducing apparatus in its final form is given. A comparison of this cut with Fig. 1 of the Suess Canadian patent (T., p. 155), which is the same as Fig. 1 of the Suess United States patent (T., p. 446), both of which patents Berliner applied for and obtained as the assignee of Suess, shows that on August 18, 1888, more than three years before the filing of the application for the patent in suit on March 30, 1892, the Suess machine illustrated in Fig. 3 of the patent in suit (T., p. 454), upon which claims 5 and 35 in suit are to be read, because no other illustration of the subject matter of said claims is given in the patent in suit, had been perfected. The article in the Electrical World for August 18, 1888 was written by Mr. Wetzler as a result of the exhibition of the operation of the sound reproducing apparatus given by Berliner in the presence of Mr. Wetzler, Mr. Martin and others, and from explanations given by Mr. Berliner to Mr. Wetzler and Mr. Martin for the purposes of the article (T., pp. 191, 194). As stated in the article (T., p. 274) and as testified to by Mr. Martin (T., p. 191) and by Mr. Wetzler (T., p. 194) Mr. Berliner employed the sound reproducing apparatus in the presence of Messrs. Wetzler, Martin and others for the reproduction of sound. He

also gave to Mr. Martin, upon that occasion, one of the records used for reproducing sound upon the machine (T., p. 193, fol. 577) and Mr. Martin, as well as Mr. Berliner, employed the machine for the reproduction of sound from the records (T., p. 193, fol. 578). A most complete and perfect description of the sound reproducing machine was, at Berliner's instance and request, written by Mr. Wetzler and published broadcast in the *Electrical World* for August 18, 1888, which reads as follows (T., p. 274);—

> "Notwithstanding the simplicity of the etching process that of the *reproducing* apparatus is still greater. As shown in the accompanying engraving there is no gear or machinery of any kind except a small friction wheel which revolves the table having clamped down upon it the reproducing disc. The *reproducing* stylus connected to the diaphragm is permitted *to rest by its own gravity* in the reproducing groove of the record, and when the plate is made *to revolve* it not only *vibrates* the diaphragm and reproduces the sound but it also leads the diaphragm box across the disc from periphery to centre so that *the record groove serves at the same time as a screw instead of a separate gear.* The recording diaphragm and stylus are attached to a lever which is pivoted at a distance of about 18 inches from the centre line of the disc, and as it slowly swings across the disc it describes an arc of very flat amplitude. It may be objected that the motion given by the hand to the disc would not be sufficiently regular but while it is true that it would be desirable to have a motor attached to the machine, there is no difficulty whatever in revolving the disc regularly by hand, and by hanging up a small pendulum to swing before the eyes of the manipulator he can regulate the revolving motion by the swinging of the pendulum."

Unquestionably the sound reproducing apparatus illustrated in Fig. 3 of the patent in suit was in public use as early as 1888, except in so far as the reproducer illustrated in Figs. 6 and 7 of the patent in suit and previously patented in Germany and France, as shown under Points Six and Seven (*supra*, pp. 114, 152), was substituted in Fig. 3 by Berliner for the reproducer shown in the Suess reproducing apparatus of May, 1888 (T., p. 269), and in Fig. 1 of the Suess United States and Canadian patents (T., p. 446), which reproducer employed in the Suess machine is the same as the reproducer employed in defendant's machine charged with infringement (T., p. 296, fol. 886; p. 119, Par. 5th; p. 103, fol. 308). In the consideration of this defence of more than two years prior public use, however, we need not concern ourselves with the construction of the reproducer, since defendant has not used the reproducer of Figs. 6 and 7 of the patent in suit, and since complainants contend, as they must contend upon the question of infringement, that Claims 5 and 35 are not limited by the features of the reproducer shown in said Figs. 6 and 7.

Such being the undisputed facts, proved beyond any possible or reasonable doubt, we are now in a position to consider the rulings of the courts below in the prior suit upon the question of prior public use.

In the prior suit the evidence in support of the defence of more than two years prior public use rested solely upon Berliner's testimony and upon Berliner's lecture of May 16, 1888, before the Franklin Institute. The testimony of Messrs. Wetzler and Martin and the article in the *Electrical World* for August 18, 1888, showing the public use of Suess'

sound reproducing disc gramophone of Fig. 3 of the patent in suit in its perfected form, were not before the courts.

In the prior suits, complainants contended, and Judge Hazel held, erroneously it would seem, that the exhibition of the apparatus during the lecture of May 16, 1888, before the Franklin Institute was purely experimental (T., p. 70, fol. 209). With this holding the Circuit Court of Appeals was not prepared to agree (T., p. 74), and such holding of Judge Hazel was clearly contrary to the decision of the Circuit Court of Appeals in *Thomson-Houston Co.* v. *Lorain Co.* and *Eastman* v. *Mayor, supra.* A comparison of the Suess sound reproducing apparatus of May, 1888 (T., p. 269), with Fig. 3 of the patent in suit shows that in so far as the alleged invention here in controversy is concerned, that invention had been perfected by Suess at the time Berliner delivered his lecture and exhibited and used the apparatus. No change or improvement whatever upon it was ever made or contemplated by Berliner or Suess. Furthermore, Suess' improvement, whereby the reproducing stylus was mounted upon the sound conveyer or horn carried by Edison's freely-swinging, pivoted arm, was perfected before August 18, 1888, and illustrated and described in the article published in the *Electrical World* of that date. The Circuit Court of Appeals disposed of the defence of prior public use made in the prior suit upon a different ground and said (T., p. 74):

> "The specifications in that application (for 564,586) were full enough to warrant the making of the claims here in controversy (5 and 35); at any time the application *might* have been amended by *adding* such claims, and in

> our opinion it is immaterial that instead of thus amending it he took the broader claims on another application filed while the first was pending. The second may fairly be considered a *continuation* of the first, and thus Berliner's application antedates the public use."

Because of this holding of the Circuit Court of Appeals in the prior suit, the defence of prior public use was not open to this petitioner in the courts below, notwithstanding the new evidence interposed in regard thereto. It is respectfully submitted that the Circuit Court of Appeals erred in holding that the application for the patent in suit could be regarded as a *continuation* of the application filed November 7, 1887, for patent No. 564,586.

It is a well settled rule of patent law that the power to amend an application does not include the power to change the nature of the invention, especially where other inventors, whose rights would be prejudiced, have entered the field. The remedy is for the patentee to file a new application, as Berliner did, when he filed the application for the patent in suit which was in no way connected with the previous application of Nov. 7, 1887. *Fig. 3 and the description thereof in the patent in suit are so radically different from Fig. 10 and the description thereof in patent No. 564,586 that the one could not have been introduced as an amendment of the other, within the decided cases* (*Railway Co.* v. *Sayles*, 97 U. S., 554; *American B. T. Co.* v. *National T. Mfg. Co.*, 109 Fed., 976, 1005 and cases cited; *American Co.* v. *Steward*, 155 Fed., 731, 739; *Dodge Needle Co.* v. *Jones*, 153 Fed., 186, 191; *Ide* v. *Carpet Co.*, 115 Fed., 137, 147 and cases cited).

In the American B. T. Co. case, *supra*, Judge Brown said (109 Fed., 1005);—

"I am of the opinion that this patent is invalid for the reasons that *the power to amend an application does not include the power to change the nature of the invention;* that the right to amend or the right to complete an application under section 4894, Rev. St., U. S., *does not give the right to transform completely;* that the only remedy for a radical mistake in substance so serious as to require a transformation so complete as is here shown is *a new application. Rob. Pat.*, §§561, 635; *Consolidated Electric Light Co., v. McKeesport Light Co.* (C. C.), 40 Fed., 21-27; *Railway Co. v. Sayles*, 97 U. S., 554-563, 24 L. Ed., 1053; *Michigan Cent. R. Co. v. Consolidated Car-Heating Co.*, 14 C. C. A., 232, 67 Fed., 121."

In the *Dodge Needle Co.* case, *supra*, Judge Archbald held (150 Fed., 191), that where the nature of the amendment required a new application, *the defence of two years prior public use was to be considered with reference to the date of the new application.*

As shown under Point Five (*supra*, pp. 101-112), Fig. 3 of the patent in suit is a machine of entirely different construction from Fig. 10 of patent No. 564,586. The modes of operation of the two machines are widely different. *Excepting the reproducer shown in Figs. 6 and 7, the machine shown in Fig. 3 of the patent in suit is the gramophone which in the Canadian patent Berliner described and claimed broadly as the invention of Suess.* In Fig. 3 the stylus is carried at the end of a freely swinging, pivoted arm connected with its support by means of a universal joint. By reason of the universal joint the stylus was free to be vibrated and propelled by the revolving, disc, spiral, record-groove precisely according to the construction and mode of operation shown by Edison in his

British patent of 1878 (*supra*, pp. 71-76). Furthermore, by reason of the universal joint, the reproducing stylus was capable of vertical adjustment so that it rested by gravity with a yielding pressure in and upon the spiral groove of the record, as described in the *Electrical World* for August 18, 1888 (*supra*, p. 220), precisely according to the construction and mode of operation shown by Edison in 1878 (*supra*, pp. 71-76), and by Bell & Tainter in 1886 (*supra*, pp. 81-82). In Fig. 3, moreover, a sound-conveyer or horn was carried by the pivoted arm to both of which the reproducing stylus was attached. These important features which made a commercial success of the Suess machine of Fig. 3 were all absent from Berliner's sound reproducing apparatus shown in Fig 10 of patent No. 564,586. The stylus of Fig. 10 was not carried by a pivoted arm but by a carriage moving on rails. The stylus was not capable of vertical adjustment, since the reproducer, of which the stylus was a part, was suspended from a fixed horizontal rail by means of wheels rolling upon the rail. The stylus, therefore, did not rest by gravity and with a yielding pressure in and upon the spiral groove of the record. For these reasons the apparatus of Fig. 10 was impractical and was abandoned by Berliner, who lost the only apparatus ever constructed by him in accordance with Fig. 10 (*supra*, pp. 102, 111). Fig. 3 is further to be distinguished from Fig. 10, in that the reproducer of Fig. 3 is that shown in Figs. 6 and 7.

There is no statement in the patent in suit in any way connecting the application thereof with the application filed November 7, 1887 for No. 564,586. On the contrary, Berliner stated in the patent in suit (T., p. 456, lines 8-16) that the invention of

the patent in suit was an improvement upon the gramophone patented in No. 382,790, of May 15, 1888. The invention of the patent in suit was, therefore, subsequent in date to May 15, 1888, and the prior application of November 7, 1887 could not have been intended to cover it.

The application for the patent in suit was not filed as a *division* of the application filed November 7, 1887 (see patent in suit, T., p. 472). It also appears from the findings of Judge Hazel and the Circuit Court of Appeals in the prior suit, in evidence in this suit (T., pp. 71 and 74), that the claims here in controversy were never made upon the prior application. Such findings were in accordance with the file-wrappers and contents of the patent in suit and of Patent No. 564,586 (see record on appeal in prior suit, pp. 157, 275; 145 Fed., 350). It is the fact, and there was no evidence in the prior suit or in this suit to the contrary, that the features of the claims here in controversy, 5 and 35, as construed by the Circuit Court of Appeals, were first made the basis of an application for a patent and claimed in the application for the patent in suit, filed March 30, 1892.

Fig. 10 and the description of Fig. 10, contained in the application of November 7, 1887, are not contained in the patent in suit, but an entirely different sound reproducing apparatus and an entirely different description thereof are set forth in the patent in suit. If Judge Hazel was correct in upholding complainants' contention that the use of the Suess reproducing apparatus of May, 1888, exhibited by Berliner before the Franklin Institute on May 16, 1888, was an experimental use, it follows that the invention was not complete on May 16, 1888, and was not, therefore, complete when the

prior application was filed on November 7, 1887. The prior application could not, therefore, have been an application for the invention of Fig. 3 of the patent in suit or of any part thereof.

The fact is that when on March 30, 1892, Berliner filed the application for the patent in suit, he had abandoned the impractical apparatus shown in Fig. 10 of the application filed November 7, 1887, and no connection whatever existed between the application for the patent in suit and the application of November 7, 1887. Had Berliner attempted by amendment, to introduce in the application of November 7, 1887, Fig. 3 and the description thereof of the patent in suit the amendment would have been rejected as new matter.

In *Railway Co.* v. *Sayles*, 97 U. S., 554, this Court said, as stated in head notes 5 and 6:

> "5. The original application for letters-patent (with its accompanying drawings and model), filed by an inventor, should possess great weight in showing what his invention really was, especially when it remains unchanged for a considerable period, and is afterward amended so as to have a broader scope. *Amendments embracing any material variation from the original application—anything new, not comprised in that—cannot be sustained on the original application, and should not be allowed; otherwise, great injustice might be done to others who may have invented or used the same things in the meantime.*
>
> "6. The law does not permit enlargements of an original specification any more than it does where letters-patent already granted are reissued. It regards with jealousy and disfavor any attempt to enlarge the scope of an application once filed, or of letters-patent once

granted, the effect of which would be to enable the patentee *to appropriate other inventions made prior to such alteration, or improvements which have gone into public use.*"

But irrespective of these considerations, the fact is that Berliner filed his application for the patent in suit on March 30, 1892, more than two years after the sound reproducing apparatus illustrated in Fig. 3 and covered by claims 5 and 35, had been publicly used. Unless, as contended under Point Eight (*supra*, p. 164), the alleged invention covered by claims 5 and 35 of the patent in suit was patented by claim 8 of patent No. 564,586, and by claim 9 of the prior British patent No. 15,232 of November 8, 1887, Berliner never made any claim upon any application for the alleged invention of claims 5 and 35 until he filed the application for the patent in suit on March 30, 1892.

As will be seen from an examination of the authorities collated by the Circuit Court of Appeals in *Hayes-Young Co.* v. *St. Louis Co.*, 137 Fed., 80, 82, 83, and *Western Elec. Co.* v. *Sperry Co.*, 58 Fed., 186, 191, 192, in cases where a second application has been held to be a *continuation* of a first application and to relate back to the date of the first application, it has appeared (1) that the invention described and claimed in the second application was *claimed* as well as described in the first application (56 Fed., 714; 79 Fed., 80; 34 Fed., 328, 333; 11 Fed., 859); (2) that special circumstances existed *connecting* the second application with the first application and showing that the second application was in fact, and was intended to be, a *division* or continuation of the first application (56 Fed., 714; 79 Fed., 80; 11 Fed., 869; 68 Fed., 544); (3) that between the filing of the first

application and the filing of the second application the applicant had not *abandoned* the invention described and claimed in the second application or done any ing *estopping* him from making claim thereto; and (4) that the invention was *complete* and not merely experimental, when the first application was filed.

In the case at bar, however, it appears (1) that Berliner, in his application filed November 7, 1887, for patent No. 564,586, described the alleged subject matter of claims 5 and 35 of the patent in suit, as a mere modification, retaining the main features, of the invention described and claimed in Patent No. 564,586, but made *no claim* for such modification; (2) that no circumstance appears *connecting* the second application for the patent in suit with the first application for No. 564,586, or showing that the second application was in any sense whatever a *division* or continuation of the first application; (3) that *between* the filing of the first application for Patent No. 564,586 on November 7, 1887, and the filing of the second application for the patent in suit on March 30, 1892, Berliner, as appears from the following Eleventh Point (*infra*, p. 230), *abandoned* the alleged invention, and, as the assignee of Werner Suess, *asserted*, in an application filed May 5, 1891, for Letters Patent of Canada, that the invention held by the Circuit Court and the Circuit Court of Appeals to be the invention covered by claims 5 and 35 of the patent in suit, and illustrated by Fig. 10 of Patent No. 564,586, was broadly the sole invention of Werner Suess; and (4) that the invention was *not complete, as complainants contended and Judge Hazel held*, when the first application was filed on November 7, 1887. *Two years' prior public use and abandon-*

ment are clear (*Western Elec. Co.* v. *Sperry Co.*, 58 Fed., 186, 191, 192).

Additional authorities upon the question of more than two years prior public use.

Eastman v. Mayor, 134 Fed. 844 and cases cited; *Leticlier v. Mann*, 91 Fed. 917; *Young v. Clipper Co.*, 121 Fed. 560 and 130 Fed. 150; *Bradley v. Eccles*, 138 Fed. 911 and 144 Fed. 90; *Jenner v. Brown*, 139 Fed. 556.

In the following cases one application was held to be a continuation of another, because the second was either a *division* or a *renewal* of the first: *Godfrey* v. *Eames*, 1 Wall. 317; *Smith* v. *Goodyear*, 93 U. S., 500; *Graham* v. *McCormick*, 11 Fed. 859; *Ligowski Co. v. American Co.*, 34 Fed. 328; *Frankfort Co. v. Mill Co.*, 37 Fed. 533, 539; *Stirling Co.* v. *St. Louis Ass'n*, 79 Fed. 80.

In each of these cases the matter claimed in the second application was described and *claimed* in the first application.

POINT ELEVEN.

Claims 5 and 35 of the patent in suit are void, because, if Berliner ever had any right to the alleged invention of said claims, he had irrevocably abandoned his right thereto before the filing of the application for the patent in suit on March 30, 1892, and before the patent was issued on Feb. 19, 1895.

Assignment of errors 12 and 13, supra, p. 12, which read as follows:—

> "12. In not holding that Berliner had abandoned the invention claimed in claims 5 and 35

of the patent in suit, No. 534,543, *before he applied* for a patent therefor.

13. In not holding that Berliner had abandoned the invention claimed in claims 5 and 35 of the patent in suit, No. 534,543, *before the patent was issued.*"

The evidence of *abandonment* is convincing and complete. It is as follows;—

(1) Berliner's claim to the alleged invention of claims 5 and 35 rests *solely* upon Fig. 10 of patent No. 564,586, granted July 28, 1896 upon an application filed Nov. 7, 1887 (T., p. 466).

(2) The apparatus shown in Fig. 10 (T., p. 465) differs substantially from that shown in Fig. 3 of the patent in suit (T., p. 454), being different in construction and mode of operation, as explained *supra*, pp. 224-225.

(3) The apparatus shown in Fig. 10 was impractical and never went into use (*supra*, pp. 111-112). Berliner made only one model which he discarded and lost (*supra*, p. 102). As early as May 16, 1888, he was employing the machine invented by Suess (*supra*, p. 105).

(4) Berliner never claimed in any patent an apparatus such as that shown in Fig. 10, consisting of a reproducing stylus mounted on a carriage moving on rails, in combination with a revolving record-tablet. Such an apparatus is neither shown, described nor claimed in the patent in suit and no claim therefor is to be found in No. 564, 586 since claim 8 of the latter patent is a broad claim not limited by a stylus mounted on a carriage moving on rails (*supra*, pp. 173-176).

(5) In the article published in the *Electrical*

World for Nov. 12, 1887, Berliner gave to the public a complete description of the apparatus shown in Fig. 10 (*supra*, p. 99; and T., p. 244, top of 2nd col.). Berliner himself prepared the article (T., p. 230, Q. 3). Nothing further was ever heard of such an apparatus as that shown in Fig. 10.

(6) When Berliner delivered his lecture of May 16, 1888, before the Franklin Institute he stated that he had adopted the Suess machine in lieu of that described in the *Electrical World* for Nov. 12, 1887 and it was the Suess machine that he publicly described and used to illustrate his lecture (*supra*, p. 105; and T., p. 270, fol. 809).

(7) In the article published in the *Electrical World* for August 18, 1888, as the result of an exhibition and information given by Berliner for the purpose, Berliner gave to the public a perfect illustration and description of the Suess machine of Fig. 3 of the patent in suit in its perfected form (*supra*, p. 220; T., p. 274). This was nearly *four years* before the filing of the application for the patent in suit.

(8) On August 6, 1889, nearly *three years* before the application for the patent in suit was filed, Berliner, as the assignee of Suess, applied for U. S. patent No. 427,279, which was issued May 6, 1890 (T., p. 446). In this patent Berliner again gave to the public a perfect illustration and description of the Suess machine of Fig. 3 of the patent in suit.

Within the authorities hereinafter cited, it is submitted that, under Rev. St. § 4886, *abandonment* results as well from the *publication* of such clear, accurate and full descriptions of an inven-

tion as those set forth in the *Electrical World* for August 18, 1888 and in the Suess U. S. patent No. 427,279 of May 6, 1890, as from a prior *public use*, especially when *more than two years* intervenes between the publication of the description and the filing of the application for a patent. It is well settled that if a patent issues describing, but not claiming, an invention, the invention described and not claimed is dedicated to the public, and that no valid second patent can be obtained therefor upon an application filed *at any time* after the issue or publication of the first patent (*Swift* v. *Jenks*, 29 Fed., 642; *Holmes Co.* v. *Metropolitan Co.*, 33 Fed. 254; *Kinnear Mfg. Co.* v. *Wilson*, 142 Fed. 970, 973, C. C. A. and cases cited; *Thomson-Houston Co.* v. *Elmira Co.*, 71 Fed., 396, 404 C. C. A. and cases cited; *Independent Co.* v. *Jeffrey Co.*, 76 Fed. 981, 990 and cases cited; *Comptograph Co.* v. *Universal Co.*, 142 Fed. 539, 543; *Thomson-Houston Co.* v. *Ohio Co.*, 80 Fed. 712, 725, 728; *Ide* v. *Carpet Co.*, 115 Fed. 137, 147 C. C. A. and cases cited.)

The issue of a patent describing but not claiming an invention is *evidence of abandonment by publication*, which will defeat a second patent issued upon an application filed *at any time* and within *less* than two years after the issue of the first patent. Where an inventor puts the public in possession of an invention, by *publication* and without notice of his claim thereto, and thereby leads the public to believe that he does not claim the invention, such conduct amounts to abandonment and estops the inventor from thereafter obtaining a patent for such invention. The intention to abandon may be manifested otherwise than by words (*Planing Machine Co.* v. *Keith*, 101 U.

S. 479), as by conduct (*Kendall* v. *Winsor*, 21 How., 328); and there may be an abandonment *after* an application for letters-patent has been filed and *while* the application is still pending or after a patent has been granted (*Planing Machine Co.* v. *Keith*, *supra*, and cases cited *infra*, p. 238). Berliner filed his application for No. 564,586 on November 7, 1887, but he never claimed in that application an apparatus such as that shown in Fig. 10, consisting of a reproducing stylus mounted on a carriage moving on rails, in combination with a revolving record-tablet. He did not file his application for the patent in suit until nearly five years later when he described and showed not Fig. 10, but the Edison-Suess machine of Fig 3 of the patent in suit. In the meantime he put the public in possession of the invention and asserted that the invention belonged to Suess, *thereby leading the public to suppose that as far as he was concerned, he had no claim to the invention. Such conduct is abandonment which will defeat a patent* (*Planing Machine Co.* v. *Keith*, *supra*, and cases cited *infra*, p. 236).

(9) *We now reach the culminating proof of abandonment.* On May 5, 1891, about one year before the filing of the application for the patent in suit, Berliner, as the assignee of Suess, applied for the Canadian patent No. 41,901 (T., p. 155), which was issued on Feb. 14, 1893, two years before the patent in suit was issued on Feb. 19, 1895. In this Canadian patent Berliner disclosed and *broadly claimed*, as the invention of Suess, the invention of claims 5 and 35 in suit. The claims and description of the Canadian patent and the finding of the Courts below to the effect that the Canadian patent "describes and *claims* the broad

generic invention of the claims here in suit" have been fully set forth, *supra*, pp. .

The claims of the Canadian patent are a climax to the other facts showing that the invention belonged to Suess and that if Berliner had any claim whatever to the invention, he had irrevocably abandoned it and had taken a position so inconsistent with any claim on his part for the invention that he could not thereafter be heard to claim it.

(10). When Berliner filed his application for the patent in suit on March 30, 1892, the world was in possession of a gramophone such as that shown in the Suess Canadian patent, and had been in possession thereof since August 18, 1888, at least, when Suess' machine was disclosed to the world in its perfected form in the article in the *Electrical World* of that date.

It is respectfully submitted that in consideration of the facts and circumstances above referred to, no clearer case of abandonment, could be made out.

Assuming that claims 5 and 35 of the patent in suit are not to be limited by Berliner's improvements in the construction of his reproducer, and that when correctly construed they cover the invention described and broadly claimed by Berliner in the Canadian patent as the invention of Suess, it is clear that Berliner *irrevocably abandoned* all claim to the invention when he filed the application for the Canadian patent *as the assignee of Suess*, nearly a year before he filed the application for the patent in suit, and that when he filed the application for the patent in suit, he was *estopped* from claiming as his own the invention, which, in the Canadian application, he alleged to be the in-

vention of Suess. Neither Judge Townsend nor the Circuit Court of Appeals has shown how claims 5 and 35 of the patent in suit can, under the facts disclosed, be construed to cover the identical invention described and broadly claimed by Berliner in the Canadian patent as the invention of Suess; nevertheless, they have so construed the claims. Neither Judge Townsend nor the Circuit Court of Appeals has explained how, under the circumstances, *abandonment* of the invention by Berliner and *estoppel* are not clearly made out. It is respectfully submitted that the evidence conclusively shows *abandonment* of the invention and *estoppel*.

Authorities Upon the Question of Abandonment and Estoppel.

> "A party cannot occupy inconsistent positions; and where one has an election between several inconsistent courses of action, he will be confined to that which he first adopts. Any decisive act of the party done with a knowledge of his rights and of the fact, determines his election and works an estoped" (*Bigelow on Estoppel*, p. 578, ed. of 1872; *Smith's Leading Cases*, vol. 2, p. 735, Am. ed. 1873).

When Berliner made the Canadian application, *as the assignee of Suess*, he was in a position where he could not keep silent and thereafter claim the invention, which, as he then asserted, belonged to Suess.

In *Consolidated Fruit Jar Co.* v. *Wright*, 94 U. S., 92, this Court held that Mason at the time of his application for the patent there in question, had abandoned his invention to the public. The public was in possession of the invention in question, from sources entirely independent of Mason, before Mason applied for his patent; that is to say, Mason

having made his invention and having communicated it to others, the public had thereby come into possession of the invention. Such action on Mason's part was held to constitute an abandonment. On the question of estoppel, this Court said (p. 96);—

> "He who is silent when he should speak must be silent when he would speak if he cannot do so without a violation of law and injustice to others."
>
> "The supineness of the patentee is unexplained and inexcusable. *A principal akin to equitable estoppel applies.*"

By reason of Berliner's applications in the United States and Canada, *as the assignee of Suess*, and especially by reason of the broad claims of the Canadian patent, Berliner asserted, *and the assertion was in accordance with the truth*, that Suess was and Berliner was not, the inventor of gramophones such as complainants' exhibits of defendant's machines. This, it is confidently asserted is more than mere abandonment and estoppel; it is a concession and admission that Berliner himself had no right to claim the invention.

In *Huber v. Nelson Mfg. Co.*, 148 U. S., 270, abandonment of an invention in England was held to be an abandonment thereof in the United States.

In *Hutchinson v. Everett*, 26 Fed., 531, Judge Blodgett had occasion to pass upon the question of abandonment arising out of facts very similar to, but not so conclusive as, those in the suit at bar. Judge Blodgett, as stated in head notes 1, 2 and 4, held as follows:

> "1. Where one made, in 1874, a device which was claimed to embody an invention patented

to another in 1879, which earlier device never went into practical use, *held*, that the 1874 device was an abandoned experiment, and was not sufficient to defeat the patent" (*Railway Co. v. Sayles*, 97 U. S., 554, accords).

"2. It is hardly conceivable that one who was in fact the prior inventor of a device, on seeing it in use, and knowing that another claimed to be the inventor, would have uttered no protest, and laid no claim to the invention." (*Apply this to the Canadian patent*).

"4. The fact that a person, claiming to have invented a device in 1874 or 1875, knew that another had put it into public use in 1878, is sufficient to defeat his claims to take out a patent in 1883, even if he had been the inventor" (*Planing Machine Co. v. Keith*, 101 U. S., 479, accords).

Abandonment of an invention may be evinced by the conduct of the inventor at any time before or after the patent is granted.

"An abandonment of an invention to the public may be evinced by the *conduct* of the inventor *at any time*" before or after the patent is granted (*Planing Machine Co. v. Keith*, 101 U. S., 479; *Elizabeth v. Pavement Co.*, 97 U. S., 126, 134; *Bell v. Daniels*, 1 Bond, 212, 219; *Ransom v. Mayor*, 1 Fischer, 253, 273; *Holmes Electric P. Co. v. Met. B. A. Co.*, 30 Fed., 254). *Abandonment once made cannot be recalled* (same cases; and *Planing Machine Co. v. Keith*, 101 U. S., 479; *Western Electric Co. v. Sperry Co.*, 58 Fed., 186, 191).

"Abandonment is a question of fact and may be established by the patentee's intention to abandon or by inferences consistent therewith (*Rifle and Cartridge Co. v. Arms Co.*, 118 U. S., 22; *Planing Machine Co. v. Keith*, 101 U. S., 479)." So said Judge Hazel in the prior suit (T., p. 72).

POINT TWELVE.

Defendant's machines do not infringe claims 5 and 35 of the patent in suit when those claims are properly construed in view of the prior art disclosed.

Assignment of errors 14, 15, 28 and 29, which read as follows:

14. In not holding that claims 5 and 35 of the patent in suit, No. 534,543, should be limited to Berliner's *improvements in the details of construction of his reproducer*.

15. In not holding that defendant's devices do not infringe claims 5 and 35 of the patent in suit, No. 534,543.

28. In not holding that *in view of the prior art*, claim 5 should be limited to a method of reproducing sounds wherein the stylus is vibrated substantially as described in the specification of the patent in suit, No. 534,543, *and shown in figures 6 and 7 thereof*.

29. In not holding that *in view of the prior art*, claim 35 of the patent in suit, No. 534,543, should be limited to a sound reproducing apparatus having a reproducing stylus free to be vibrated substantially as described in the specification *and shown in figures 6 and 7 thereof*.

As fully explained under the preceding points of this brief, and especially under Point Five, dealing with the Suess Canadian patent, defendant's machines are constructed according to the gramophone of the Suess Canadian patent. As pointed out (T., p. 287, fols. 861-862; p. 296, fol. 886), de-

fendant has never made, sold or used machines provided with reproducers such as the reproducer of the patent in suit, shown in figures 6 and 7. That the reproducers used in connection with defendant's machines are like the reproducer of the gramophone of the Suess Canadian patent and are not like the reproducer of the patent in suit is obvious furthermore from a mere inspection and comparison. Since claims 5 and 35 must either be limited so as to cover a method or apparatus employing the reproducer of the patent in suit, shown in figures 6 and 7, or otherwise be held invalid, in view of the Suess Canadian patent, of Edison's English patent No. 1644 of 1878, of the Bell & Tainter patents of 1886, and the other evidence referred to above in this brief, it follows that defendant's machines do not infringe either claim 5 or claim 35 of the patent in suit.

The question is:

Whether where a person, as the assignee of another, first applies in a foreign country for a patent for an invention, and upon such application secures in the foreign country a patent broadly describing and claiming the invention, as the invention of another, such person can, after the filing of such application in the foreign country, file an application and secure a patent in this country for the same invention as his own invention. In other words, under such circumstances, can the claims of the home patent be construed to cover the invention described and claimed in the prior foreign patent?

This question arises upon the evidence showing that on May 5, 1891, Berliner, as the assignee of Werner Suess, filed an application in Canada upon which, on February 11, 1893, Letters Patent of Canada, No. 41,901, were granted (T., p. 169, fol.

507). The Canadian patent is set forth in the record at pages 155-168. By stipulation (T., p. 541) the drawings of the Canadian patent are identical with the drawings (T., p. 446) of U. S. Patent No. 427,279, of May 6, 1890, to Berliner as the assignee of said Suess. The file wrapper and contents, including the assignment, petition, powers of attorney and proceedings in the Patent Office, of the Canadian patent, are to be found in the record at pages 169-175. The petition (T., p. 170) was signed by Berliner, who asserted therein that Werner Suess had "invented new and useful improvements in gramophones, not known or used by others before his invention thereof," and that Berliner, by an assignment, "acquired the right of obtaining a patent from Werner Suess aforesaid for the said invention," and "prays that a patent may be granted to him as the assignee of the said Werner Suess for the said invention."

That the Canadian patent describes and broadly claims the invention covered by the claims, 5 and 35, of the patent in suit, here in controversy is clear. Referring to the opinion of Judge Townsend, it appears that Judge Townsend found that the Canadian patent "discloses and broadly claims the invention covered by the claims here in suit" (T., p. 324, fol. 971) and that "the Canadian patent in terms describes and claims the broad, *generic* invention of Berliner covered by the claims here in suit" (T., p. 325, fol. 973). With this finding of Judge Townsend the Circuit Court of Appeals agreed, as will be seen from the oral statement of that court made when affirming upon the argument Judge Townsend's decree. The Circuit

Court of Appeals said (petition for writ of *certiorari*, p. 42, fol. 126);—

> "Of course, if the Canadian patent expired the United States patent expired at the same time."

In view of this Canadian patent which was not in evidence in the prior suit, this petitioner contends that the construction given to the claims 5 and 35 in the prior suit was incorrect, not warranted by the specification of the patent in suit, and unreasonable by reason of the fact that in the Canadian patent Berliner, as the assignee of Suess, had previously described and *claimed the broad invention* which in the prior suit, in the absence of the Canadian patent, the courts had construed the claims 5 and 35, in controversy, to cover.

As both the Circuit Court and the Circuit Court of Appeals have squarely held that the Canadian patent describes and broadly claims the invention of the claims 5 and 35, here in suit, as construed by the courts in the prior suit and in this suit, but little needs to be said further upon this point. It is desired only to point out that in *Matheson* v. *Campbell*, 78 Fed., 910, 917, the Circuit Court of Appeals for the Second Circuit said:

> "It must be *sound law*, as it is reasonable *common sense* to hold that the *tests of prime importance* in a suit for infringement are those which the *patent itself* prescribes. The inventor certainly may be assumed to know what it is that he has invented. If any one is able to describe the product of his inventive skill, it is himself. He surely knows the earmarks of the thing he seeks to patent. * * *"

Referring to the patent in suit, it will be seen

that Berliner describes all the features of his invention at page 456, lines 17-36, as follows:

> "*One feature* of my invention has reference to *improvements* in the *method of recording sound* by tracing upon a fatty film deposited upon a metallic surface, undulatory lines, corresponding to sound waves, and then etching such lines in the metal base, or, as it is now commonly called, the record tablet; while the *other features* of my invention have reference to the *construction of the details of both the recorder and the reproducer of the gramophone*. Each of these *features of improvement* are designed to overcome certain difficulties, and to avoid certain imperfections *heretofore met with in the operation of the gramophone*. These difficulties and imperfections, and the manner in which they are avoided, will be particularly pointed out in the following description with reference to the accompanying drawings, in which—"

This is the patentee's express declaration of the features of improvements contained in the patent, and no other declaration whatever of any other feature of improvements is to be found elsewhere in the patent. In the face of this express and positive declaration of the patentee as to what are the features of his invention, the Circuit Court and the Circuit Court of Appeals have held not only that the patent included other features not enumerated by Berliner, but have gone even further and held that the features which Berliner did enumerate as the features of his invention are not the principal features of his invention; and finally the Circuit Court and the Circuit Court of Appeals reached the unreasonable and the untenable conclusion that the claims, 5 and 35, here in controversy, were not to be limited in any way by the features which Ber-

liner in the specification pointed out as the principal features of his invention, but were to be broadly construed so as to cover the invention which Berliner had previously described and broadly claimed in the Canadian patent as the invention of Suess.

It is, therefore, respectfully submitted that the broad construction given to claims 5 and 35 in the prior suit and in this suit is a construction which renders claims 5 and 35 invalid, because anticipated by Suess in the Canadian patent, as well as by Edison and by Bell & Tainter; that such broad construction of claims 5 and 35 is, upon the facts stated, unreasonable and untenable; and that claims 5 and 35, when properly and reasonably construed, in view of the Canadian patent and of the express statement of Berliner in the patent in suit as to the features of his invention, *must be limited, by Berliner's improvements in the construction of his reproducer.*

In his lecture before the Franklin Institute Berliner said (T., p. 266):

> "I will now describe the *most important* apparatus of the *gramophone*—the *recorder*."

Equally important with the recorder, is, of course the reproducer, which, as Berliner stated in the Franklin Institute lecture (T., p. 268),

> "is constructed on precisely the same principles as the recorder."

The recorder and the reproducer constitute, therefore, as Berliner says, the principal features of the invention of the patent in suit. *A proper construction of claims 5 and 35 must include the features of construction of the reproducer*, whereby the reproducer is permitted to vibrate laterally in

the manner described in the specification of the patent. In other words claims 5 and 35, when properly construed, are infringed only by a sound-reproducing apparatus employing a stylus carried by *"a leaf spring twisted at one point so as to bring the edge of one portion at right angles to the face of the other portion, whereby it is elastic in two directions"* (see claim 25, T., p. 462), *and can vibrate laterally.* This was Berliner's *improvement* upon the laterally-vibrating stylus of the prior art (see expired U. S. patent No. 372,786 of Nov. 8, 1887, Fig. 2, T. pp. 416 and 526).

Petitioner used the reproducer of the Suess gramophone of the Canadian patent, which reproducer has none of the features of the invention of the patent in suit. Petitioner's machines embody the invention of Suess, only, and unless claims 5 and 35 can be construed so as to cover broadly the invention of the Canadian patent, they cannot be construed so as to cover petitioner's machines.

As this defense was not met by the opinion of Judge Townsend in the Circuit Court, as it was not met by the oral statement in the Circuit Court of Appeals, and as it is clearly conclusive in reason, this Court is respectfully requested carefully to consider the argument made in support thereof, and to pass upon the question whether it is possible to hold that claims 5 and 35 can reasonably and properly be construed so as to cover an invention which the patentee, Berliner, had previously asserted in the most solemn and irrevocable manner, in the Canadian patent, was the invention of Suess; and, if it is possible so to hold, whether claims 5 and 35 are not invalid, because before filing his application for the patent in suit Berliner asserted in the Canadian patent that the invention thereof was

the invention of Suess, and thereby became *estopped* from thereafter claiming the invention as his own.

It is not reasonable to hold that what Berliner claimed in Canada as the invention of Suess, he subsequently claimed in the United States, by the claims in suit, as his own invention. Claims 5 and 35 must, therefore, be limited, and, when limited, they are not infringed by defendant.

The same patent solicitor, acting for Berliner, made the application for the Berliner-Suess Canadian patent and the application for the patent in suit (T., pp. 171, 452). It is not reasonable to hold that he first claimed the invention for Suess in Canada and then claimed the same invention for Berliner in the United States.

Berliner's Canadian patent No. 55,079 (T., pp. 314-317), identical with the patent in suit, was applied for and issued after the issue of the Berliner-Suess Canadian patent; hence, the Canadian patent office, as well as Berliner, considered that claims 5 and 35 did not cover the broad invention of the earlier Berliner-Suess Canadian patent, but were limited as above stated.

POINT THIRTEEN.

The matter of the patent in suit was concededly the subject of more than one prior, foreign patent. Hence under Rev. St. Section 4887, the patent in suit expired at the same time with the foreign patent having the shortest term.

It was shown under Point Six (*supra*, p. 131), that even before the decision of this court in *Siemens' Adm'r* v. *Sellers*, 123 U. S., 276, the Pat-

ent Office held in *ex parte Unsworth*, 15 O. G., 882, as follows;—

> "Where the entire matter is the subject of *more than one foreign patent* the restriction should be made in view of *the one having the shortest term*."

The Patent Office was referring to a case where the matter of the home patent had been split up to form the subject matter of several prior, foreign patents obtained in the same foreign country. It must be immaterial, however, whether the several prior, foreign patents covering the several features of the home patent were obtained in one or in more than one foreign country.

Concededly, the subject matter of the alleged invention of claims 5 and 35 of the patent in suit was previously patented by Berliner in Canada (see Point Nine, *supra*, p. 188).

Concededly, the reproducer described and claimed in the patent in suit was previously patented by Berliner in Germany (see Point Six, *supra*, p. 144).

Concededly, the reproducer and also the recorder described and claimed in the patent in suit were previously patented by Berliner in France (see Point Seven, *supra*, p. 152).

Clearly, the main features of the invention of the patent in suit were previously patented by Berliner by the British, French and German patents of November 8, 1887 (see Point Eight, *supra*, p. 164).

Hence, the entire matter of the patent in suit was previously patented by Berliner in several foreign countries. Therefore, according to the express provision of Rev. St. § 4887, (quoted *supra*, p. 128), since more than one prior, foreign patent was ob-

241

tained for the subject matter of the invention of the patent in suit, the patent in suit was limited to expire, and did expire, with the prior, foreign patent "*having the shortest term.*" It cannot be contended that some of the claims of the patent in suit expired with one prior, foreign patent, some with a second, some with a third, and the rest with others. According to the statute, the patent in suit expired with that prior, foreign patent which had the shortest term. The patent in suit, therefore, expired with the Canadian patent of Point Nine, or with the German patent of Point Six, or with the French patent of Point Seven, or with the British, French and German patents of Point Eight. It is immaterial which. In any case it expired under the clear provision of the statute.

Unless the court, contrary to the repeated decisions of this Court (*supra*, pp. 132-135), is to read into the statute provisions and exceptions not therein contained, and is to depart from the clear and unambiguous words of the statute, which are applicable to the precise facts in the suit at bar, and is to base its decision, as did the Courts below, upon some *supposed* policy of Congress, not stated in the statute, then the patent in suit expired.

POINT FOURTEEN.

For the reasons stated in the preceding points of this brief, the bill was without equity, and, the patent having expired, the Circuit Court was without jurisdiction to entertain this suit in equity. The Circuit Court, therefore, erred in not dismissing the bill.

Assignment of error 23 (*supra*, p. 12), sets forth that the Circuit Court erred in not dismissing the bill of complaint. The other relevant assignments of error have been referred to in the preceding points of this brief.

It appearing that the patent in suit had expired before this suit *in equity* was begun, the Circuit Court, under repeated decisions, had *no jurisdiction* to entertain the suit and should have *dismissed the bill* (*Root* v. *Railway Co.*, 105 U. S., 189; *Diamond Co.* v. *Sens*, 159 Fed. 497; *Brown* v. *Lanyon*, 148 Fed. 838, 842; *Plotts* v. *Central Co.*, 143 Fed. 901; *Deere Co.* v. *Dowagiac Co.*, 153 Fed. 177, 180.

It appearing also that the claims in suit are void because they are claims for the functions of a machine, that claim 35 in suit is void because it claims nothing, that the claims in suit are void because of anticipation, of more than two years prior, public use and of abandonment, and that the patent and claims in suit are not infringed, the bill was *without equity* and should have been *dismissed* upon the hearing of the application for the injunction *pendente lite* (*Harriman* v. *Northern Securities Co.*, 197 U. S., 244, 286; *Castner* v. *Coffman*, 178 U. S. 168; *Mast, Foos & Co.* v. *Stover Mfg. Co.* 177 U. S., 485 and 89 Fed. 333, 337; *De Laval Co.* v. *Vermont*

Co., 109 Fed. 813; *Streat* v. *American Co.*, 115 Fed. 634).

It appearing also that the patent in suit had expired not only before the suit was begun, but also before the application for the injunction *pendente lite* (Point Seven), the Circuit Court erred in entering the decree for injunction.

CONCLUSION.

The decree of the Circuit Court for an injunction and the order of affirmance of the Circuit Court of Appeals should be reversed with costs and the cause remanded to the Circuit Court with a direction to dismiss the bill.

Respectfully submitted,

LOUIS HICKS,

Counsel for petitioner.

Office Supreme Court, U.S.
FILED.
JAN 13 1909
JAMES H. McKENNEY,
CLERK.

No. 80. October Term, 1908.

IN THE

United States Supreme Court.

LEEDS & CATLIN COMPANY,

Petitioner-Defendant,

v.

VICTOR TALKING MACHINE COMPANY and UNITED STATES GRAMOPHONE COMPANY,

Respondents-Complainants.

Brief on Behalf of Respondents-Complainants.

INJUNCTION PROCEEDINGS.

HORACE PETTIT,

Counsel for Respondents-Complainants,

604 Stephen Girard Building, Philadelphia, Pa.

International, 236 Chestnut Street.

INDEX OF SUBJECTS AS CONSECUTIVELY CONSIDERED IN BRIEF.

	Page
Statement of the Case	1
Re Contempt Proceedings	4
The Widely Known Victor Talking Machine	7
Re Doctrine Laid Down in Siemens v. Sellers	8, 75, 96
Re Record in American Graphophone Co. Case	9
Re the Record in This Case	13
The Complainants' Exhibits, Defendant's Machines and Records Admitted	18
Infringement Not Denied	18
The Matter in Suit	19
The Art Prior to Berliner's Invention Briefly Reviewed	20
The Patent in Suit	24
Cut of Fig. 3, Berliner Patent in Suit	27
Cut of Fig. 10, Berliner U. S. Patent No. 564,586	31
Re Pending Application for Berliner Patent, No. 564,586	32
Consideration of Claims 5 and 35, and Infringement Involved, by Complainants' Expert	33
The Commercial Uses of the Invention	38
Berliner Commercial Records always made in Hard Indestructible Material	39
A Most Delicate Instrument	40
Prior to the Advent of Mr. Berliner in the field, it had not been discovered that a vibrating Stylus Pulsated under the Impulse of Sound Waves, could be automatically propelled by a record groove by contact with One of the Side Walls of the Record Groove, without Destroying, or Impairing, the sound vibrations of the Stylus Point. Mr. Berliner was the first to discover this Fact and to Invent a Method and a Machine and Record of a New and Peculiar Character for Accomplishing the Result	41
Berliner Gramophone in Suit Distinct Departure	41
A Brief History of the Invention in Suit	42
Prior to this Invention of Mr. Berliner, of November, 1887, no method existed for reproducing sound simultaneously Vibrating and Propelling the Stylus Point Across face of the Record through the Medium of the Record Groove alone, and without the aid of any Auxiliary Feeding Mechanism. The Fact also Remains that no Talking Machine Apparatus existed Prior to Mr. Berliner's Invention of November, 1887, such as claimed in Claim 35 Applied to any Class of Record	46
The Great Commercial Success of the Berliner Gramophone in Suit	46
The Validity of the Scope of Claims 5 and 35 Sustained in the Former Litigation	47
Re Validity	47
Victor Talking Machine Company and United States Gramophone Company v. American Graphophone Co. (140 Fed. Rep. 860).	48

Page

Same case on Appeal (145 Fed. Rep. 350) 48
Victor Talking Machine Co. and United States Gramophone Co. v. Hoschke et al. (158 Fed. Rep. 309) 51
Victor Talking Machine Co. et al. v. Douglas Phonograph Co..... 52
Victor Talking Machine Co. et al. v. The Fair (118 Fed. Rep.. 609 and 123 Fed. Rep. 424) 53
Victor Talking Machine Co. et al. v. Shaffer & Salm 53
Victor Talking Machine Co. et al. v. Vim Co. et al..... 54
Victor Talking Machine Co. et al. v. Bentel 54
Victor Talking Machine Co. et al. v. The Keen Co..... 54
Victor Talking Machine Co. et al. v. Poppenberg et al..... 55
Victor Talking Machine Co. et al. v. Bearwald 55
Victor Talking Machine Co. et al. v. Futernik 56
Re Defences in American Graphophone Co. Case 56
Re Defences of the Present Defendant 58
In passing it should be noted that the Defendant has comparatively recently come into the Field and copied Complainants' Machines and Records since the Complainants have made a great Success, and World-wide Reputation, in the manufacture and Sale of their Talking Machines, and Records, the Subject-matter of the Suit, and without any Pretence or Excuse, except the alleged invalidity of the Patent 58-59
In all these various Defences raised by Defendants, there is not a single Invention of another Prior Inventor Produced which was not in the Graphophone Case 59
There is no new Prior Art Produced 59
There is no alleged Anticipation 59
The Alleged New Defence rests entirely upon the Consideration of Certain Strained Technicalities Regarding the Alleged Effect of Certain other Patents to Mr. Berliner upon the Claims 5 and 35 of the Patent in Suit 59
Defences to this Motion Considered 60
The Relation of Berliner's Earlier U. S. Patents to his Subsequent Patent No. 534,543, in Suit Containing the Basic Claims 5 and 35 60
Re Berliner U. S. Patents, 372,786 and 382,790 62
The Taking out of a Prior Patent for a Certain Method and Apparatus does not Preclude the same Inventor from Subsequently Applying for and Patenting a Basic Method and Apparatus Relative to the same Art, and Differing Materially from that of the first Patent 64
The Method of Claim Five, and the Apparatus of Claim Thirty-five, subsequent to the Invention of 372,786, which made his Gramophone a World-Wide Success, is due to the Invention of Mr. Berliner 65
Counsel for Defendant, without any Plausible, or Logical reason, and without the Addition of any Substantial Light contends that certain unwarranted and Illogical Limitations should be placed upon these Claims 5 and 35 65

Page

All Defences in the Graphophone Suit Regarded as Res Adjudicata by the U. S. Circuit Court of Appeals, and not again Considered by it in the Present Suit. Only the Defences Considered Below Should be Reviewed by this Honorable Court 67

Suess U. S. Patent No. 427,279, issued May 6, 1890, was filed August 6, 1889, etc..... 69

Mr. Berliner's Acts were entirely consistent 69

Mr. Berliner, therefore, Having Filed this Application with this Invention Described and Illustrated in it, had a perfect right to Assume that he was protected, and that he might safely make such disclosures as he did make in the "Electrical World," and in the Franklin Institute Lecture 70

Re Attempt to Misconstrue the Patent in Suit 70

But even Supposing that the Invention of the Patent in Suit was an Improvement on the Construction shown in the Berliner Prio Patent, No. 372,786, this Fact in no Manner affects, under the Circumstances, the Scope of Claims 5 and 35 71

Re Defendant's Contention that 5 and 35 are for Specific Constructions of Reproducers shown in Figs. 6 and 7 73

As hereinbefore pointed out, the Suess Canadian Patent was granted for a Term of Eighteen years, etc..... 75

Re Question of Applicability of Siemens v. Sellers (123 U. S. 276). 75

As hereinbefore pointed out it had not been discovered prior to Berliner's invention in suit that a vibrating stylus pulsating under the Impulses of sound waves, could be automatically propelled by a record groove by contact with the side walls of the groove, without destroying or impairing the sound vibrations imparted to the stylus point 75

The present invention was a great improvement over what Berliner had previously invented, as shown in the old patent 372,786, but this in no manner detracted from the basic character of the improvement, or from the scope of claims 5 and 35 77

Suess did not invent this; this fact was decided by Judge Hazel, and by the Circuit Court of Appeals, in the Graphophone case, and the fact that some broader claim than those of the Suess U. S. patent may have crept into the Suess Canadian patent, cannot in any manner affect the fact that Berliner was the inventor 77

Berliner Patent No. 372,786, No Bearing on the Case 77

The Prior Foreign Patents referred to Can Have No Effect on Term of Patent in Suit 78

It is admitted * * * that Fig. 10 and the description thereof of U. S. Patent, 564,586, is entirely omitted from the Berliner British patent 15,232 79

A Misleading Statement of Defendant 80

Re Defendant's Point 1 83

Complainants' Contention Re German Patent No. 53,622 and French Patent No. 207,090 85

Page

Drawings of German Patent to Berliner No. 53,622, November 20, 1889 87
The Claim of the German Patent 53,622 88
Re Berliner French Patent, No. 207,090, of July 19, 1890, for Sound Box 89
Drawings Berliner French Patent 90
It is Apparent that Berliner Regarded the Specific Sound Box of the German Patent, No. 53,622, and French Patent, No. 207,090, as Quite a Different Invention from the Invention, the Subject Matter of the U. S. Patent, No. 534,543, in Suit 92
Defendant's Contention Based on a False Premise 94
Defendant contends that a patenting in a foreign country of part or detail of an invention contained in a U. S. patent prior to U. S. patent, forfeits the whole U. S. patent at expiration of foreign patent 94
Consideration of the Authorities 96
Siemens et al. v. Sellers et al., 123 U. S. 276 96
Defendant's Counsel Appears to Rest his Whole Contention in this Connection not upon the Spirit of the Decision of Siemens v Sellers, but upon a Misconstruction of a short Sentence by Justice Bradley, viz., "a Patent cannot be Construed as Running Partly from one Date and Partly from another" 97
Under the Laws of the U. S. the Failure of some of the claims does not Invalidate the Entire Patent 100
This, therefore, places the claims of the U. S. patent regarding validity, or invalidity, by reason of the expiration of a prior foreign patent, upon the same basis as the declaration of a Court as to the invalidity of one, or more, claims of a U. S. patent, by reason of proof of ANTICIPATION of such claims. Under the laws of this country, the remaining claims unanticipated continue to exist for the term of seventeen years from the date of the patent 100
The intent of the Act is that the prior patenting abroad shall not debar a person from receiving a patent in this country; the statute so specifically states; and starts out with that statement 100
Therefore * * * the main invention of a domestic patent cannot be invalidated, under our system of claims, because a detailed minor specific part may have been previously patented abroad. 101
Considered Further 101
Considered in Another Light 102
Authorities re Reasonable Doubt 104
Defendant's Contention That the Patenting of a Minor Detail in a Foreign Country Previous to the Patenting of the Broad Generic Invention in the United States Forfeits the United States Patent as a Whole, is Contrary to the Letter and Spirit of Sec. 4887 104
What is THE INVENTION of the Patent in Suit? 104
Re Invalidating Certain Claims, and Not Others 105

INDEX (Continued).

Page

Not one case has been cited by the defendant where the substantial invention of the patent has been declared forfeited by reason of the prior patenting in a foreign country of a minor detail. 107
Authorities 107
Additional Authorities Considered 108
Western Electric Co. v. Citizens' Tel. Co., 106 Fed. Rep. 215.... 108
Commercial Mfg. Co. v. Fairbank Canning Co., 135 U. S. 176... 110
Clark v. Wilson, 28 Fed. Rep. 95 110
Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co., 33 Fed. Rep. 254 111
Accumulator Co. v. Julien Electric Co., 57 Fed. Rep. 605. 112
J. L. Mott Iron Works v. Henry Co., 80 Fed. Rep. 516... 112
Williams Co. v. Miller Co., 108 Fed. Rep. 967..... 113
Aquarama Co. v. Old Mill Co., 124 Fed. Rep. 229..... 113
Sawyer Spindle Co. v. Carpenter (Circuit Court), 133 Fed. Rep. 238 114
Sawyer Spindle Co. v. Carpenter (Court of Appeals), 143 Fed. Rep. 976 114
Westinghouse v. Stanley Co., 138 Fed. Rep. 823 117
If the *Principal* Invention of the Subsequent United States Patent is not described or claimed in the prior foreign patent the Principal Invention cannot forfeit 118
Bate Refrigerator Co. v. Sulzberger, 157 U. S. 1 122
Electric Accumulator Co. v. Brush, 52 Fed. Rep. 130 122
Alleged German and French Patents to Berliner, not properly Proven by Defendant 122
Re Point Two 125
All References to Claims 5 and 35 Omitted from Foreign Patents and Invention Covered thereby 126
Re Claim 9, of British Patent No. 15,232, of 1887 130
Re So-called Modified Form 131
Further Consideration of Points Raised in Defendant's Brief on Point ~~Two~~ Three 134
Re Miller v. Eagle Mfg. Co..... 135
Re Testimony of R. M. Hunter 138
Re Nature of the Defences 144
Re Point Three 146
Re Alleged Prior Public Use 146
Decree, Circuit Court of Appeals, Graphophone Case 147
At the Time of the Alleged Public Uses Berliner had Pending an Application for Patent, Filed November 7, 1887, Embodying and Disclosing the Invention in Suit 149
Authorities 151
No Extension of the Term of the Patent in Suit 158
The Demonstration at the Franklin Institute Lecture, did not Constitute a "Public Use" 159
The Franklin Institute Lecture of May 16, 1888 161
A Test before a Scientific Body 163
Re Authorities 165

Page

Authorities re Experimental Use 166
If the nature of the invention is such as to require test and demonstration before others, such a use before the invention is put on sale, is not a public use, within the meaning of the Statute. 168
Robinson on Patents, re Experimental Use 172
Authorities 172, 173
Am. & Eng. Enc. of Law, 2nd Ed., Vol. 22, p. 338, re Experimental Use 173
Full Evidence of the Experimental Character of the Use 175
Re Alleged Prior Public use in Mr. Berliner's Bedroom 177
Point Four 178
The Suess-Canadian Patent Considered 178
The fact that Berliner subsequently applied for and secured his Canadian Patent No. 55,079, for his invention in suit, containing Claims 5 and 35, corresponding in all material respects in drawings, specifications and claims to the patent in suit, No. 534,543, is further conclusive evidence that Berliner did not consider that the Suess Canadian Patent contained his invention of the patent in suit, otherwise he would not have subsequently patented it in Canada, as he did 184
Point Five 185
Berliner had long previously placed himself indisputably upon record as the inventor of claims 5 and 35 and was so recognized by the scientific public. The great scientific institute, the Franklin Institute, recognized his invention and honored him with an invitation to address the society upon the subject in May, 1888 188
The Berliner Canadian Patent for the Invention in Suit filed December 7, 1895 189
The Court in the Graphophone Case has passed upon the question of ABANDONMENT and decided that there was none; as herein shown, there is no evidence whatsoever upon which to base any different decision 189
Re Alleged New Evidence that the Apparatus of Fig. 10. of the Berliner Patent No. 564,586, was impracticable 189
Point Six 192
No matter how broad the Suess Canadian Patent may be the term of 18 years for which it was granted has not expired, and the Berliner Patent in suit could not be affected 193
This Suess Canadian Patent was granted "for the period of eighteen years from the date of these presents," as appears upon its face. Record, p. 156, fol. 467 193
Authorities re Definiteness of Term of Foreign Patent upon which the term of the United States Patent is Dependent under Section 4887 194
Diamond Match Co. v. Adirondack Match Co. et al., 65 Fed. Rep. 803 194
Pohl et al. v. Anchor Brewing Co., 134 U. S., p. 381 195
Quotation from opinion of Judge Townsend in Pohl et al. v. Anchor Brewing Co..... 196, 197

Page

Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co., 21 Fed. Rep. 458 197
Consolidated Roller Mill Co. v. Walker, 43 Fed. Rep. 575 197
Welsbach Light Co. v. Apollo Incandescent Light Co. et al., 96 Fed. Rep. 332 198
Paillard et al. v. Bruno, 29 Fed. Rep. 864 199
Bate Refrigerating Co. v. Gillette, 31 Fed. Rep. 809 202
Edison E. Co. v. Electric E. S. Co., 60 Fed. Rep. 400 202
Bonsack Machine Co. v. Smith, 70 Fed. Rep. 383 203
Point Seven 213
Re Edison British Patent, No. 1644, of 1878 214
Point Eight 218
This Alleged Defense (Bell & Tainter Patent, No. 341,214) not urged in the Circuit Court of Appeals, and not Assigned as an Error in the Circuit Court 219
The Defense that Claims 5 and 35 are Anticipated by the Bell & Tainter Patent 221
Figs. 1 and 2, Bell & Tainter Patent No. 341,214 222
Cut of Fig. 8, Bell & Tainter Patent, No. 341,214 225
The Little Joint 32 is only Applicable to Machines which have an Auxiliary Feed Screw, where a Slight Variance may Occur between the Pitch of the Feed Screw and the Pitch of the Record Groove 229
The Small Auxiliary Joint 32 could have no useful Purpose or Function to perform in Complainants' Machine 229
Material Difference in the Action of the Stylus of the Berliner and the Bell & Tainter Machines 230
Diagrammatic Views Illustrating Difference in the Action of the Stylus in the Bell & Tainter and Berliner Machines 231
Mr. Cameron's Contention 233
Re Claims 19 to 23 of Bell & Tainter Patent 234
Re American Graphophone Co. v. Leeds 236
Conclusion re Bell & Tainter 238
Berliner's Radical Departure 240
Bell & Tainter Improved upon Edison, but Berliner departed from both their methods and apparatus, and struck out on radically different lines 241
Re Point Nine 245
Claim Five Involves Clearly a Patentable Process 247
Authorities re Patentability of Method 253
Re the Telephone Cases 254
Claim 35 clearly covers a patentable apparatus comprising mechanical elements essentially necessary to make up the complete patented mechanical combination 263
Re Point Ten 265
Point Eleven 265
Point Twelve 266
Defendant's Proofs of Foreign Patents Incomplete 267
Points Thirteen and Fourteen 268

Page

Defendant Contends that the Patent in Suit was not Fairly in Controversy in the Graphophone Case 269
Defendant's Contention the Sale of records is not Infringement 272
Re Talk-O-Phone with so-called "Mechanical Feed" 274
Defendant's Attempt to have "Mechanical Feed" Machine adjudicated 276
The Record is an Element of the Combination of Claim 35 and the Reproducing Apparatus is Another Element 276
Authorities 278
Thomson-Houston Electric Co. v. Ohio Brass Co., 80 Fed. Rep. 712 278
Re Defendant's Affidavits 281
Affidavit of Harry Ensign 281
Re Defendant's Affidavit of Albert T. Irish 282
Defendant's Affidavit of Edward F. Leeds (No. 1) 285
Defendant's Affidavit of Edward F. Leeds (No. 2) 285
Re Defendant's Affidavit of Harry T. Goss 286
Re Schedule "A" (R., p. 304) 287
Re Joseph Lyons' Testimony 291
Re Complainants' Title 292
The Granting of a Preliminary Injunction is within the *Discretion* of the Circuit Court. If *Discretion* not Improvidently Exercised, Injunction should Stand 294
Duplex Printing Press Co. v. Campbell Printing Press & Mfg. Co., 69 Fed. Rep. 250 294
Ritter v. Ulman et al., 78 Fed. Rep. 222 295
Garrett et al. v. T. H. Garrett & Co., 78 Fed. Rep. 472 295
Blount v. Societe Anonyme Du Filtre Chamberland Systeme Pasteur et al., 53 Fed. Rep. 98 296
Paris Medicine Co. v. W. H. Hill Co. et al., 102 Fed. Rep. 148 296
The Defendant's Acts 297
Conclusion 299
Opinion of Judge Hazel, U. S. Circuit Court, Victor Talking Machine Co. et al. v. American Graphophone Co., 140 Fed. Rep., p. 860 301
Opinion of Judges Lacombe, Townsend and Coxe, Circuit Court of Appeals, Victor Talking Machine Co. et al. v. American Graphophone Co., 145 Fed. Rep. 351 311
Opinion of Judge Townsend, U. S. Circuit Court, Victor Talking Machine Co. et al. v. Talk-O-Phone Co., and same v. Leeds & Catlin Co., 146 Fed. Rep., p. 534 313
Opinion of Judge Lacombe (Contempt Proceedings), U. S. Circuit Court, Victor Talking Machine Co. et al. v. Leeds & Catlin Co. (Contempt case), 150 Fed. Rep., p. 147 323
Opinion of Judge Hough (Contempt Proceedings), U. S. Circuit Court of Appeals, Leeds & Catlin Co. v. Victor Talking Machine Co. et al. (Writ of Error), 154 Fed. Rep., p. 58 325
Opinion of Judge Hough, U. S. Circuit Court, Victor Talking Machine Co. et al. v. Hoschke et al., 158 Fed. Rep. 309 334

INDEX OF SUBJECTS CONSIDERED IN BRIEF, ALPHABETICALLY ARRANGED.

A.

Page

American Graphophone case—Transcript of Record considered in this case 9
American Graphophone Company case (Circuit Court, 140 Fed. Rep. 860) 48
American Graphophone Company case—Appeal (145 Fed. Rep. 350) 48
American Graphophone Company case—Defences 56
American Graphophone Company case—No invention of another prior inventor produced in the present case in the American Graphophone case 59
American Graphophone Company case—Decree considered 147
Anticipation—No alleged anticipation in present case, not in American Graphophone case 59
Art prior to Berliner's invention briefly reviewed 20
Attempt to misconstrue claims of patent in suit 70
Alleged abandonment, re 185
American Graphophone Company v. Leeds, considered 236
Authorities re effect of prior foreign patents 96, 97, 100, 101, 102
Authorities—All reasonable doubt in favor of patentee 104
Authorities following the doctrine of Siemens v. Sellers 107
Authorities—Re substantial present invention must be in prior foreign patents 107, 122
Authorities re public use 151
Authorities re experimental use 165, 175
Authorities relative to term of foreign prior patent 194, 203
Authorities re patentability of method 253
Accumulator Company v. Julien Electric Company (57 Fed. Rep. 605) 112, 107
Alves v. U. S. (75 U. S. 337) 12
Aquarama Company v. Old Mill Company (124 Fed. Rep. 333) 113, 107
Am. & E. Enc. of L. (2nd Ed., vol. 22, 338 and 340) ... 152, 161, 173
Am. & E. Enc. of L. (vol. 22, 384) 203
American Bell Telephone Company v. Dolbear (15 Fed. Rep. 448 256
American Fibre Chamois v. Buckskin Fibre Company (72 Fed. Rep. 508) 259
American Graphophone Company v. Leeds et al. (87 Fed. Rep. 874) 236, 217, 237, 238, 280
American Graphophone Company v. The National Gramophone Company (92 Fed. Rep. 365) 237
American Graphophone Company v. Amet (74 Fed. Rep. 789)... 280
American Graphophone Company v. Hawthorne et al. (92 Fed. Rep. 516) 280
Bate Refrigerating Company v. Gillette (31 Fed. Rep. 809). 202, 203
Bate Refrigerator Company v. Schulzberger (157 U. S. 1) 122
Bell v. Bruen (42 U. S. 169) 12
Bell v. Daniels (3 Fed. Cases, case No. 6771) 153

INDEX (Continued).

Page

Bement v. National Harrow Company (186 U. S. 90) 280
Blount v. Societe Anonyme Du Filtre Chamberland Systeme Pasteur et al. (53 Fed. Rep. 98) 296
Bonsack Machine Company v. Smith (70 Fed. Rep. 383), 203, 204, 209. 210, 211
Brown Cork & Seal Company v. Aluminum Stopper Company (108 Fed. Rep. 850) 104
Carlton v. Bokee (17 Wall, 463-472) 101
Carr v. Fife (156 U. S. 494) 12
Celluloid Manufacturing Company v. Zylonite Brush & Comb Company (27 Fed. Rep. 291-294) 102
Chisholm et al. v. Johnson (106 Fed. Rep. 191) 262
Chisholm v. Randolph Canning Company and Chisholm et al. v. Canastota Canning Company (135 Fed. Rep. 815-816) 263
Clark v. Wilson (28 Fed. Rep. 95) 110
Cochran v. Deener (94 U. S. 780) 258, 260, 261
Commercial Manufacturing Company v. Fairbank Canning Company (135 U. S. 176) 110, 116, 117, 119, 121
Consolidated Roller Mill Company v. Walker (43 Fed. Rep. 575) 197
Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U. S. 405 12
Corning v. Burden (56 U. S. 15 How. 250) 256, 257
Dayton Fan & Motor Co. v. Westinghouse Electric Mfg. Co. (118 Fed. Rep. 562) 263
Diamond Match Co. v. Adirondack Match Co. et al. (65 Fed. Rep. 803) 194, 203, 206, 211
Doyle v. Continental Ins. Co. (94 U. S. 535) 270
Duplex Printing Press Co. v. Campbell Printing Press Mfg. Co. (69 Fed. Rep. 250) 204
Eames v. Andrews (122 U. S. 40) 263
Eastern Paper Bag Co. v. Standard Bag Co. (30 Fed. Rep. 62). 173
Edison E. Co. v. Electric E. S. Co. (60 Fed. Rep. 400, 404)..... 202
Edison v. American Mutoscope Co. (110 Fed. Rep. 662) 155
Egbert v. Lippman (104 U. S. 333)..... 169
Electric Accumulator Co. v. Brush Electric Co. (52 Fed. Rep. 130) 122, 107
Elizabeth v. Pavement Company (97 U. S. 134), 166, 167, 169, 170, 175
Emery v. Cavanagh (17 Fed. Rep. 242) 173
Ennis v. Oil City Boiler Works (22 Fed. Rep. 780) 174
Ex parte Livingston (Commissioner of Patents' decisions of 1881, p. 42) 157
First National Bank Kentucky (76 U. S. 355) 12
Gage v. Herring (107 U. S. 640-646) 101
Guaranty Company v. Green Cove Rd. Co. (129 U. S. 137) 270
Garrett et al. v. T. H. Garrett & Co. (78 Fed. Rep. 472) 295
Godfrey v. Eames (68 U. S. 317) 156

Page

Graham v. Geneva L. C. M. Co. (11 Fed. Rep. 138) 174
Graham v. McCormich et al. (11 Fed. Rep. 859) 154, 155, 168
Gramme Electric Company v. Arnoux (17 Fed. Rep. 838) 209
Hake v. Brown (37 Fed. Rep. 783) 260
Harmon et al. v. Struthers et al. (57 Fed. Rep. 637) 173
Harriman v. Northern Securities Company (197 U. S. 284) 266
Hayes Young Tile Plate Co. v. St. L. Transit Co. (137 Fed. Rep. 80) 154
Henry v. Francestown Soapstone Stove Co. (2 Ban and A. 221 and 11 Fed. case No. 6382) 153
Henry v. Providence Tool Company (3 B. & A. 501) 200
Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co. (21 Fed. Rep. 458) 197, 200, 202
Holmes Electric Protective Company v. Metropolitan Burglar Alarm Co. (33 Fed. Rep. 254) 111
Howe v. Newton (12 Fed. cases, case No. 6771) 153
Hutch v. Moffit (15 Fed. Rep. 253) 257
Insurance Co. v. Morse (20 Wall, 445) 270
Insurance Company v. Sellers (8 Sup. Ct. Rep. 117) 111
International Tooth Crown Company v. Richmond et al. (30 Fed. Rep. 775) 152
Kirchberger v. American Acetylene Burner Company (124 Fed. Rep. 764) 261
Leggett v. Standard Oil Company (149 U. S. 287-293) 101
Lyman v. Maypole (19 Fed. Rep. 735) 172, 174
Mast F. & Co. v. Stover Mfg. Co. (177 U. S. 495) 267
McCormick v. Seymour (2 Blatchf. 256) 104
McKay v. Jackson (12 Fed. Rep. 615) 257
McMillen v. St. Louis & Miss. Valley Transp. Co. (18 Fed. Rep. 260) 270
Melvin v. Potter (91 Fed. Rep. 151) 257, 259
Miller v. Eagle Mfg. Co. (151 U. S. 186) 135, 114
Mott Iron Works v. Henry Company (80 Fed. Rep. 516) 112
Mowry v. Whitney (81 U. S. 14 Wall, 620) 258
New York Filter Company v. Jackson (91 Fed. Rep. 422) 280
O'Reilly v. Morse (56 U. S. 15 How. 62) 255, 257
Oval Company v. Sandy Company (60 Fed. Rep. 295) 113
Paillard et al. v. Bruno (29 Fed. Rep. 864) 199, 202, 203, 210
Paris Medicine Co. v. W. H. Hill Co. et al. (102 Fed. Rep. 148). 296
Pitt v. Hall (2 Blatchf. 238) 104
Pohl et al. v. Anchor Brewing Co. (134 U. S. 381), 195, 196, 197, 201, 202, 203, 204, 210
Pohl et al. v. Heyman and same v. F. & M. Shaefer Brewing Co. (58 Fed. Rep. 203 and 268) 196, 201
Railway Register Mfg. Co. v. Broadway Co. (22 Fed. Rep. 655). 174
Rassau v. Brown (21 Appeal Cases, District of Columbia, 73) 124, 268

Page

Red Jacket Mfg. Co. v. Davis (82 Fed. Rep. 432) 280
Reissner v. Sharp (16 Blatchf. 383) 200
Risdon Iron and Locomotive Works v. Medart (158 U. S. 65) 258, 260
Ritter v. Ulman et al. (78 Fed. Rep. 222) 295
Robinson on Patents (vol. 1, sec. 355) 161, 172, 173
Robinson on Patents (vol. 2, sec. 623) 107, 151
Robinson on Patents (paragraph 580, note 4) 151
Rogers v. Ritter (79 U. S. 317) 12
Russell v. Place (94 U. S. 606-609) 102
Sawyer Spindle Co. v. Carpenter (133 Fed. Rep. 976) 114, 106
Sawyer Spindle Co. v. Carpenter, Appeal Court (143 Fed. Rep. 976) 114
Shaw v. Cooper (32 U. S. 292) 169
Siemens et al. v. Sellers et al. (123 Fed. Rep. 276), 96, 8, 75, 76, 97, 105, 107, 109, 111, 116, 117, 118, 121
Sinclair v. Backus (5 Ban & A. 81, 1880) 166
Smith v. Goodyear Dental Vulcanite Co. et al. (93 U. S. 486) .155, 156
Smith & Griggs Mfg. Co. v. Sprague (123 U. S. 249) 173, 175
Sprague v. Smith & Griggs Mfg. Co. (128 Fed. Rep. 721), 173, 174, 175
Stearns v. Phillips (43 Fed. Rep. 792) 280
Stirling Company v. St. Louis Brewing Assn. (79 Fed. Rep. 80). 152
Telephone cases (126 U. S. 1) 254, 261
Thomson-Houston Electric Co. v. Kelsey (75 Fed. Rep. 1005)... 280
Thomson-Houston Electric Company v. Ohio Brass Co. (80 Fed. Rep. 712) 279
Thomson-Houston Electric Co. v. Lorain Steel Co. (110 Fed. Rep. 654) 167
Tilghman v. Proctor (102 U. S. 708) 258
Topliff v. Topliff (145 U. S. 156) 12
Tubular Rivet & Spud Co. v. O'Brien (93 Fed. Rep. 200) 280
Trolley Stand 280
U. S. v. American Bell Telephone Co. (167 U. S. 224) 12, 220
U. S. v. Bell Telephone Co. (167 U. S. 224) 292
United Nickle Co. v. California Electric Works (25 Fed. Rep. 475-479) 101
Victor Talking Machine Company et al. v. American Graphophone Company (Dist. of Connecticut) (118 Fed. Rep. 50).. 293
Victor Talking Machine Co et al. v. American Graphophone Co. (140 Fed. Rep. 860) 48
Same case on appeal (145 Fed. Rep. 350) 48
Victor Talking Machine Co. v. Hoschke et al. (158 Fed. Rep. 309) 51
Victor Talking Machine Co. v. The Fair (118 Fed. Rep. 609 and 125 Fed. Rep. 424) 53
Wallace v. Holmes (29 Fed. case No. 79) 280
Walker on Patents (4th Ed., p. 84) 155

Page

Walker on Patents (4th Ed., sec. 95) 166
Walker on Patents (sec. 95, etc.) 167
Walker on Patents (sec. 96) 168
Walker on Patents (sec. 108, 4th ed.) 104
Walker on Patents 201
Welsbach Light Co. v. Apollo Incandescent Light Co. et al. (96 Fed. Rep. 332) 198, 203
Welsbach Light Co. v. Rex Incandescent Co. (94 Fed. Rep. 1006) 93, 107
Western Electric Co. v. Citizens' Tel. Co. (106 Fed. Rep. 215).. 108
Westinghouse Electric Co. v. Dayton Fan & Motor Co. (106 Fed. Rep. 724) 280
Westinghouse Electric Co. v. Citizens' Tel. Co. (106 Fed. Rep. 215) 208
Westinghouse v. Stanley Improvement Co. (138 Fed. Rep. 623) 117, 97, 105, 107, 116
Williams Co. v. Miller Co. (108 Fed. Rep. 967) 113
Wilson v. McNamee (102 U. S. 572) 12
Wood v. Wiemar (104 U. S. 786) 12

B.

Brief history of invention in suit 42
Berliner U. S. patent 564,586 pending when 534,543 filed 32
Berliner Commercial Records always made in hard indestructible material 39
Berliner Instrument a most delicate one 40
Berliner Invention in suit—prior to his invention the methods and apparatus of reproducing sound radically different 41
Berliner Gramophone a distinct departure 41, 46
Bentel, Victor v. 54
Bearwald, Victor v. 55
Berliner's Earlier U. S. patents—their relation to the patent in suit. 60
Berliner's U. S. patents 372,786, 372,790 considered 62
Berliner's invention in suit subsequent to the invention of Berliner patent 372,786 a world-wide success 65
Berliner's Acts Entirely Consistent 69
Berliner's Present Invention Protected before the Patent Office from the time of filing November 8, 1887, his application for 564,586 70
Berliner's Invention involving automatic propulsion and free stylus vibration without impairing sound reproduction 75
Berliner's U. S. patent 372,786 for different invention 77
Berliner's German patent No. 53,622 considered 85, 87, 88, 92
Berliner's French patent No. 207,090 considered 85, 89, 90, 92
British patent No. 15,232 of 1887—re claim 9 130
Berliner U. S. patent No. 564,586—invention of claims 5 and 35 embodied in this case filed November 7, 1887 149

Page

Berliner patent in suit—no extension of the term 158
Berliner recognized as the inventor by the scientific public in 1887-1888 188
Berliner Canadian patent No. 55,079 of February 24, 1897, filed December 7, 1895, corresponding to patent in suit 189
Bell & Tainter patent No. 341,214 considered ..... 218 to 241
Berliner's radical departure considered 240
Dr. Bell's testimony forming Schedule A attached to Goss affidavit considered ..... 287 to 290

C.

Contempt proceedings considered 4
Claims 5 and 35 of patent in suit considered 33
Commercial uses of the invention 38
Commercial success of the Berliner Gramophone in suit 46
Claims 5 and 35 not affected by prior Berliner U. S. patents 71
Claims 5 and 35—the invention of these claims expressly omitted from all prior foreign patents 126
Cameron's contention—expert in Graphophone case re Bell & Tainter patent 233
Conclusion 300

D.

Defendant's machines and records—infringement not denied 18
Douglas Phonograph Company—Victor v. 52
Defenses in American Graphophone Company case 56
Defenses in the present case 58
Re defense that a U. S. patent expires under Section 4887 with the expiration of a prior foreign patent where the invention described and claimed in a prior foreign patent was claimed in the U. S. patent, even though the U. S. patent contains claims for the broad principal invention which was not described or claimed in the prior foreign patent 83
Re defenses that the Berliner patent No. 534,543 expired with the Berliner British patent No. 15,232 of 1887 and German patent No. 45,048 and French patent No. 186,827 125
Re defense of alleged prior public use at Berliner's Franklin Institute Lecture of May 16, 1888, and in Mr. Berliner's bedroom at Union Square Hotel, New York.....146, 177
Re defense that by reason of the issues of the Suess Canadian patent No. 49,101 of February 11, 1893, to Berliner, that Berliner is now estopped from claiming that claims 5 and 35 in suit cover the broad principle of Berliner's invention contended for 178
Re Defenses that the Berliner Suess Canadian patent proves abandonment by Berliner of the invention now claimed 185

Page

Re defense that Berliner patent No. 534,543 expired before suit brought with the expiration of the six-year term of the Suess Canadian patent when it lapsed by reason of failure to pay the renewal fees 192
Re defense that claims 5 and 35 are anticipated by the Edison British patent No. 1644 of 1878 213
Re defense that claims 5 and 35 of the patent in suit were anticipated by the Bell & Tainter patent No. 341,214, of May 4, 1886 218
Re defense that claims 5 and 35 are for the function of a machine and are not valid 245
Re defense that claim 35 is unintelligible 265
Re defense that defendant's machines do not infringe claims 5 and 35 if they be construed as limited with reference to the Suess Canadian patent 265
Re defense that the bill should be dismissed by this court if the defenses raised are valid 266
Re defense concerning limitation of Berliner-Suess Canadian patent by lapsing of Suess French patent admitted by defendant not available to be considered in the petition for certiorari 268
Defendant's bald infringement 58, 59
Defenses—the alleged new defenses based on strained technicalities regarding certain other Berliner patents 59
Defenses to this motion considered 60
Defenses—re limitations on claims 5 and 35 unwarranted and illegal 65
Defenses substantially all the defenses regarding alleged anticipation, etc., decided in the Graphophone case and not before the court in the present case 67
Defenses—only defenses considered in court below should be reviewed by this Honorable Court 67
Defendant's Point One 83
Defendant's contention re foreign patents based on false premises.. 94
Defendant's Proofs of Foreign Patents Incomplete 267
Defenses—Defendants have not cited a single case where the substantial invention of the patent is forfeited by reason of prior patenting abroad of minor details 107
Defenses—nature of 144
Defendant's affidavits 281, 287
Discretion of the court below in granting preliminary injunction not improvidently exercised 294, 297
Defendant's acts 297
Decision of Judge Hazel, U. S. Circuit Court—Graphophone Case.. 301
Decision of Court of Appeals—Graphophone case 311
Decision of Judge Townsend, U. S. C. C., present suit 313
Decision of Judge Lacombe (Contempt Proceedings, U. S. C. C.).. 323
Decision of Court of Appeals (Contempt proceedings) 325
Decision of Judge Hough, U. S. C. C. (Hoschke case) 334

E.

Page

Experimental use—authorities 165
Edison British patent No. 1644 of 1878 considered 214
Ensign affidavit considered 281

F.

Fig. 3 of patent in suit illustrated 27
Fig. 10 of British patent 564,586 31
Former litigation 47
Fair, Victor v. (118 Fed. Rep. 609 and 123 Fed. Rep. 424) 53
Futernik, Victor Company v. 54
Figs. 6 and 7 of patent in suit 73
Foreign prior patents to Berliner can have no effect on term of claims in suit 78
Fig. 10 of 564,586 and description not patented abroad in Berliner prior patents 79
French Berliner patent 207,090 ..... 85, 89 90, 92
Foreign patents—re Berliner prior foreign patents—legally considered 96, 203
French and German patents not properly proven..... 122
Franklin Institute Lecture—did not constitute public use 159
Fig. 10 not impracticable but very practical 189

G.

German patent to Berliner No. 53,622 ..... 85, 87, 88, 92
German and French patents not properly proven 122
Goss affidavit considered 286

H.

Hoschke et al., Victor Company v. (58 Fed. Rep. 309) 41, 334
Hunter, R. M.—testimony in Graphophone case considered 138

I.

Infringement not denied 18
Illustrations—Fig. 3 of patent in suit 27
Fig. 10 31
Figs. 1 and 2, of Bell & Tainter U. S. Patent No. 341,214 222
Fig. 8, of Bell & Tainter U. S. Patent No. 341,214.... 225
Diagrammatic views Figs. 1 and 2, illustrating differences in action of the stylus in the Bell & Tainter and Berliner machines 231
Berliner German patent No. 53,622 87
Berliner French patent No. 207,090 90
Infringement considered 33, 58, 59
Invention—What is the invention of the patent in suit? 104
Invalidating certain claims and not others—considered 105
Irish affidavit considered 282

K.

Page

Keen Company, Victor Company v. 54

L.

Leeds affidavit No. 1 considered 285
Leeds affidavit No. 2 considered 285
Lyons testimony considered in Graphophone case 291

M.

Matter in suit 19
Misleading statement of defendant 80
Minor detail—Previous patenting of minor detail cannot affect broad invention not included ..... 104, etc.
Miller v. Eagle Mfg. Company considered 135
"Mechanical Feed"—so-called attempt to adjudicate 276

P.

Prior art briefly reviewed 20
Patent in suit 24
Poppenberg et al., Victor Company v. 55
Prior art—no new prior art in present case 58
Prior patents—the obtaining of earlier patent for particular method of device does not effect a subsequent patent for new basic method and apparatus 64
Patent in suit—attempt to misconstrue claims 70
Point One—re effect of previously patenting abroad a minor detail and not the principal invention of the subsequent U. S. patent 83
Point Two—re effect of certain prior Foreign Patents 125
Point Three—re alleged Public Prior Use 146
Point Four—re alleged Estoppel 178
Point Five—Berliner never abandoned directly or indirectly his claim for this invention 185
Point Six—Suess Canadian patent is for term of eighteen years and has not expired 92, 203
Point Seven—re alleged anticipation by Edison British Patent No. 1644 of 1878 213
Point Eight—re alleged anticipation by Bell and Tainter patent 341,214 ..... 218 to 241
Point Nine—that claims 5 and 35 are for a function of the machine ..... L ..... 245 to 265
Point Ten—that claim 35 is unintelligible 265
Point Eleven—contention that defendant's machines do not infringe if claims 5 and 35 are to be restricted 265
Point Twelve—bills should be dismissed if the defenses are valid defenses 266
Points Thirteen and Fourteen—Re Suess French patent—defendant admits in petition are not available here 268

Page

Patent in suit not fairly in controversy in Graphophone case—defendant contends 269
Prior public use—alleged—considered 146
Public use—authorities 151
Prior public use alleged in Mr. Berliner's bedroom 177
Preliminary injunction—granting of, within *discretion* of the court below—not improvidently exercised 294

R.

Record in this case considered 12
Records—defendant contends sale of, not infringement 272
Record is an important element of the combination..... 276 to 278

S.

Statement of case 1
Siemens v. Sellers (123 U. S. 76) considered 8, 75, 96, 97
Scope of claims 5 and 35 sustained 47
Salm & Shafer, Victor Company v. 53
Success of the Victor Company 58, 59, 65
Suess U. S. patent No. 427,279 considered 69
Scope of claims 5 and 35 not affected by prior Berliner U. S. Patents 70
Specific construction of reproducers shown in Figs. 6 and 7..... 73
Suess Canadian patent for eighteen years 75
Suess invented a minor improvement of specific construction 77
Suess Canadian patent considered 77, 177, 178, 184
Schedule A 287

T.

Telephone cases considered 254
Title of complainants considered 292

V.

Victor Talking Machine Company—its wide reputation..... 7
Validity of claims 5 and 35 sustained 47
Validity considered 47
Victor Talking Machine Co. et al. v. American Graphophone Co. (Circuit Court, 140 Fed. Rep. 860) 48, 301
Victor Talking Machine Co. et al. v. same, on appeal (145 Fed. Rep. 350) 48, 311
Victor Talking Machine Co. et al. v. Hoschke et al. (158 Fed. Rep. 309) 41, 334
Victor Talking Machine Co. et al. v. Douglas Phonograph Co..... 52
Victor Talking Machine Co. et al. v. The Fair 53

V.

	Page
Victor Talking Machine Co. et al. v. Shafer and Salm	53
Victor Talking Machine Co. et al. v. Vim Company et al.	54
Victor Talking Machine Co. et al. v. Bentel	54
Victor Talking Machine Co. et al. v. The Keen Company	54
Victor Talking Machine Co. et al. v. Poppenberg et al.	55
Victor Talking Machine Co. et al. v. Bearwald	55
Victor Talking Machine Co. et al. v. Futernik	56
Vim Company et al., Victor Company v.	54

THE END.

FOREWORD.

Since this brief was printed, and about to be filed, complainant's counsel received a copy of the Petitioner-Defendant's brief forwarded by the Clerk of the Court. It is noted that the Petitioner-Defendant has not observed the same chronological order in numbering its Points as obtained in its petition on *certiorari*, and it therefore becomes necessary to change in red ink the number of the Points printed herein, as complainant's counsel in the preparation of this brief had followed the numerical order of the Points followed by the Petitioner-Defendant in its petition for *certiorari*. The Points of argument considered by the defendant, however, in its present brief are substantially the same as those heretofore urged by it, though the same order of presentation was not observed.

Counsel for Petitioner-Defendant premises his brief with a statement outlining his defences and referring to Mr. Berliner's domestic and foreign patents, in answer to which the attention of the Court is called to the statement contained in complainant's brief, pages 1 to 24; in relation to the history of Mr. Berliner's invention the attention of the Court is called to complainant's brief, pages 19 to 24. and 60 to 78

Re Defendant's Point One:

This point is considered in complainant's brief at Pages 245 to 265.

Re Defendant's Point Two:

This point is considered in complainant's brief at Page 265.

Re Defendant's Point Three:

This point is considered in complainant's brief at Pages 213 to 218.

Re Defendant's Point Four:

This point is considered in complainant's brief at Pages 218 to 244.

Re Defendant's Point Five:

This point while not noted as a separate point in complainant's brief, is considered at Pages 68, 69, 74, 77, 82, 163, 180, 183, 184, 185, 186 and 188.

Re Defendant's Points Six and Seven:

These points are considered in complainant's brief at Pages 83 to 125.

Re Defendant's Point Eight:

This point is considered in complainant's brief at Pages 125 to 146.

Re Defendant's Point Nine:

This point is considered in complainant's brief at Pages 192 to 213.

Re Defendant's Point Ten:

This point is considered in complainant's brief at Pages 146 to 178.

Re Defendant's Point Eleven:

This point is considered at Pages 178 to 192.

Re Defendant's Point Twelve:

This point is considered at Pages 73 to 78.

Re Defendant's Point Thirteen:

This point is considered in complainant's brief at Pages 83 to 125; Pages 125 to 146, and Pages 192 to 213.

Re Defendant's Point Fourteen:

This point is a general point of alleged want of equity, briefly considered in complainant's brief, Pages 297 to 299.

IN THE

Supreme Court of the United States.

October Term, 1908. No. 80.

Suit on Berliner U. S. Patent, No. 534,543.

LEEDS & CATLIN COMPANY,
Petitioner-Defendant,

v.

VICTOR TALKING MACHINE COMPANY AND UNITED STATES GRAMOPHONE COMPANY,
Respondents-Complainants.

BRIEF ON BEHALF OF RESPONDENTS-COMPLAINANTS.

INJUNCTION PROCEEDINGS.

STATEMENT OF THE CASE.

This case comes before this Honorable Court upon writ of *certiorari*, granted May 27, 1907, upon Petition of the petitioner-defendant, filed May 13, 1907, the said *certiorari* being directed to the United States Circuit Court of Appeals for the Second Circuit, which Court, by decree filed October 22, 1906 (Transcript of Record, p. 546, fol. 1638), affirmed the decree of the United States Circuit Court, for the Southern District of New York, of May 2, 1906, granting preliminary in-

junction in accordance with the prayer of the Bill of Complaint, filed by the complainants to restrain the defendant from infringing their Letters Patent, No. 534,543, as to claims 5 and 35, issued to Emile Berliner, February 19, 1895, for Improvement in Gramophone.

Before proceeding further with the statement of the case, it will be here noted that there were two similar suits, in equity, brought at the same time for infringement of said patent, one against the Leeds & Catlin Co., the petitioner-defendant herein, and the other against the Talk-O-Phone Company, a corporation organized and existing under the laws of the State of Ohio, having an office in New York City, N. Y., both of which suits were prosecuted together, substantially the same testimony being in each case, each of the defendants being represented by the same counsel, and both cases heard together in the U. S. Circuit Court, for the Southern District of New York, and on appeal in the U. S. Circuit Court of Appeals, for the Second Circuit. As shown by the record in this case, each of the said defendants, the Talk-O-Phone Co. and the Leeds & Catlin Co. sold talking machines and sound records similar to the complainants' patented machines and records, and for the purpose of these motions for preliminary injunction, this fact was admitted by the defendant's counsel in each case.

The Talk-O-Phone Co., the defendant in the other, or sister suit, was principally a manufacturer of talking machines, and the Leeds & Catlin Co., the present Petitioner-Defendant, was principally a manufacturer of sound records to be used in connection with said machines, though, as before stated, this defendant sold said machines as well. While the affidavit of E. F. Leeds (R., p. 312), denies that any business connection existed between the Leeds & Catlin Co. and the

Talk-O-Phone Co. at the date of his affidavit, April 13, 1906, yet it is apparent from his affidavit that a short time prior to suit brought, the Leeds & Catlin Co. sold records to the Talk-O-Phone Co. for its machines, and also that the Leeds & Catlin Co. purchased some Talk-O-Phone machines from it. Mr. Leeds also admits (R., p. 313, fol. 938), that he was elected President of the Talk-O-Phone Co., but shortly after resigned. The affidavits of Albert L. Irish (R., pp. 309-311, and R., pp. 283-289), while denying any then present connection between the Talk-O-Phone Co. and the Leeds & Catlin Co. at the date of the affidavit, shows that there were business relations between the two companies relative to the manufacture and sale of the infringing machines and records respectively. It will also be noted that all these affidavits in the record of this case against the Leeds & Catlin Co. are entitled as well in the Talk-O-Phone case.

These facts were more fully set forth in the affidavit of R. L. Thomae, in behalf of complainants, in the Talk-O-Phone case, but as that case was not appealed Mr. Thomae's affidavit was not brought before this Court.

These explanations are necessary in order that this Honorable Court may understand why the affidavits in this case are entitled in both cases, and why the Talk-O-Phone Co. is so conspicuously and frequently referred to in the said affidavits. The Talk-O-Phone Co., however, did not file any petition for *certiorari* to this Court, notwithstanding the injunction decree similar to the injunction decree against the Leeds & Catlin Co. was entered against it at the same time as against the Leeds & Catlin Co., apparently being satisfied that the decree of the Circuit Court of Appeals could not be reversed.

Further, since the writ of *certiorari* has been granted in this case, a final decree by consent was en-

tered by the U. S. Circuit Court, for the Southern District of New York, against the said Talk-O-Phone Company, May 4, 1908, and writ of final injunction issued upon the said consent decree May 6, 1908.

The Leeds & Catlin Co., however, continued to prosecute this said appeal, with the affidavits entitled in both cases incorporated in the Transcript of Record.

RE CONTEMPT PROCEEDINGS.

The appeal in the **contempt** proceedings against Leeds & Catlin Co. is considered in a separate brief (Case No. 81, of October Term, 1908), the Petition for *certiorari* having been granted also in that branch of this suit against the said Leeds & Catlin Co. for infringement of this patent here in suit, No. 534,543.

Judge Lacombe in the Circuit Court, found this defendant in **contempt of court** for violating the writ of preliminary injunction entered in this suit, and imposed a fine of $1000.00, one-half to the United States, and one-half to the complainants (see decision of Judge Lacombe, Contempt R. p. 74), the decree of Judge Lacombe upon writ of error to the U. S. Circuit Court of Appeals for the Second Circuit was duly affirmed in an opinion of Judge Hough, Judge Coxe concurring—Judge Wallace dissenting (Contempt R., p. 90, etc.).

The defendant's contempt consisted after the service of the writ of preliminary injunction, in continuing to manufacture and sell disc talking machine records, identically the same as the defendant had theretofore made and sold, the said records being intended for the same uses and purposes, viz.: for use in the combination of claim 35, in accordance with the method of claim 5, of the Berliner Patent, No. 534,543, in suit, for reproducing sound from said records. It was shown in these contempt proceedings that defendant

sold the said contempt records to enable owners of the sound reproducers purchased from complainant, or its licensees, to reproduce sound recorded on the said records, instead of records made by the complainants. Both the Circuit Court and the Circuit Court of Appeals held that the continued manufacture and sale by the defendant of the contempt records clearly established contributory infringement, as the said records were an essential element of the combination of claim 35, and were made and sold by the defendant to be used with the other element of the combination of that claim, viz., with a reproducing stylus shaped for engagement with the said record and so mounted as to be free to be vibrated and propelled by the record, and in accordance with the method of claim 5.

The collection of the fine was suspended pending the writ of error upon proper security being entered. The writ of injunction was also stayed pending appeal, security in the sum of $10,000 being required to be entered (See Contempt R., pp. 76-77). The amount of this security manifestly contemplated only the usual appeal period to the U. S. Circuit Court of Appeals, and manifestly did not contemplate the much longer period of appeal to the Supreme Court of the United States, which was a matter of grace and not of right, so that the defendant has been enabled to continue the said infringement since March 11, 1907, the date of the said Order in the contempt proceedings, and is, and has been continuing to sell the said records for the same purpose in contributory infringement in large quantities since the said date, as well as previously thereto, with very insufficient security to these complainants should the decrees of the Court below be affirmed by this Honorable Court. The previous bond required by Judge Townsend, at the time of the original injunction in the Circuit Court, May 2, 1906 (Injunction R., p. 330), was not more than sufficient, if

sufficient, to cover the infringement pending the appeal from the decree of the Circuit Court, in the injunction proceedings to the date of the decision of the Circuit Court of Appeals, of October 12, 1906.

As complainants' counsel has not seen or had any opportunity to examine defendant's brief to be filed in this Honorable Court, no reference herein can be made by pages to defendant's brief. It is assumed, however, that substantially the same points of defense raised by the defendant in its Petition for *certiorari* will be followed, and also substantially the same points of defense as presented in the Court below, we will, therefore, herein refer, from time to time, to the defendant's points, defenses and statements as contained in the said petition for *certiorari,* and as contained in defendant's brief in the Court below, a copy of which is attached to defendant's petition for *certiorari,* it being understood that this Honorable Court in consideration of these matters will have before it, not only defendant's brief on appeal prepared specially for this hearing, but also the said petition for *certiorari,* with defendant's brief below attached thereto.

An index of subjects treated has been carefully prepared so that this Honorable Court may readily find any particular subject treated, especially in view of the somewhat extended length of this brief, rendered necessary in order to meet the numerous subjects and alleged defenses which the defendant has heretofore presented in the courts below, and others, which it is assumed the defendant's counsel may treat of in his brief, and attempt to have this Court consider, many of which, as hereinafter pointed out, we submit should not come before this Court for review, for the reasons hereinafter pointed out. In the event that this Honorable Court should consider all the various de-

fenses which may be raised by the defendant, it has been decreed expedient, in order that the complainants' position may be fully presented before this Court on all points, to treat herein all possible points which the defendant might attempt to raise in its untiring effort to defeat the claims of the patent in suit in order that the defendant, and others, who are anxiously watching the outcome of this decision, may continue the manufacture and sale of the complainants' patented talking machines and records.

The Widely Known Victor Talking Machine.

The Berliner Patent, No. 534,543, here in suit (R., p. 452), is the main basic foundation patent upon which the Victor Talking Machine and records of world-wide reputation and fame are constructed, under claims 5 and 35, and has been several times sustained by the U. S. Circuit Court and the U. S. Circuit Court of Appeals, for the Second Circuit, as hereinafter particularly noted.

Claims 5 and 35, of the patent in suit, read as follows:

> "5. The method of reproducing sounds from a record of the same which consists in vibrating a stylus and propelling the same along the record by and in accordance with the said record, substantially as described.
>
> "35. In a sound reproducing apparatus consisting of a traveling tablet having a sound record formed thereon and a reproducing stylus shaped for engagement with said record and free to be vibrated and propelled by the same, substantially as described."

While the petitioner-defendant will doubtless urge upon this Court numerous alleged defences which have been heretofore fully and thoroughly considered and

passed upon by the U. S. Circuit Court and U. S. Circuit Court of Appeals favorably to the patent relative to the question of alleged anticipation, and alleged prior public use, etc., yet the main defence upon which this petitioner-defendant relied in the petition for *certiorari,* and in the Circuit Court and in the United States Circuit Court of Appeals, was the effect of certain prior foreign patents granted to the said Berliner, the patentee of the patent in suit, prior to the issue of the United States patent, in suit. As to these defences, both the Circuit Court and the Circuit Court of Appeals in these cases, held that the invention of claims 5 and 35, of the Berliner Patent, in suit, had not been patented in any foreign patent prior to the date of the patent in suit, and did not come under that portion of Section 4887, of the Revised Statutes, affecting the term of the U. S. patent.

Re Doctrine laid down in Siemens v. Sellers.

The petitioner-defendant's petition for the writ of *certiorari* was mainly based upon, the contention that the doctrine laid down by this Honorable Court in the case of Siemens *v.* Sellers, 123 U. S. 276, applied to this case. The Court of Appeals, for the Second Circuit, as well as the U. S. Circuit Court, held that the doctrine laid down in that case did not apply to the facts of the present case. The petitioner-defendant's main contention in this present case at this time is, in substance, that if Mr. Berliner, the patentee of the patent in suit, patented abroad, prior to the issue of the United States patent, any feature, or element described or claimed in any of the claims of the said United States patent, no matter if the same were for minor and unimportant constructions, and not the **broad, principal invention** of claims five and thirty-five here in suit, that the United States patent would

expire as to all of its claims with the expiration of the foreign patent having the shortest term to run, notwithstanding the fact that the broad invention, claimed in claims five and thirty-five of the patent in suit, and other features of invention claimed in other portions of the patent in suit, were not described, or claimed, or patented in the said prior foreign patent, or patents.

This Honorable Court doubtless took cognizance of this present case by granting the petition for *certiorari* in order to settle any question, as to any such misinterpretation or misconstruction of the doctrine laid down by this Honorable Court in the said case of Siemens *v.* Sellers, 123 U. S., p. 276.

As hereinbefore noted, the petitioner-defendant will doubtless also raise, as defences, various alleged anticipations and questions of alleged prior public use, which defences were not technically before the Circuit Court or Court of Appeals in this present cause, and which defences those courts refused to consider, and which we submit should not be subject here to review. If this Court should find that the *discretion* exercised by the Court below in granting the motion for preliminary injunction was not improvidently exercised, or that the discretion was not abused, the decree of the Court below should stand, as hereinafter more fully considered. We feel confident that this Honorable Court will coincide and agree with the findings and rulings of the U. S. Circuit Court of Appeals for the Second Circuit, as well as the U. S. Circuit Court of that Circuit in the said matters.

Re Record in American Graphophone Case.

It is respectfully submitted, and strenuously urged, on behalf of complainants, that while the record in the American Graphophone case was before the Cir-

cuit Court, and Circuit Court of Appeals, in this case, and should be referred to at this hearing in order that an intelligible understanding may be had of the history of the invention, and of the litigation upon this patent, and of the defences made in the Graphophone case, as hereinafter stated, yet, it is respectfully submitted that the defences in the Graphophone case should not be re-considered or reviewed by this Honorable Court in this appeal, as the Court of Appeals in this case, as well as the Circuit Court, did not consider any of the said defenses made in the American Graphophone case. They were regarded as *res adjudicata*. As these defenses in the American Graphophone case were not considered or reviewed as defences by the Court of Appeals in the present case those defenses should not be reviewed by this Honorable Court upon appeal in this case.

The only matter, the subject of review by this Honorable Court, it is submitted is the defence which was considered and was before the Circuit Court of Appeals in this case.

In this connection, the attention of this Honorable Court is called to the decision of Judge Townsend, in this case, in the Circuit Court (R. pp. 318-327). Attention is also called to the affirmance of the Court of Appeals of the decree entered pursuant to Judge Townsend's decision, and to the oral decision of the Circuit Court of Appeals, affirming the decree of Judge Townsend, which is printed on pages 41-46 of defendant's petition for writ of *certiorari*. It will be here observed that in the decision of Judge Townsend, he stated (R. p. 318, fol. 953):

> "The Circuit Court for the Southern District of New York, in the suit of this complainant against the American Graphophone Company, after an exhaustive discussion of the issues pre-

> sented sustained said claims and its decree was affirmed by the Court of Appeals, of March 1st, 1906, after elaborate argument by able counsel and upon voluminous briefs in which apparently every material defence was presented and discussed."

Judge Townsend then proceeded (R. p. 319, fol. 955), to consider the "twelve defenses claimed either to consist of new matter not before the Court on the former hearing, or to relate to matters which, while in the record at the former hearing were not considered or discussed." The Court then considers the alleged new matter. As to the alleged new defenses regarding the Edison British Patent, No. 1644, of 1878, before the Court, in the Graphophone case, Judge Townsend said:

> "The defenses founded on the prior Edison Patent will not be discussed because said patent was before the Court in the original suit (the Graphophone suit). (R. p. 327, fol. 979.)

Regarding the alleged new defense as to certain contract between the parties, Judge Townsend said that this was "not deserving of notice," and that "the contract and the relations of the parties were fully before the Court and the record and briefs in the said case are a sufficient answer to any such contention" (referring to the Graphophone case), (R. p. 327, fol. 979).

The oral decision of the Circuit Court of Appeals affirming Judge Townsend in the present case, printed at pages 41 to 46, of defendant's petition for *certiorari*, shows that the only defenses considered at all were the alleged *new* defenses as to the effect of Berliner's prior foreign patents upon the term of the patent in suit.

The only defenses, therefore, which this Court

should review in this case are the alleged *new defenses* raised by the defendant in this case, and such as were not before the Court in the American Graphophone case.

In this connection we would cite a few authorities to the effect that questions not passed upon by the lower Court, cannot be reviewed in this Court.

Bell *v.* Bruen, 42 U. S. 169;
Alveso *v.* U. S., 75 U. S. 337;
First National Bank Kentucky, 76 U. S. 355;
Rogers *v.* Ritter, 79 U. S. 317;
Wilson *v.* McNamee, 102 U. S. 572;
Wood *v.* Wiemar, 104 U. S. 786;
Topliff *v.* Topliff, 145 U. S. 156;
Carr *v.* Fife, 156 U. S. 494;
U. S. *v.* American Bell Telephone Co., 167 U. S. 224.

While we will hereinafter refer to the said American Graphophone Co. record, as is necessary in order that this Honorable Court may have an intelligent understanding of the defenses in that case, which were considered *res adjudicata,* and which the Court of Appeals in this case, as well as the Court below refused to consider, it is referred to herein **without in any way waiving the said objections** to a review in this case of the defenses in the American Graphophone case, and **without in any manner waiving the point heretofore made.**

Further as to questions of fact upon which both of the lower courts concurred the findings will not be disturbed unless clearly wrong. Continental Paper Bag Co. *v.* Eastern Paper Bag Co., 210 U. S., 405.

The Record in This Case.

It will be noted that the motion for preliminary injunction in this case, as also in the Talk-O-Phone case, was filed March 24, 1906, a rule to show cause having been granted that day returnable April 6, 1906.

This motion for preliminary injunction was, therefore, **promptly and diligently** made immediately following the decision of the U. S. Circuit Court of Appeals, for the Second Circuit, in the suit of these complainants against the American Graphophone Co. on sustaining this same Berliner Patent, No. 534,543, here in suit as to the claims five and thirty-five, now in controversy.

The motion for preliminary injunction in this present case was made before Judge Townsend (R. p. 318), who was one of the Judges composing the Circuit Court of Appeals, for the Second Circuit, which decided the appeal in the said suit against the American Graphophone Co. (R. p. 373). Judge Townsend was not only thoroughly familiar with the record, and all the defences raised in the said suit against the American Graphophone Co., but it was agreed between counsel for the respective parties in this case, both at the hearing of the motion for preliminary injunction of this case before Judge Townsend, and upon the argument of the appeal in the U. S. Circuit Court of Appeals, that the appeal Transcript of Record in the said suit against the American Graphophone Co., should be referred to at the said hearings of this case. This is apparent, from the complainant's and defendant's affidavits, such as Hicks' affidavit (R., p. 78 and 89, etc.), and Hicks' affidavit No. 2 (R., pp. 218-219), and defendant's affidavit of Goss (R., p. 298, etc.), as well as by complainant's affidavits—(see Kennedy affidavit, R., pp. 55-61, and Middleton's affidavit, p. 51), that this record in the American Graphophone case should be before your

Honors as it was before the Court below, in order to intelligently consider the record in this case, and particularly the affidavits referred to not as evidence in this case to be here reviewed, **but to show what the defences were in that case**, and which the courts in the present case refused to consider as before the Court below. The decision of Judge Hazel in the Graphophone case in the Circuit Court, and the decision of the U. S. Circuit Court of Appeals affirming Judge Hazel (see R. p. 63 and R. p. 373), show that the courts below in this case referred to the Graphophone Record to show what defences had been considered in that case which defences would not be considered as defences in this present case.

The attention of the Court is called, among other things in this connection, to the fact that Mr. Hicks, defendant's counsel, in his affidavit at R. pp. 77-80, refers to this Transcript of Record in the American Graphophone case, and to matter therein contained, and states, among other things (R. p. 80, fol. 240):

> "I beg leave to refer to the Exhibits filed in the said suit between the Victor Company, *et al.* and the American Graphophone Company * * *"

It is also clear from the affidavit of Mr. Harry T. Goss (R., pp. 297-303), that he had the record in the American Graphophone case before him, and that his criticism of it could not be intelligently considered by this Honorable Court without the same advantage of the presence of that record.

Mr. Hicks also in his affidavit of June 8, 1905, (R. pp. 216-220), criticises a certain agreement in evidence in the Graphophone case, and the *bona fide* prosecution of that case, and it is, we submit, incumbent that the record of that case should be before the Court, as it was used as an exhibit before the Circuit Court, and

Circuit Court of Appeals in the hearings of this case before, in order that the Court may fairly and intelligently review the decision of the lower Courts.

In this connection the attention of this Honorable Court is called to the opening paragraph of Judge Townsend's opinion in this Leeds & Catlin case (R. p. 318), where he states:

> "The bills allege infringement of claims 5 and 35 of the Berliner Patent, No. 534,543. The Circuit Court for the Southern District of New York in the suit of this complainant against the American Graphophone Company, after an exhaustive discussion of the issues presented sustained said claims and its decree was affirmed by the Court of Appeals on March 1st, 1906, after elaborate argument by able counsel and upon voluminous briefs in which apparently every material defence was presented and discussed.
>
> "The case on this motion is presented by some five hundred pages of affidavits and briefs; 'Defendants' Exhibit Letters Patent' is a book of some 135 pages.
>
> "It appears that the machines of these defendants are practically identical with those found to infringe in the former suit. These defendants, however, have set up twelve defences claimed either to consist of new matter not before the Court on the former hearing, or to relate to matters which, while in the record at the former hearing were not considered or discussed."

It is, therefore respectfully submitted that this Court should have that record, as had the Circuit Court and Circuit Court of Appeals, in considering the motion for preliminary injunction, and in reviewing their decisions.

The complainants in the Courts below consequently only argued the alleged new defences not presented in the American Graphophone case, such as noted by

Judge Townsend in the opening paragraphs of his opinion in this case above quoted in his decision granting the preliminary injunction—(see R., p. 318). There was no necessity to meet any of the defences which were not defences in this case.

A copy of the said Transcript of Record in the U. S. Circuit Court of Appeals in the suit of these complainants against the American Graphophone Co. will be presented to this Court at the hearing, for the purposes noted, in considering this appeal.

The petitioner-defendant will hereinafter be referred to as the defendant and the respondents-complainants will hereinafter be referred to as the complainants.

We will now consider the facts relative to the issue, in detail.

This case comes before this Honorable Court upon appeal from decree granting preliminary injunction for alleged infringement of claims five and thirty-five of Letters Patent No. 534,543, issued February 19, 1895, to Emile Berliner, for Improvements in the Method of and Apparatus for Recording and Reproducing Sounds. These claims five and thirty-five of the Berliner patent No. 534,543, in suit, were adjudicated by the U. S. Court of Appeals, for the Second Circuit, in a decision rendered March 1, 1906, affirming the decision of the Circuit Court filed by Judge Hazel, September 28, 1905, in the case of these complainants against the American Graphophone Company, in Equity, No. 8627 (140 Fed. Rep., p. 860). This latter case was hotly contested, and the defendant put in evidence all the material prior art. A copy of the decision of said Court of Appeals, and of the decision of Judge Hazel, in that case is printed in the record (Transcript of Record, pp. 63 to 74). (140 Fed. Rep., p. 860, and 145 Fed. Rep., p. 350). A petition for rehearing and leave to amend decree was

filed by the defendant, the American Graphophone Company, in said Court of Appeals in April, 1906, after the motion for preliminary injunction in the present case had been argued, but before decision rendered. The petition for rehearing was based upon the alleged new evidence produced in these cases, which petition and leave to amend was refused by said Honorable Court. (See 145 Fed. Rep., p. 351.)

On account of the complainants' showing regarding the financial conditions of the Leeds & Catlin Co. and of the Talk-O-Phone Co., Judge Townsend, in staying the writ pending appeal, required each of the defendants to enter a bond of $10,000 to indemnify the complainants for damages and profits accruing during the period of the stay (Transcript of Record, p. 330), and in the Talk-O-Phone case the amount of the bond was subsequently increased to $25,000.

As the defendants in the Court of Appeals have filed a very voluminous brief, covering some 200 pages of printed matter; though many of the points raised by the defendants should require little or no consideration, yet it has been deemed proper to explain to this Honorable Court all the defendants' points, whether trivial, or apparently immaterial, so that there may be no misunderstanding, in the event that this Honorable Court should see fit to consider any of defendant's points which we consider should not be here reviewed as matters within the *discretion* of the Court below, etc. This has, therefore, rendered it necessary to make this brief much fuller than otherwise would have been the case, contrary to the desire of counsel for respondents.

In view of the defendant's unwarranted attack upon Mr. Berliner, and the well recognized fact of his having been the inventor of the gramophone or "Victor" talking machine in suit, there is also herein in-

cluded a brief statement of the history of Mr. Berliner's invention in this art, as shown by the record, dating back to November, 1887, and, in fact, back to the date of his application for his first patent No. 372,786, for his earliest device, filed May 4, 1887, though the invention in suit practically dates from the early part of November, 1887. A brief resume of the relation of Berliner's invention in suit to the prior phonograph and graphophone is also considered, together with a careful review of the patent in suit, so that the Court may have these facts quite fully before it, especially in view of the strenuous effort of defendants' counsel to becloud and minimize the importance of the invention in suit.

The Complainants' Exhibits, Defendant's Machines and Records Admitted.

For the purposes of these motions, the defendant admits the sale of machines and records offered by the complainants, and marked in each case as exhibits, Complainants' Exhibit, Defendant's Machine and Defendant's Record.

Infringement Not Denied.

The defendant does not deny the infringement, (unless a different construction should be given to the claims from that heretofore given to them by the various Courts which have passed upon them). The machines and records of the defendant produced as exhibits are identical, from a patent standpoint, with the defendants' machines and records in the suit against the American Graphophone Company, as shown by the affidavit of H. C. Kennedy on behalf of the complainants (R., p. 59, Fol. 177, and R., p. 61, Fol. 181).

THE MATTER IN SUIT.

The subject matter of the claims of the patent involved in this suit is the method and apparatus of *reproducing* sound, after a record of the same has been made, and involves a consideration of one of the most marvelous classes of inventions of the latter part of the nineteenth century. The subject is not an intricate, or difficult one, but necessarily requires the careful consideration of the nice and most delicate operations of the method based upon scientific principles, carried out through the medium of scientifically invented and constructed devices. It involves the consideration of the phenomena of sound reproducing through the medium of these methods and devices, which makes it possible to reproduce at will the human voice, grand opera, orchestrations, and, in fact, any, and all, sound uttered, almost perfectly, with the tones and notes of the original utterances. In comparing the sound reproducing devices and methods of this art, the differences in the methods followed, and in the construction and organization of the devices employed, as the one set of methods and apparatus advanced beyond the other, in the steps of progress and in perfection in the art, until the Berliner invention in suit, must be fully understood, and appreciated, in order to arrive at an intelligent and correct judgment.

The Victor Talking Machine Company, as shown by the record, is the exclusive licensee of the said patented invention, under license from the United States Gramophone Company. The title to the patent in suit is admitted, and not disputed.

The subject matter of the present suit is the talking machine, widely known as the "*Gramophone,*" invented by Emile Berliner about November, 1887, which is distinguished from the two other types of talking machines, in existence prior to the Berliner invention, and

known as the "*Phonograph,*" being the Edison machine, and the "*Graphophone,*" invented by Messrs. Bell & Tainter.

The Art Prior to Berliner's Invention Briefly Reviewed.

At the date of Mr. Berliner's invention of the gramophone, about November 7, 1887, as before stated, the only other *commercial* talking machines known were the Edison Phonograph, and the Bell & Tainter Graphophone, the latter being owned by the American Graphophone Company. (See R., p. 74—carrying Berliner's date back to the filing date of Berliner patent No. 564,586 (R., p. 466) before this Court in reviewing the decisions which were based in part upon that record.

The Edison phonograph, which had been invented, as long ago as 1877 or 1878 (see Edison patent, R. p. 335), comprised essentially an *indented sound record* formed on the periphery of a cylinder, or tablet, of wax-like material—sometimes covered with tin foil, in the earlier machines—the indented record extending in spiral, or helical, form on the face of the cylinder, or tablet. In the earlier Edison patents, such as Edison British patent of 1878, No. 1644 (Record, p. 472, etc.), this indented record is shown as formed on the surface of both a disc and a cylinder, though the Edison commercial machines used only cylinders for their records, such as shown, for instance, in the Edison United States patents, No. 227,679 (R. 346), and No. 200,521 (R. p. 334). The character of the indenting sound groove of the Edison phonograph was such as to require, in the reproducing machine, a construction whereby the stylus, or reproducing point, in order to be maintained in constant rubbing contact with the rotating record groove, should be *positively propelled* across the face of the record cylinder, or tablet, by special *mechanical auxiliary means,* such as a *positive feed*

screw, or auxiliary means provided for positively traveling, longitudinally, the record tablet past the stylus point of the reproducer, when it was held in a fixed position. (See decision of Judge Hazel in American Graphophone case, R. bottom of pp. 65-66, etc.).

The Bell & Tainter Graphophone (R. p. 387), existing at the date of the Berliner invention of the patent in suit, comprised essentially a cylinder, or disc, of soft wax-like material, having a record groove of *varying depth,* in the nature of *hills and valleys, cut* in the soft wax-like material, as contradistinguished from being *indented* by an indenting point, such as in the Edison phonograph. The character of the graphophone record groove, in which many of the apices of the vertical undulations, or hills, were practically on a level with the upper surface of the tablet, was such as to necessarily require positive mechanical means in the reproducing machines for keeping the stylus point, as it rubbed over the vertical undulations, or over the hills and valleys, in constant rubbing connection, and proper relation with the record groove. This was so as to positively feed the reproducing stylus point across the face of the cylinder, or tablet, as it revolved, and on the spiral record groove wound its way, and thus to keep the stylus point always in the groove and on the record proper. The Bell & Tainter Graphophone is shown in "Defendant's Exhibit, Bell & Tainter Patent, No. 341,214" (R. p. 387). In the illustration, the record tablet on which the vertically undulating sound grooves are cut in spiral form is a revolving disc, as shown particularly in Figs. 1, 2, 12 and 14 of the Bell & Tainter patent, in which case the record tablet, instead of the stylus point, is constructed and arranged to travel, while the stylus point holds a relatively fixed position, the record tablet at the same time rotating upon its axis. (See Judge Hazel's decision R., p. 66, etc.)

Another form of the graphophone which more

nearly resembles the commercial Graphophone, which has the vertically undulating record formed upon a wax-like cylinder, is shown in "Defendant's Exhibit, Tainter Patent, No. 341,288." (R. p. 399.)

The commercial form of the Edison Phonograph having an indented record provided upon a cylinder of wax-like material, is illustrated in "Edison Patent No. 227,679" (Rec., p. 346) and "Edison Patent No. 200,-521" (Rec., p. 334).

The Edison phonograph for reproducing sound from an indented **tin foil** record, and the Bell & Tainter graphophone for reproducing sound from a cut wax record of varying depth, cut or engraved in wax-like material, having the vertical undulations therein, represented the prior art at the time Mr. Berliner entered the field in 1887.

While the Edison phonograph, and the Bell & Tainter graphophone, had distinctive features of difference, yet they more nearly resembled each other than they did the Berliner gramophone, which made its advent in 1887. The Edison phonograph, and the Bell & Tainter graphophone were both constructed to reproduce sound from a record of *uneven* depth, vertically undulating, the Bell & Tainter record being a clean *cut* or *engraved* wax record, while the Edison was formed by a series of *indentations*. Both machines were closely allied to each other, the main line of demarkation and improvement by Bell & Tainter over Edison being the vertically undulating groove *cut* or *engraved* in wax-like material by a graver or tool which removed the material from the groove as it cut it, in the form of a shaving, which superseded the *indented* record of Edison.

From the character of the record grooves of both Edison and Bell & Tainter, it was an essential requisite that the reproducing machine should have a **positive**

auxiliary feeding mechanism for traveling the record tablet past the stylus point, or an auxiliary positive feed mechanism for traveling the stylus point over the face of the record tablet as it simultaneously rotated.

In both the Edison and Bell & Tainter machines, the stylus point rested upon the vertically undulating record, or indented record, in the base of the groove, which was of microscopic depth, and carried the weight of the sound box, of which it was a part, as shown in the Bell & Tainter patent, and the Edison patents, just referred to. This, of course, produced a *constant normal pressure upon the centre of the diaphragm* of the sound box, dependent upon the weight of it. The rotating of the vertically undulating record groove beneath the stylus point *vibrated the stylus up and down,* in accordance with the record thereon, which stylus, in turn, pulsated the diaphragm, and set the air in motion behind it, reproducing the recorded sound. The side walls of this class of groove, both in the Edison and in the Bell & Tainter constructions, were naturally unabrupt and poorly defined. At the apex of the vertical undulations, many of which were about on a level with the surface of the tablet, there would, of course, be practically no side wall. In the base, or valley, between the undulations or hills, the extent of the side wall would be varied according to the depth of sound waves recorded. The side walls were also always *sloping,* both in the Edison *indented* form and in the Bell & Tainter *cut* form. It is, therefore, clear that in a practical commercial machine for reproducing from a record of this construction, reproducing stylus must be operatively maintained in connection with record walls *by positive auxiliary means* for either traveling the spiral record past the stylus point, or traveling the stylus point over the face of the spiral record, as it rotated in reproducing sound.

It will be further noted that while the Edison and Bell & Tainter commercial records were all in soft wax-like material, prior to Berliner invention, Mr. Berliner's commercial records were all formed in hard, durable and practically indestructible material.

We do not say that it would be impossible to propel a light stylus point carrying comparatively little weight by a cut vertical wax record of the Bell & Tainter type across the face of the record, as in a toy machine of the Amet construction shown in "Amet Patent, No. 562,-699," in the other suit, which is later than the Berliner invention. We do say, however, that it is impracticable by it to get acoustical results, and further, *it never was done before Berliner's invention.*

THE PATENT IN SUIT.

The patent in suit, No. 534,543, issued February 19, 1895, to Emile Berliner, is contained on page 452 of the Record in this case.

The claims in these suits, which were the claims sustained in the suit against the American Graphophone Company, are claims five and thirty-five, and read as follows:

> "5. A method of reproducing sounds from a record of the same, which consists in vibrating a stylus and propelling the same along the record by and in accordance with the said record, substantially as described."

> "35. In a sound reproducing apparatus consisting of a traveling tablet, having a sound record formed thereon and a reproducing stylus shaped for engagement with said record and free to be vibrated and propelled by the same, substantially as described."

As shown the invention of claims five and thirty-five of Patent 534,543 in suit was invented by Mr. Berliner as early as November, 1887, though the present application for patent was not filed until March 30, 1892. (See *Per Curiam* of the U. S. Circuit Court of Appeals in Graphophone case, 145 Fed. Rep., 350, and attached to this brief.)

The patent in suit, No. 534,543, is for a *gramophone,* and, as stated in the specification, "has reference to improvements in the method of and apparatus for recording and reproducing sounds——"

A large portion of the specification of this patent is devoted to a description of one of Mr. Berliner's methods of recording sound by tracing, upon a fatty film, deposited upon a metallic surface, undulatory lines corresponding to sound waves, and then etching such lines in the metal base, which constitutes the record tablet. He also illustrates in the drawings and fully describes, a recording machine for making the talking machine records in the manner described.

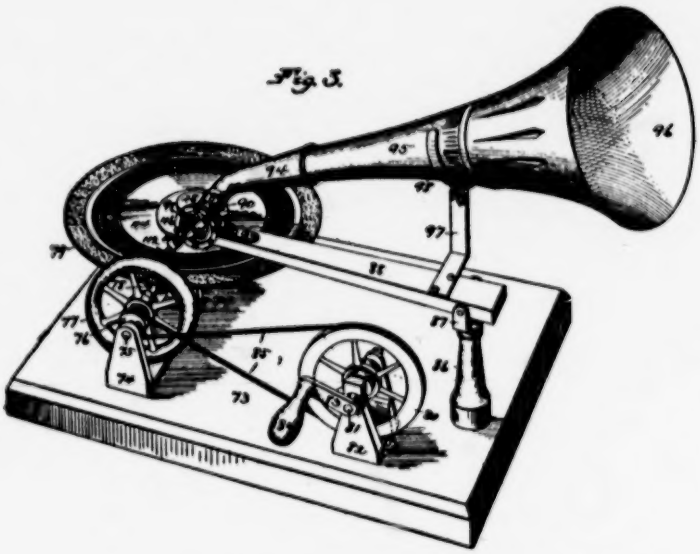
In Fig. 3 of the patent one form of a reproducing machine is illustrated, such as is claimed in claim thirty-five, and operating in accordance with claim five, the details of which are fully described in the specification (specification, p. 4, line 95, to p. 5, line 19).

While no other form of this reproducing apparatus is specifically described in the patent, it is clear that the patentee did not limit himself to that particular form shown in Fig. 3, but merely illustrates it and describes it manifestly as one of the numerous forms which might be used. This is apparent not only from the breadth and scope of claims five and thirty-five, but also from the general description in the specification of the said method and reproducing apparatus. Another, and earlier, construction of machine invented by Mr. Berliner in accordance with these claims is illustrated on

page 31 of this brief, being Fig. 10 of Berliner patent 564,586 (R., p. 465).

It is clear that this reproducing apparatus must have a traveling tablet, with a sound record formed thereon, and a reproducing stylus shaped for engagement with the said record, and free to be vibrated and propelled by the same, it is not essential what means for rotating the tablet is employed; it may be a hand motor, such as shown in Fig. 3, or be operated, by a weight properly governed, as illustrated in the form shown on page ~~27~~ 31 of this brief, which is the construction illustrated and described in Berliner's patent application filed November 7, 1887, which was still pending when the application for the patent in suit was filed; or, very much more preferably, a spring motor might be employed, such as is now used in the commercial machines of the complainants and of the defendant, and shown in "Complainants' Exhibit, Complainants' Machine," and "Complainants' Exhibit, Defendant's Machine." Nor is it essential what gear connecting mechanism is used for traveling the tablet, whether it be a friction gear, such as shown in Fig. 3, or whether it be a train of spur gearing, such as used in the complainants' and defendant's spring motor. *It is also clear that it is not essential as to just how the reproducing stylus shall be suspended, or mounted above the record tablet, the only essential features in this regard being that it shall be so suspended, or mounted, that the stylus point shall at all times be in engagement with the record, and free to be propelled by the record across the face of the tablet as the point is simultaneously being vibrated by the record grooves.*

The specification, p. 4, lines 95 to 127, describes the construction of the particular form of apparatus shown in Fig. 3, as follows:



"The reproducing apparatus as a whole is represented in Fig. 3.

"Upon a base board 73 in standards 74 is journaled a shaft 75, upon which are mounted a driven pulley, 76, a fly wheel, 77, and a friction disc, 78. The latter is in frictional engagement with a rotary tablet, 79, which is mounted upon a vertical shaft substantially in the manner described with reference to the rotary table, 4, of the recording apparatus. Fig. 3 being a perspective view, the mounting of the table, 79, is not visible, but is easily understood from the foregoing description. The upper surface of the table is preferably covered with a sheet of felt or other elastic and non-resonant material, as indicated by appropriate shading.

"Upon the felt-covered table, 79, the record tablet, 44, is placed, and is clamped thereon substantially in the manner in which this is done in the transmitting apparatus, i. e., by means of a clamping plate, 46, and a thumb-nut, 48. A driving wheel, 80, mounted on a shaft, 81, which is journaled in standards, 82, is rotated by means of a crank, 83,

and handle, 84, and gives motion to the tablet, 79, by means of a cross belt or cord, 85. The relation of the table, 79, to the friction disc, 78, is the same as the relation of the table, 4, to the friction disc, 12; that is to say, the table rests with the greater part of its weight upon the friction disc, so that the frictional gearing is automatically maintained."

The patent then describes one particular form of mounting for the sound-box and stylus, as shown in Fig. 3, which in that case consists of a post, 86, mounted upon a baseboard, 73, which has swivelled upon its upper end a fork, 87, between the prongs of which is pivoted the swinging arm, 88, which extends over the tablet, 79, and has at its free end a clasp, 89, which receives the neck, 90, and which projects from the centre on one side of the casing of the reproducing diaphragm, 92. It is then shown how this casing, with its diaphragm, stylus and appurtenances, can be turned in the clasp, and be fixed in any adjusted position by the clamp screw, 93, all of which is detail. The specification then also states that upon the neck, 90, which projects beyond the clasp, 89, is slipped a flexible tube, which in turn receives the small end of a sound-conveying trumpet, 95, the flaring end, 96, of which is turned toward the listener. The specification then describes how the horn may be supported upon the swinging arm, 88, through the medium of a bracket, 97. It also shows that the construction is such that the point of the reproducing stylus will press rather firmly upon the record tablet, for the purpose of keeping it in engagement, to prevent displacement.

This form of swinging arm is, as before stated, one of several forms which might be used for carrying out the method claimed in claim five, and for a reproducer such as claimed in claim thirty-five, though it is obvious that the invention is not limited to the particular de-

tails of construction shown in this form illustrated in Fig. 3.

It is also seen that the *particular specific construction of swinging arm* is nowhere claimed in this patent.

Berliner's invention was broader than this. This form, however, was constructed in accordance with his broad invention, and embodied it, and illustrated the form in which he used his invention at the time of the filing of the application for the patent in suit. He could have added another form, such as shown in Fig. 10 of his application of 1887, then pending, and perhaps other forms, but it was not necessary.

The specification then goes on to state (p. 5, lines 19 to 33) as follows:

> "It will now be understood that when a record tablet, having a record of sound waves upon its surface, produced in accordance with my invention, is mounted upon the table, 79, and when the point of the stylus is adjusted in engagement with the record groove, and the wheel, 80, is rotated, the rotating record groove will guide the stylus across the face of the tablet, and will at the same time vibrate the stylus and diaphragm in accordance with the undulations of the record grooves. The sound waves thus produced by the diaphragm will issue from the flaring opening of the trumpet, and the sounds will be heard by a listener in front of the trumpet, or in its vicinity."

The patentee here evidently refers to the use of a *laterally undulating record groove of even depth* in hard resisting material, when he says "a record tablet, having a record of sound waves upon its surface, produced in accordance with my invention."

The patentee then describes the details of construction of the sound box, diaphragm and stylus, and he again refers to his method, and shows that the stylus point need not be in contact with the bottom of the groove, in fact preferably should not be, and is guided

by the walls of the record groove. He states (specification, p. 5, lines 81 to 89):

> "In the operation of reproducing the sound recorded on a tablet, the stylus is guided by the walls of the record groove, and not by the bottom of the same. Consequently, it is not essential that the point of the stylus be in contact with the bottom of the groove. In fact, it is preferably not in contact with the same, so that this point may be made rather dull."

The claims then follow, after a brief description of a device for damping, or modifying, the sound.

Many of the claims relate to the method of recording the sound waves on a plate to be etched, and the method of etching the same. A number of them refer to the construction of the sound-box and its connection with the stylus. Some of them claim the recording apparatus, and some of them certain details of construction.

There is no claim for the *specific form* of swinging arm reproducer shown in Fig. 3.

Claim thirty-five, however, is drafted so as to include not only the construction shown in Fig. 3 of reproducing apparatus, but other constructions which embody a traveling tablet having a sound record formed thereon, and a reproducing stylus shaped for engagement with the record, and free to be vibrated and propelled by the same.

As this was the invention of Mr. Berliner broadly, there was no necessity for a multiplicity of specific claims. The language of this claim clearly illustrates the breadth and scope of Mr. Berliner's reproducing apparatus, as does claim five of the scope of his method, which the apparatus claimed in claim thirty-five was devised to carry out.

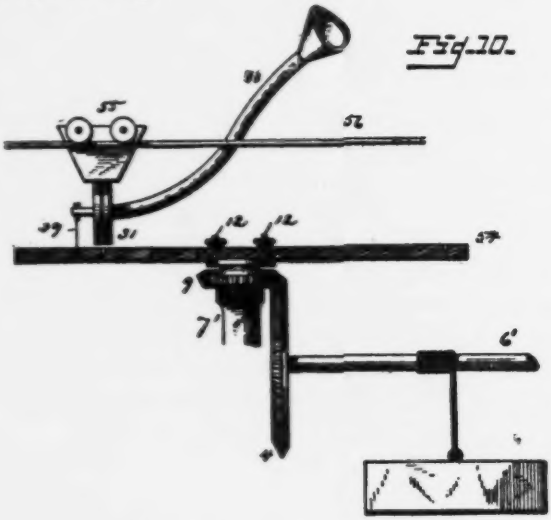
Claims five and thirty-five read as follows:

> "5. The method of reproducing sounds from a

record of the same, which consists in vibrating a stylus and propelling the same along the record by and in accordance with the said record, substantially as described."

"35. In a sound reproducing apparatus, consisting of a traveling tablet having a sound record formed thereon, and a reproducing stylus shaped for engagement with the said record, and free to be vibrated and propelled by the same, substantially as described."

One of the forms of apparatus constructed and operated by Mr. Berliner, in 1887, in accordance with claims thirty-five and five, is illustrated in this accompanying drawing.



The decision of the Circuit Court in the Graphophone case, affirmed by the Court of Appeals, and Mr. Berliner's testimony now in this case (Rec., p. 239) show that this is one of the forms of the apparatus invented by him, and claimed in claim thirty-five, which he constructed in November, 1887, and which he re-

ferred to in the article, "Berliner's Gramophone," published in the "Electrical World" of November 12, 1887, and in his Franklin Institute lecture.

The decision of the Court of Appeals has sustained these claims of his patent after a careful consideration of the full and most carefully prepared defence of the defendant in the suit against the American Graphophone Company, and has fixed Mr. Berliner's date of invention as November, 1887.

Re Pending Application for Berliner Patent, No. 564,586.

At the date of the filing of the application for the patent in suit, No. 534,543, which was March 30, 1892, Mr. Berliner had pending in the Patent Office, at Washington, D. C., another application, which had been filed November 8, 1887, and resulted in Letters Patent No. 564,586 (R. p. 465), which was not issued until January 28, 1896, after the date of the issue of the patent in suit, No. 534,543, which was February 19, 1895. This first application, filed November 8, 1887, had illustrated in one of the figures of the drawings (Fig. 10) and disclosed and described in a portion of the specification, though not claimed, the invention subsequently claimed in the patent in suit, filed March 30, 1892. In this connection the Court of Appeals in the Graphophone case (R., p. 74) stated:

> "The specifications in that application (for 564,586) were full enough to warrant the making of the claims here in controversy (5 and 35). At any time the application might have been amended by adding such claims, and in our opinion it is immaterial that, instead of thus amending it, he took the broader claims on another application filed while the first was pending. The second may fairly be considered a continuation of the first, and thus Berliner's application antedates the public use, and

the facts will not sustain the contention that he abandoned his invention here in suit. The decree is affirmed." (145 Fed. Rep., p. 350.)

Consideration of Claims 5 and 35 and Infringement Involved by Complainants' Expert.

The invention claimed is described briefly by complainants' expert, Harry Cobb Kennedy (R. p. 56, etc.).

"The patent in suit is for a gramophone or talking machine, that is to say, a machine for reproducing recorded sounds. The sounds to be reproduced are recorded in a flat disc sound record by means of spiral grooves of even depth containing lateral undulations conforming to the sound waves produced by the sounds to be recorded. This flat disc sound record is carried by a turn-table rotated by means of a suitable motor. To reproduce the sounds, a sound box or reproducing apparatus is employed. A swinging arm, suitably supported at one end, carries this sound box at its other end, the said sound box communicating with a suitable amplifying horn carried also by said swinging arm. The sound box contains a diaphragm which is set in vibration by a stylus suitably connected therewith, which stylus enters the record groove and is laterally vibrated thereby. These lateral vibrations being reproduced in the diaphragm which sets up vibrations within the sound box and amplifying horn similar to those recorded on the flat disc sound records, and also similar to the sound waves by which the record groove was made in the flat disc sound record.

"Claims five and thirty-five of the patent in suit read, as follows:

> '5. The method of reproducing sounds from a record of the same which consists in vibrating a stylus and propelling the same along the record by and in accordance with the said record, substantially as described.'

> '35. In a sound reproducing apparatus consisting of a traveling tablet having a sound record formed thereon and a reproducing stylus shaped for engagement with said record and free to be vibrated and propelled by the same, substantially as described.'

"The United States Circuit Court of Appeals, in affirming the decree of the Court below in the *per curiam* filed March 9, 1906, stated as follows:

> 'In affirming this decree we do not find it necessary to add anything to the careful and exhaustive discussion of the issues which will be found in Judge Hazel's opinion, with one single exception.'

"This single exception is, that without discussing the question raised in the Court below disposing of the defence of prior public use, and without expressing any definite opinion either way as to the manner in which it was decided by the Court below, the Court of Appeals held that on another ground, namely that of continuing applications, this defence of prior public use would not avail the defendant, so that the manner in which claims five and thirty-five were construed by the Court below thereby becomes the opinion of the Court of Appeals.

"Prior to the invention of the patent in suit the reproducing styles of sound reproducing machines was fed across the surface of the round record by a feed screw, or other means independent of the record itself, and the main distinction of the invention of the patent in suit over the prior art is in the manner of the propelling of the stylus across the record, which is not accomplished by an auxiliary feed screw, but is due to the operating engagement of the stylus point with the record groove itself, independently of other means, or as Judge Hazel states in his opinion sustaining the validity and holding infringement of claims five and thirty-five:

'Complainants contend, and the proofs show, that the stylus attached to the diaphragm is arranged so as to permit the same to vibrate laterally, and that owing to lateral undulations in the walls of the record groove, a desirable swaying motion is imparted to the reproducer diaphragm. Concededly, the lateral undulations in the record automatically guide or propel the stylus and diaphragm in its course over the disc from the outer circumference toward the center, and the stylus travels in an apparently direct radial path while at the same instant of time it is pulsated or incited by the sound waves. The principle of operation in the Berliner machine is thought to be essentially different from that of the machine of Bell & Tainter. In the latter, an auxiliary joint or feed screw was necessary, as already stated, to effectuate the required passage of the record over the point of the stylus, or to cause the stylus and reproducer diaphragm to travel across the surface of the record. In complainants' patent, on the other hand, it is shown that the lateral vibrations of the stylus point and the propelling of the same over the surface of the record without mechanical assistance and through the means of the groove alone was the primary object of the inventor.' * * * 'But from what has already been said regarding the Bell & Tainter patent, it is manifest that the principle of Berliner's invention rests upon the practicability of propelling the stylus in the groove across the surface of the record without a feed screw or other mechanism. By such adaptation to what is known in the art as a zig-zag record (complainants' record) certain imperfections in the talking machines were overcome, and sound, when reproduced was rendered intelligible. There was, I think, patentable novelty in the method which accomplished the results stated.' * * * 'The essence of such claims would seem to include a sound record which, when in juxtaposition with a diaphragm and stylus propelled in the manner described, is thereby enabled to successfully accomplish the primal object and purpose of the invention.'

"In the said suit against the American Graphophone Company so decided by the Court of Appeals as aforesaid, I have examined the exhibits of complainants' and defendant's machine and records, and am conversant with the same, and except for certain specific details of structure, non-essential changes of material and very slight changes in ornamentation or style, Complainants' Exhibits, Defendant's Machine, is a practical duplicate of Complainants' Exhibit, Complainants' Machine as manufactured under the patent in suit. And the structure embodied in Complainants' Exhibit, Defendant's Sound Record, as compared with Complainants' Exhibit, Complainants' Sound Record is also the same, flat disc sound records made of hard, indestructible material, in the faces of which are impressed a spiral record groove of even depth with lateral undulations, which record groove serve the two-fold purpose of vibrating the stylus to produce the necessary vibrations in the diaphragm of the sound box, and also to automatically propel the stylus in the groove across the surface of the record without a feed screw or other mechanism independent of the record itself.

"I have also examined the exhibits introduced in this cause against the Talk-O-Phone Company, namely, Complainants' Exhibit, Complainants' Machine; Complainants' Exhibit, Complainants' Sound Record; Complainants' Exhibit, Defendant's Machine, and Complainants' Exhibit, Defendant's Sound Record, and I find that Complainant's Exhibits, Complainants' Machine and Sound Record are the same as the said Complainants' Exhibits, Complainants' Machine and Sound Record introduced in evidence in said suit against the American Graphophone Company so decided by the Court of Appeals. Comparing the exhibits in this present suit, I find that Complainants' Exhibits, Defendant's Machine is essentially the same as Complainants' Exhibit, Complainants' Machine introduced in evidence in

this suit, and also is the same as Complainants' Exhibit, Defendant's Machine, introduced in evidence in said suit, against the American Gramophone Company. That is to say, in all of these exhibits, there is a cabinet or casing containing a spring motor, the upright spindle of which projects centrally through the top of the cabinet and carries a turn-table. From one side of the cabinet there is a projecting arm. In a bearing at the outer end of this arm is mounted a swinging arm capable of swinging horizontally and vertically on a universal joint, while the inner and free end of this swinging arm carries the sound box, with which is connected an amplifying horn supported and carried also by said swinging arm. Complainants' Exhibit, Defendant's Sound Record is the same structurally as Complainants' Exhibit, Complainants' Sound Record, offered in evidence in this suit, and likewise the same as the Complainants' and Defendant's Sound Record before the Court in said suit, against the American Graphophone Company so decided by the Circuit Court of Appeals, that is to say, it is a flat disc sound record of hard material having in its face a spiral record groove of even depth with the lateral undulations. This Defendant's Sound Record in the present suit is adapted, as in the other devices, to be carried and rotated by the turntable, and the stylus of the sound box engaging the spiral groove therein causes lateral vibrations in the diaphragm and these vibrations of the diaphragm set up the sound waves in the sound box and amplifying horn while at the same time the sound box and stylus are automatically propelled across the surface of the record by reason of the record groove itself, and independently of any other means or mechanism.

"As there is absolutely no difference between the construction of defendant's machine and sound record and the invention set forth and claimed in claims five and thirty-five of the patent in suit, as far as the prin-

ciple of Berliner's invention as to vibrating the diaphragm and propelling the stylus and the sound reproducer by and in accordance with the groove of the sound record across the surface of the record, and without a feed screw or other mechanism, and in view of the fact that defendant's machine and sound record offered in evidence in this suit do vibrate the stylus and propel it and the sound reproducer across the surface of the record in the patent in suit, and as it is done in Complainants' Exhibits, Complainants' Machine and Complainants' Sound Record in said suit against the American Graphophone Company, so decided by the Court of Appeals, in my opinion, the said Complainants' Exhibit, Defendant's Machine and Sound Record, in this suit contain all the means and instrumentalities called for by claims five and thirty-five of the patent in suit and constitute an infringement of these claims.

"The Complainants' Exhibit, Defendant's Machine and Defendant's Sound Record are manufactured for use in connection with each other, and are so used, and in my opinion are incapable of use in any other connection in a practical manner."

The Commercial Uses of the Invention.

For the information of the Court, we would state briefly that a sound reproducing machine, otherwise known as a talking machine, is constructed to reproduce sound, such as songs, musical renditions, recitations, etc., from sound records, upon which the songs, recitations, etc., have previously been recorded. The commercial machines of the Edison phonograph, and the Bell & Tainter graphophone, were usually constructed so as to operate both as recording and reproducing machines, as their records were made upon wax-like blanks, usually of the cylindrical form. In this type of machine, the purchaser could at home, or in his office,

talk into the machine, or sing to it, or dictate letters, the cutting, or indenting, stylus recording the sound as it was uttered by the operator upon the wax-like cylinders. Having made a record he could then, on the same machine, *reproduce* the sound recorded at once by returning the reproducer over the record grooves thus made. Or, in the phonograph and graphophone, records already prepared, with songs thereon by opera singers, or recitations by dramatic talent, were sold, so that they could be reproduced at home for amusement purposes.

Mr. Berliner's invention could not be used for dictating purposes, or making records at home, or at the office, as the Berliner commercial machines sold upon the market were not recording machines, but strictly *reproducing machines*. The Berliner commercial records were always made in **hard, indestructible material** in disc-like form, and were produced in the laboratory through the medium of such process, as described in the patent in suit, or by other suitable means.

The Berliner records were for amusement and educational purposes, and made a radical departure from all talking machine records which had been on the market previous to his invention, which had been formed in wax-like material having a record of the vertically undulating type. Mr. Berliner's commercial disc records of the laterally undulating, or zig-zag type, of groove of even depth were always formed in hard rubber, or material of this character, into which the record could be pressed from a matrix, made in the laboratory, while the material was in a semi-plastic heated condition, and which hardened upon cooling.

All the commercial phonographs and graphophones placed upon the market were of the mandrel type; constructed to record, or reproduce from cylindrical records. All the commercial machines of the Berliner type had a revolving flat table, constructed to

reproduce from hard, indestructible disc records of the laterally undulating, zig-zag type.

All the commercial reproducing machines have what is commonly called a sound box, which consists of a diaphragm of mica, or other suitable material, mounted in a metal cup, or casing, to the centre of which diaphragm is attached a stylus point. In the graphophone and phonograph the stylus point is held by gravity against the vertically undulating record in the spiral record groove, which vertically undulating record pulsates the stylus point in the direction of its length as it is rotated. This, in turn, pulsates the diaphragm, in accordance with the sound waves of the record, which, in its turn, sets in motion the adjacent air within the sound box, thus reproducing the sound recorded upon the record, which is amplified by being discharged through a flaring horn. In the Berliner gramophone, in suit, the stylus bar, connected with the centre of the diaphragm, is vibrated laterally substantially at right angles to its length, and is positively moved back and forth by the lateral sound undulations recorded in both side walls of the record groove, which is of even depth.

A Most Delicate Instrument.

The vibrating of a needle point for reproducing sound from a record of sound waves, was a very delicate operation, and required the most delicate and nicely adjusted instrument to reproduce properly. The phonetic problem to be dealt with was one of minute and microscopic proportions, and not only could not the vertically undulating record of the Edison and Bell & Tainter type effectually automatically propel the stylus of the sound box across the face of the tablet, and produce satisfactory results, as it rotated, by reason of the peculiar character of the record, as herebe-

fore described, having practically little or no side wall resistance, but at that time **and prior to the advent of Mr. Berliner in the field, it had not been discovered that a vibrating stylus pulsated under the impulse of sound waves, could be automatically propelled by a record groove by contact with one of the side walls of the record groove, without destroying, or impairing, the sound vibrations of the stylus point. Mr. Berliner was the first to discover this fact and to invent a method and a machine and record of a new and peculiar character for accomplishing the result.**

The history of Mr. Berliner's invention of his sound records having the sound vibrations recorded laterally in the side walls of a groove of even depth (the subject-matter of another suit between the same parties hereto, on Berliner record patent, No. 548,623), and of his method and apparatus involved in claims five and thirty-five of the patent in suit, is quite fully set forth in Mr. Berliner's article in the "Electrical World" of November 12, 1887 (R., p. 243, etc.), and in Mr. Berliner's address before the Franklin Institute of May 16, 1888 (R., p. 245, etc.).

Berliner Gramophone in Suit Distinct Departure.

As will be seen from the evidence, Mr. Berliner's gramophone was a distinct departure from the method and apparatus of the Edison phonograph, and of the Bell & Tainter graphophone.

Defendant's expert witness in the Graphophone suit admitted Mr. Berliner to be one of the greatest experts in this art. (See Record in American Graphophone case, p. 80.)

In this connection attention is called to a statement made by Mr. Cameron, defendant's expert in the graphophone case, which statement is quoted in the record in the graphophone case, p. 80. Mr. Cameron states, referring to Mr. Berliner, that he——

"was the greatest expert at that time in the world in the art of making and duplicating 'zig-zag' record, or records of uniform depth."

Further Mr. Cameron states:

"These (the Berliner record and the vertically undulating record) were the only forms of commercially practicable sound records known at the date of the Berliner patent, as in fact they are the only forms of commercially practicable sound records known at the present day."

Mr. Cameron further states:

"As I have before pointed out, the record of even depth in commercial practical form, had its origin in inventions of Mr. Berliner, dating from the years 1887 and 1888."

A Brief History of the Invention in Suit.

Emile Berliner, the patentee of the patent in suit, whose name is also conspicuously connected with the Bell telephone by reason of his important inventions in connection therewith, had been a careful student of the sound reproducing art from the time that Edison's first phonograph was known, about 1876, and continued his experiments until the invention of the Berliner gramophone, now widely known to the world as such, involving conspicuously the method and devices for reproducing sound claimed in claims five and thirty-five of the patent in suit.

His patent No. 372,786, filed May 4, 1887, issued November 8, 1887, was the first to describe and claim the gramophone record of laterally undulating grooves of even depth in solid resisting material. He also here showed a somewhat crude reproducing apparatus with a fixed non-propellable reproducer.

On November 7, 1887, Emile Berliner filed an appli-

cation in the United States Patent Office for a method and apparatus of recording and reproducing sound, and in that application, among other things, described and illustrated the method and apparatus claimed in claims five and thirty-five of the patent in suit, No. 534,543, which was filed March 30, 1892, and issued March 19, 1895, while the application first referred to was still pending, and before it issued, which was not until July 28, 1896, when it was issued and given the No. 564,586. (R. p. 465).

Five days subsequent to the filing of the first-mentioned application of November 7, 1887, the "Electrical World," published in New York City, New York, in its issue of November 12, 1887 (R. p. 243), contained an article describing Mr. Berliner's gramophone, and his work in relation thereto. This publication also referred to the particular invention, the subject-matter of claims five and thirty-five of the patent in suit. See also Mr. Berliner's testimony regarding this publication and regarding his application filed November 7, 1887, when he was called as a witness on behalf of the defendant in the Graphophone case (R. p. 230, etc.). Also see Mr. Berliner's testimony when called as a witness by the complainants. (R. p. 239, etc.).

About six months after the filing, of the first mentioned application, which became eventually patent No. 564,586, and during the pendency of that application Mr. Berliner delivered a lecture at Franklin Institute, Philadelphia, before this scientific body, on May 16, 1888, in which he referred, among other things, to his reproducing method and apparatus which had been described and illustrated in his then pending application filed November 7, 1887. While during that lecture he was etching a record plate described in the lecture, he took the opportunity to experiment with his reproducing device before the audience in this hall to test its sound reproducing qualities before this scientific body

of some two hundred people, reproducing some phonautograms, or records, which he had previously prepared in Washington. He pointed out, however, to the audience that some imperfections may have existed at that time in his recording apparatus by reason of lost or added motion, as well as in his *reproducing* apparatus there presented and illustrated on Fig. 2 of the drawings accompanying his lecture. (See R. p. 267. Also see statement, middle of p. 267). Mr. Berliner also referred in this lecture to the description of his invention published in the "Electrical World" of November 12, 1887. He shows that in that paper he referred to "mounting the sounder on a carriage and rails, and have the record groove itself be the screw which was to guide the point of the stylus across the disc from periphery to centre."

In the application for patent filed November 7, 1887, he illustrated in Fig. 10 (R. p. 465), the apparatus of claim thirty-five of the patent in suit, No. 534,543, in a somewhat different form of construction from that illustrated in Fig. 3 of this patent in suit. This form is shown on page 31 of this brief. Instead of having the carrier, which supports the sound box and stylus mounted on a pivoted, swinging arm, as illustrated in Fig. 3 of the patent in suit, No. 534,543, he had the carrier suspended on a traverse rail over which it traveled, on two small anti-friction pulleys, as the stylus was vibrated and propelled by the record automatically across the record disc. This is described on page 4 of the specification of patent No. 564,586, lines 93 to 128. Otherwise the apparatus was exactly the same. The method in both applications was exactly the same.

In his Franklin Institute lecture of May 16, 1888, Mr. Berliner stated that this particular form of his invention had been improved upon by Mr. Werner Suess, who was with him there that evening on the occasion of his lecture, and who had *suggested* that the

sounder be mounted on a swinging arm pivoted at some distance from the disc. This swinging arm was merely another form of Mr. Berliner's devices shown in Fig. 10 of patent No. 564,586, and described in the specification which was then pending in the Patent Office. Mr. Berliner's testimony (R. p. 233-34, etc.), shows that Werner Suess is the same Werner Suess to whom Letters Patent of the United States No. 427,279, were subsequently issued May 6, 1890. This Suess patent No. 427,279, however, does not contain any broad claims, and was limited to the specific construction of the weighted or balanced arm, and to a lazy-tongs construction of pivoted arm. (Suess Patent, R. p. 446). This patent was assigned to Emile Berliner. Mr. Suess was in his employ at that time, and took out the patent for these detail features of construction at the request of Berliner. (See R. p. 234, etc.).

Attention is also called, in this connection, to Complainants' Exhibit Berliner Model, introduced at page 239 of the Record, illustrating the construction shown in Fig. 10 of the Patent No. 564,586.

It is, therefore, shown that Mr. Berliner not only invented the method of claim five, and the device of claim thirty-five, of the patent in suit, No. 534,543, as early as November 7, 1887, the date of the filing of his application for patent, No. 564,586, but also that at the date of the Franklin Institute lecture of May 16, 1888, he had an application pending in the United States Patent Office, which illustrated and described the device and method of claims thirty-five and five.

As has been decided by the U. S. Circuit Court of Appeals (R. p. 73), the fact that Berliner saw fit to file a second application (the patent in suit) on March 30, 1892, while the first mentioned application was pending, did not preclude him from putting into the second application (the application for the patent in suit) claims five and thirty-five, which could have been made in the

first mentioned case, had he desired to have them in that case. The first mentioned application was not issued until July 28, 1896, when it became patent No. 564,586, whereas the patent in suit, the result of the second application, No. 534,543, was issued February 19, 1895, about a year and five months before the first application was issued.

Claims five and thirty-five, of the patent in suit, are not in terms specifically limited to use in connection with a laterally undulating sound record of even depth, though the method and apparatus claimed in these two claims are particularly adapted to a record of this character.

Prior to this invention of Mr. Berliner, of November, 1887, no method existed for reproducing sound simultaneously vibrating and propelling the stylus point across face of the record through the medium of the record groove alone, and without the aid of any auxiliary feeding mechanism. The fact also remains that no talking machine apparatus existed prior to Mr. Berliner's invention of November, 1887, such as claimed in claim 35 applied to any class of record.

The Great Commercial Success of the Berliner Gramophone in Suit.

This invention of Mr. Berliner, who is also the inventor of an important improvement in connection with the Bell telephone, has been one of the greatest commercial successes of recent years. (See deposition of Charles K. Haddon, Graphophone Record, pp. 45-58.) The Victor Talking Machine Company, the exclusive licensee, and its predecessors in business, have built up a magnificent business, exclusively in the manufacture and sale of talking machines and records embodying the invention of Mr. Berliner, claimed in claims five and thirty-five, of the patent in suit, said

company in the manufacture of said inventions, having a factory in Camden, New Jersey, occupying approximately six acres of floor space, the business involving an investment of about four millions of dollars. (See Haddon deposition, Graphophone Record, pp. 47-48, Q's 14 to 16.)

The Victor Talking Machine Company purchased the business of the Berliner Gramophone Company, the former licensee of the United States Gramophone Company, under the Berliner gramophone patents, including the exclusive license under the patent in suit, for an amount equal to about eight hundred thousand dollars, as shown by the said testimony of Mr. Haddon. It was also shown by the deposition of Mr. Haddon, in the Graphophone case, that the Victor Company has been paying six per cent. dividend per annum on all its stock since the organization of the company, in October, 1901, the stock being worth at least par. Emile Berliner also shows that the machines constructed under the patent in suit have gone into every country of the globe (Graphone Record, p. 63).

The Validity of the Scope of Claims 5 and 35 Sustained in the Former Litigation.

Re Validity.

The claims, five and thirty-five of this Berliner Patent No. 534,543, in suit, have passed *through fire and water* in the various cases in which these complainants have enjoined other defendants, and have come out unscathed, and their validity affirmed in several decisions of the United States Circuit Court and Circuit Court of Appeals, for the Second Circuit, in which cases the patent was most vigorously attacked, and every known defence presented and carefully elaborated by astute and eminent counsel for defendants.

A large number of these cases have been reported in the Federal Reporter, and the first one to which reference will be made, is that in which we have referred to herein as the "Graphophone" Case.

Victor Talking Machine Company and United States Gramophone Company v. American Graphophone Company (140 Fed. Rep., 860; Record, p. 63: a copy of which is attached to this brief).

As will be noted from the caption of this case, the complainants were the same as the complainants herein, the defendant being the American Graphophone Company. This suit was in the U. S. Circuit Court for the Southern District of New York, and was instituted about the beginning of 1904, and was vigorously contested by the defendants who attacked the validity of the patent, under various defences, and came on for final argument on full pleadings and proofs before Judge Hazel, on June 5 and 6, 1905, and was taken under advisement, an opinion being filed September 28, 1905, holding claims five and thirty-five, of said patent No. 534,543, in suit, valid, and infringed by the defendant's talking machine, an injunction being ordered, with costs to the complainants.

Same Case on Appeal (Reported 145 Fed. Rep., p. 350; Record, p. 73, a copy of which is attached to this brief).

An appeal was taken and perfected from the decree of the Circuit Court and was duly argued before the United States Circuit Court of Appeals for the Second Circuit on January 17 and 18, 1906, which Court of Appeals affirmed the decree of the lower Court on March 9, 1906, sustaining the validity of said claims and holding that they were infringed.

About the latter part of April, 1906, application was made to the United States Circuit Court of Appeals for leave to file a bill in the nature of a bill of review on alleged newly discovered evidence, and was refused by said Court in 1906, reported 148 Fed. Rep., p. 1022. A final decree was entered in the Circuit Court and a perpetual injunction duly served upon the defendant.

The next cases to which reference will be made are those involved in this present litigation, and although this is set out at length in different parts of this present brief, yet to give a consecutive history of the litigation in which the patent in suit has been engaged, this litigation will be briefly referred to at this point for the sake of uniformity. These were the cases filed against the Leeds & Catlin Co. and the Talk-O-Phone Company, in the Southern District of New York, in Equity, respectively, 8797 and 8859; that against the Leeds & Catlin Company being filed in July, 1904, and against the Talk-O-Phone Company, in September, 1904. Shortly after the final decree in the suit against the American Graphophone Company motions for preliminary injunction were made against the Leeds & Catlin Company and Talk-O-Phone Company, and were argued before Judge Townsend on a voluminous record, the defendant's opposing affidavits covering about 200 typewritten pages, and defendant's Exhibit Letters Patent, was a book of 135 pages. It was argued at length upon voluminous briefs, and on April 26, 1906, Judge Townsend filed an opinion granting preliminary injunctions in each of said cases. (Reported 146 Fed. Rep., p. 534; R. p. 318, a copy of said opinion being attached to this brief.

Upon application of the defendants and upon the filing of bonds, the said preliminary injunctions were stayed pending appeal. The Leeds & Catlin Company

and Talk-O-Phone Company took and perfected appeals, the transcript containing about 550 pages. These appeals were argued before the Circuit Court of Appeals for the Second Circuit on October 11 and 12, 1906, before Circuit Judges Wallace, Lacombe and Coxe, the briefs of each party covering about 215 printed pages. On October 12, the said Circuit Court of Appeals, in open court, affirmed the decree of Judge Townsend, granting said preliminary injunctions, Judge Wallace speaking for the Court (reported 148 Fed. Rep., 1022), and thereafter mandates were duly issued and filed and decrees for preliminary injunction entered on October 27, 1906, and the preliminary injunctions were duly served upon the said defendants, the Leeds & Catlin Company and the Talk-O-Phone Company.

Subsequent to the issuance of said preliminary injunctions, the Leeds & Catlin Company, continued to manufacture and sell, disc talking machine records for use in combination with the reproducing apparatus of the patent, and upon being attached for contempt upon application of the complainants, on January 5, 1907, Judge Lacombe held the Leeds & Catlin Company in contempt, imposing a fine. (Reported 150 Fed. Rep., 147.) On appeal from the decision of Judge Lacombe, the Circuit Court of Appeals for the Second Circuit on May 2, 1907, affirmed said decree. (Reported 154 Fed. Rep., 158.)

From the decisions of the Circuit Court of Appeals, affirming the decree of Judge Townsend, granting preliminary injunction against the Leeds & Catlin Company, and affirming the decision of Judge Lacombe holding the Leeds & Catlin Company in contempt of the said preliminary injunction, this case is now before this Honorable Court on these writs of *certiorari*.

Victor Talking Machine Company and United States Gramophone Company v. Hoschke, et al., (158 Fed. Rep., p. 309, a copy of which opinion is attached to this brief).

The next suit, on the Berliner Patent, No. 534,543, where the validity of the patent was contested, was that of the Victor Talking Machine Company and United States Gramophone Company against William H. Hoschke, trading as the Sonora Phonograph Company, in the United States Circuit Court for the Southern District of New York, in Equity, No. 2-30, which was brought in October, 1907, a motion for preliminary injunction being made and argued before Judge Hough on December 6, 1907, the validity of the patent being vigorously attacked by the counsel for the defendant.

Vigorous opposition was made to the granting of said motion based upon voluminous affidavits presenting all of the defences which are presented herein, and this case was fully argued by opposing counsel. On December 28, 1907, Judge Hough filed an opinion granting the motion for preliminary injunction, in which opinion, among other salient points considered and passed upon and which were raised in this case Judge Hough said:

> "As to defendant's second contention, I do not think it true that the Courts of this circuit have not interpreted the scope of the Berliner patent. Judge Hazel declared that 'the lateral undulations in (complainant's) record automatically guide or propel the stylus and diaphragm in its course over the disc from its outer circumference toward the centre, and the stylus travels in an apparently direct radial path, while at the same instant of time it is pulsated or incited by the sound wave.' This is a description of the method of operation of complainants' talking machine.
>
> "The principle of operation of complainants' machine, as declared in the same decision (140

Fed. Rep., 863), is the 'lateral vibration of the stylus point and the propelling of the same over the surface of the record without mechanical assistance and through the means of the groove alone;' such is said to be the primary object of the inventor; and again (p. 864 of 140 Fed.), it is stated that the 'principle of Berliner's invention rests upon the practicability of propelling the stylus in the groove across the surface of the record without a feed screw or other mechanism.'

"It has thus been definitely held that Berliner's invention covers the reproduction of sound by means of a vibrating reproducing stylus, shaped for engagement with the laterally undulated groove of a sound record, and free to be vibrated and propelled by the revolving record itself, without the assistance or guidance of a feed screw or other mechanism."

Victor Talking Machine Company and United States Gramophone Company v. Douglas Phonograph Company.

In the latter part of September, 1907, a suit under this Berliner Patent No. 534,543, was filed by the complainants herein against the Douglas Phonograph Company, in the United States Circuit Court for the Southern District of New York, a motion for preliminary injunction being made, which was vigorously opposed by the defendant and fully argued by opposing counsel before Judge Lacombe on November 22, 1907, being taken under advisement. On December 19, 1907, Judge Lacombe filed an opinion granting the motion for preliminary injunction, which injunction was duly issued and served upon the defendant. In this case, the infringement complained, of, was the reconstruction and remolding of complainants' machine by the defendant.

Furthermore, this patent has been before the various Circuit Courts and Circuit Court of Appeals in

other litigation, notably that in reference to suits brought to restrain infringement of the patent by reason of the violation of conditions of license, under which the talking machines and records manufactured under the patent in suit were licensed to be sold by the Victor Talking Machine Company, for instance, such as selling machines and records at a less price than that at which they were licensed to be sold by complainant.

Among other suits in which **this patent has been involved** in litigation of this kind, may be mentioned the following, namely:

Victor Talking Machine Company, et al., v. The Fair (118 Fed. Rep., 609, and 123 Fed. Rep., 424).

This case was brought in the United States Circuit Court for the Northern District of Illinois, as first reported and was afterwards heard on appeal in the United States Circuit Court of Appeals for the Seventh Circuit. There was a vigorous contest on behalf of the defendant in both the Circuit Court and Court of Appeals, as to the question whether sale of the talking machine, at a less price than that at which the complainants had licensed it for sale, was an infringement of the patent in suit. The Court of Appeals reversed the Court below and held that such unlicensed sale was an infringement of the patent in suit.

Victor Talking Machine Company, et al., v. Shaffer & Salm.

This was a suit in the United States Circuit Court for the Southern District of Ohio, in Equity No. 5570, the bill being filed July 31, 1903. A demurrer was filed on behalf of Salm and an answer on behalf of Salm also, and at the hearing on the motion for preliminary

injunction on October 24, 1903, an affidavit was filed on behalf of Salm in opposition to said motion. There was no defense on behalf of Shaffer. At the argument of said motion for preliminary injunction, the demurrer was withdrawn, and the preliminary injunction granted and duly issued and served. Later on decrees for perpetual injunctions, *pro confesso* against Shaffer, by consent against Salm, were entered.

Victor Talking Machine Company, et al., v. Vim Company, et al.

This was a suit in the United States Circuit Court for the Northern District of Illinois, in Equity No. 7894. The bill of complaint was filed July 29, 1905. In this case a preliminary injunction was issued September 6, 1905, and duly served upon the defendants, and later on an attachment issued at the instance of the complainants, the defendants being held in contempt.

Victor Talking Machine Company, et al., v. Bentel.

This was a suit in the United States Circuit Court for the Western District of Pennsylvania, No. 25, November Sessions, 1905. The bill of complaint was filed October 20, 1905, and on the same day a temporary restraining order was issued and served. A motion for preliminary injunction made at the time of the filing of the bill of complaint was duly argued, but before a decision thereon had been rendered, the case was settled.

Victor Talking Machine Company, et al., v. The Keen Company.

This was a suit in the United States Circuit Court for the Eastern District of Pennsylvania, April Sessions, 1906, No. 32. Bill of Complaint filed June 21,

1906. A motion for preliminary injunction was made and was vigorously contested and opposed on behalf of defendant upon opposing affidavits, and on June 28, was argued by counsel for both parties before Judge McPherson, who granted a preliminary injunction which was duly issued and served. An appeal from said decree so granting the preliminary injunction was duly taken and perfected to the United States Circuit Court of Appeals for the Third Circuit and was argued by opposing counsel, the appeal withdrawn, and a perpetual injunction thereafter issued and served.

Victor Talking Machine Company, et al., v. Poppenberg, et al.

This was a suit in the United States Circuit Court for the Western District of New York, the bill of complaint being filed March 14, 1908. A motion for temporary restraining order was made and granted pending the hearing of the motion for preliminary injunction. Thereafter, and on March 23, 1908, before the hearing on the motion for preliminary injunction, a decree for perpetual injunction was made and entered, and a perpetual injunction issued and served upon the defendants in accordance therewith.

Victor Talking Machine Company, et al., v. Bearwald.

This was a suit in the United States Circuit Court for the Southern District of New York. In Equity No. 2-182, the bill of complaint being filed March 24, 1908, on which day a temporary restraining order was granted, followed by a preliminary injunction after the hearing on the motion therefor in open Court, on April 3, 1908; said preliminary injunction afterwards being made perpetual.

Victor Talking Machine Company, et al., v. Futernik.

This was a suit in the United States Circuit Court for the Eastern District of Pennsylvania, in Equity No. 105, April Sessions, 1908. The bill of complaint was filed June 15, 1908, and on the same day a temporary restraining order was granted. Thereafter, and on June 19th, a motion for preliminary injunction, which was made at the time of the filing of the bill of complaint, came on for hearing before Judge McPherson, the defendant filing an opposing affidavit and being represented by counsel. The motion for preliminary injunction was argued by respective counsel, counsel for defendant opposing the same. The said motion for preliminary injunction was granted on the same day, the preliminary injunction being issued and served on that date, and thereafter, and on August 24, 1908, a final decree for perpetual injunction was issued, the perpetual injunction being served on that date.

RE DEFENCES IN AMERICAN GRAPHOPHONE COMPANY CASE.

In order that the Court may know what were the defences presented in the American Graphophone Company case, they are herein inserted briefly, as follows:

1. Anticipation by Bell & Tainter Patent, No. 341,214, and Suess U. S. Patent, No. 427,279.

2. Prior public use for more than two years before the application, based on Berliner's lecture and demonstration of May 16, 1888, before the Franklin Institute.

3. Abandonment, based on the article in the "Electrical World" of November 12, 1887.

4. Abandonment by acquiescence in Suess United States Patent, No. 427,279.

5. Expiration of the patent in suit by reason of expiration of prior French Patent, No. 205,491, to Suess.

6. Want of jurisdiction by the Court by reason of the agreement in evidence between the parties.

7. That the patent in suit, No. 534,543, was not based on Berliner's invention, the construction being shown in the Suess patent, and not that shown in Berliner's application filed November 7, 1887, for Berliner Patent, No. 564,586.

8. Claim five is not for a patentable method.

And other less important defences.

The defendant's proofs consisted in:

Deposition of Sheldon T. Cameron, expert.
Deposition of Emile Berliner.

The prior references introduced were:

U. S. Patent, No. 341,214, to Bell & Tainter.
U. S. Patent, No. 241,288, to Bell & Tainter.
U. S. Patent, No. 427,279, to Suess.
U. S. Patent, No. 564,586, to Berliner.
U. S. Patent, No. 688,739, to Jones.
U. S. Patent, No. 562,694, to Amet.
British Patent, No. 1644, of 1878, to Edison.
French Patent, No. 205,491, to Suess.
Article on Berliner's gramophone in the "Electrical World" for November 12, 1887.
Paper read May 16, 1888, by Emile Berliner, on the gramophone, before the Franklin Institute, and alleged public use of the device on that occasion.

File wrapper and contents of patent in suit, No. 534,543.

Copies of affidavits of E. R. Johnson, filed December 14, 1900, and January 5, 1903.

Stipulation as to translation of Suess French Patent, No. 205,491.

The contention in regard to the Suess French Patent, 205,491, was that it was applied for prior to the U. S. patent in suit, and, being for the same invention as the Berliner U. S. patent, the U. S. patent in suit had expired with the expiration of the French patent.

The defendants filed an exhaustive brief both in the Court below and in the Court of Appeals, and also a supplemental brief; the case was most fully and elaborately argued in the Court of Appeals, as well as in the Circuit Court.

RE THE DEFENCES OF THE PRESENT DEFENDANT.

The present defendant, since the decision sustaining the patent in suit, has naturally been most anxiously and solicitously canvassing around for some new data which might tend to invalidate the patent in suit, not before the Court in the other case, so that it might be enabled to **continue the pirating** of the complainants' invention, both as to machines and records, claimed and protected by claims five and thirty-five, of Patent 534,543, in suit.

In passing it should be noted that the defendant has comparatively recently come into the field and copied complainants' machines and records since the complainants have made a great success, and world-wide reputation, in the manufacture and sale of their

talking machine, and records, the subject-matter of the suit, and without any pretence or excuse, except the alleged invalidity of the patent.

The defendant now claims to have very important "new matter." It is respectfully submitted, however, that a careful reading of the voluminous affidavits and exhibits produced by this defendant in these cases in opposition to these motions, shows very clearly that these are desperate efforts of the defendant to magnify unimportant details, most of which have, in one form or another, been before the Court of Appeals in the suit against the American Graphophone Company.

In all these various defences raised by defendants, there is not a single invention of another prior inventor produced which was not in the Graphophone case.

There is no new prior art produced.

There is no new alleged anticipation.

The alleged new defence rests entirely upon the consideration of certain strained technicalities regarding the alleged effect of certain other patents to Mr. Berliner upon the claims 5 and 35 of the patent in suit.

The character of the defence illustrates most forcibly and clearly the straits to which this defendant has been put in this desperate effort to enable it to continue the infringement.

The alleged new matter is set forth in detail in the affidavit of Mr. Louis Hicks (R. p. 80 and 216), who is counsel for the defendant in each of these cases (Leeds & Catlin and Talk-O-Phone Co. cases).

DEFENCES TO THIS MOTION CONSIDERED.

As hereinbefore noted, a number of the fifteen points of defence raised in the defendant's brief in the Court below are based entirely upon questions which were raised and determined in the suit against the American Graphophone Company, both by the Circuit Court, and by the U. S. Court of Appeals.

The entire defence, however, relative to alleged new matter, might have been boiled down to practically three questions, viz.:

(1) What effect has the expiration or forfeiture, by failure to pay the first renewal fee, of the Suess Canadian on the Berliner U. S. Patent No. 534,543, in suit?

(2) What effect upon the Berliner patent in suit has the expiration of the prior Berliner German Patent No. 53,622, of November 20, 1899, for a sound box, and the prior Berliner French Patent No. 207,090, of July 19, 1890, for a sound box.

(3) What effect upon the claims five and thirty-five of the Berliner patent in suit has the expiration of the prior Berliner British patent, No. 15,232, of 1887, and the corresponding German and French patents?

We will consider hereinafter (beginning at p. 83 of this Brief), the points in their order, as pursued by defendant in its petition for *certiorari*. We will, however, preliminarily consider:

The Relation of Berliner's Earlier U. S. Patents to His Subsequent Patent No. 534,543, in Suit Containing the Basic Claims 5 and 35.

Defendant's counsel in the Courts below, as noted in point one in his brief in the United States Circuit

Court of Appeals (a copy of which is attached to the petition for writ of *certiorari*, pages 7 to 36), devoted considerable argument and attention in an endeavor to show that the Berliner basic invention was patented in the Berliner patent No. 372,786, of May 4, 1887 (R. p. 416), and No. 382,790, of May 15, 1888 (R. p. 434), and that the claims five and thirty-five of the patent in suit, No. 534,543, claimed only improvements such as were illustrated in the constructions shown in Figs. 4, 5, 6 and 7, of the drawings of the patent in suit. As it is quite probable that the defendant will in his brief on appeal, which we have not yet seen, argue this proposition, in order that there may be no misunderstanding this subject will be herein considered at sufficient length to explain to the Court just what Mr. Berliner's earlier invention was, and that the broad basic invention did not come until about November 7, 1887, when he filed his application for United States Patent No. 564,586, and disclosed it in Fig. 10, as well as described in the specification, it being claimed, however, subsequently in the later co-pending application, which became United States Patent No. 534,543, in suit. (See opinion of United States Circuit Court of Appeals in this case, R. p. 73, a copy of which is also hereto attached).

This defence noted above and urged in the Courts below, in substance, is that the Berliner basic invention was patented in the Berliner U. S. Patent No. 372,786, issued November 8, 1887, filed May 4, 1887 (R. p. 416); that the patent in suit, No. 534,543, including claims five and thirty-five, describes and claims only improvements upon what the defendant calls the earlier basic patent, and that the Circuit Court, therefore, erred in holding that claims five and thirty-five are entitled to the broad construction given them by this Court. Point One also contains the statement that the Court below erred in holding that the patent in suit, as to claims

five and thirty-five, did not expire with certain foreign patents to Berliner.

In considering this point, defendant's counsel intimates that Judge Townsend, in deciding the case did not give sufficient examination to the authorities. There was only one question upon which Judge Townsend seemed to have any doubt whatsoever, and for which your Honors, it is submitted, will see there was no occasion, that was the effect of the lapse, or expiration, of the Suess Canadian patent by failure to pay the first renewal fee. On all the other questions Judge Townsend was most emphatic in his finding, and very justly so. He reviewed all the issues raised by the defendants, and decides them to be untenable. It is clear, from a careful reading of his decision (R. 318), that he carefully reviewed the evidence, and did not slight it.

Re Berliner Patents, 372,786, *and* 382,790.

The defendant's counsel in the Court below contended under Point One (Brief, p. 9, attached to petition), that in the prior suit against the American Graphophone Company the evidence was not sufficient to differentiate Berliner's basic invention from the improvements made by Berliner. He contended that by reason of the defences interposed in the prior suit the question of what was the basic invention was not important, but how counsel arrives at the conclusion that it is important now, and not then, is not stated. He further stated on page 10, of same brief, that even if the Court of Appeals in the Graphophone case had stated that claims five and thirty-five were "broader claims" then in No. 564,586, they were not for the basic invention, and contended that "the new proofs show that on May 4, 1887, Berliner applied for, and on November 8, 1887, obtained his first patent, No. 372,786 for the gramophone," and then argued (under former

Brief, p. 10, attached to Petition), that this patent, No. 372,786, and Berliner's patent, No. 382,790, of May 15, 1888, for Method of Making Records, were Berliner's basic patents.

It was practically admitted by defendant's counsel that the essential thing in these two Berliner patents, No. 372,786 and 382,790, was the undulatory groove of even depth in solid resisting material. He says (former Brief, p. 11), "This was Berliner's basic invention." Let us assume here the proposition that the undulatory groove of even depth in solid resisting material, for reproducing sound, and the method of recording the same was the essential thing in these two prior patents, and the attention of the Court is called to the Berliner Patent No. 372,786 (R. p. 416) and to the Berliner Patent No. 382,790, of May 15, 1888 (R. p. 434). The defendant's counsel tries to make capital out of the fact that these two patents were not actually used in evidence in the prior Graphophone suit. *The fact is that they were not used because they were of no use, and had no bearing upon the question;* not because they were unknown to the defendant, as patent No. 382,790 is referred to in the specification of the patent in suit (lines 15 and 16, p. 1, of the specification, R. p. 456), and by reference to this Berliner's Patent No. 382,790 (R. p. 434), we in turn find, on lines 8 and 9, reference to the Berliner Patent No. 372,786, of November 8, 1887. Berliner Patent No. 382,790 is for a Process of Making Sound Records of the laterally undulating type of even depth by an etching method. In other words, it is for the *process of making records* of this character, and does not illustrate, or describe, any apparatus for reproducing sound from the records, or in connection with the records, other than it states:—"In a patent granted me November 8, 1887, No. 372,786 I have described a method of recording and reproducing spoken words and other sounds." It then goes on to state that

in connection therewith the inventor had described a process of producing a record by photo-engraving, and then states, "My present invention is an improvement upon that described in my aforesaid patent."

The Berliner Patent No. 372,786 shows, in the drawing and describes in the specification (R. p. 416), a sound record of the gramophone type, having a laterally undulating groove of even depth in solid resisting material, mounted on a cylinder, with a diaphragm and sound box *rigidly attached to the base of the machine,* with a stylus connecting with the diaphragm engaging in the record groove.

It is defendant's counsel who calls this Berliner's *basic* invention. It is true it shows Mr. Berliner's first crude mechanism for reproducing sound from a record of stylus for reproducing sound from a record of the gramophone type, as distinguished from the Edison phonograph record or the graphophone record of the *vertically undulating type.*

There is, however, nothing whatsoever in either of these two patents, No. 372,786 or No. 382,790, which suggests, or discloses, Berliner's subsequent broad invention, contained in claims five and thirty-five of his subsequent Patent No. 534,543, in suit.

There is nothing in either of these two patents which shows the Berliner subsequent method of simultaneously vibrating and propelling a stylus point automatically across the face of the record through the medium of the record groove, and without the aid of any auxiliary feeding mechanism, nor is any apparatus therein shown for this purpose.

The taking out of a prior patent for a certain method and apparatus does not preclude the same inventor from subsequently applying for and patenting a basic method and apparatus relative to the same art, and differing materially from that of the first patent.

The object of defendant's counsel in taking his po-

sition, and voluntarily calling the Berliner Patent No. 372,786 *the basic patent*, is for the purpose of later endeavoring to show that the subsequent inventions of the same inventor in the same art could be nothing more than detailed improvements. It is quite evident, however, and requires no argument to show that the method of claim five, and the apparatus of claim thirty-five, in the patent in suit, while they may be improvements over No. 372,786, *in the sense that they are better both as to method and apparatus*, they were at the same time radically different and basically new. The apparatus shown in No. 372,786, Fig. 1 (R. p. 416), was a fixed sound box, merely reproducing from a single continuous record, groove on the periphery of a cylinder.

The method of claim five, and the apparatus of claim thirty-five, subsequent to the invention of 372,786, *which made his gramophone a world wide success, is due to the invention of Mr. Berliner.*

Defendant's attempt is to show that claims five and thirty-five are not to be broadly construed, but are to be limited, as defendant stated, on page 18 of its former Brief, "by the improvements in the details of the reproducer, whereby the stylus, provided with a wedge-shaped point, so shaped for engagement with the record, is permitted to be vibrated in the manner described."

Counsel for defendant, without any plausible, or logical, reason, and without the addition of any substantial light contends that certain unwarranted and illogical limitations should be placed upon these claims 5 and 35.

Defendant's counsel also attempted to show that there could be no broad claims in Patent No. 534,543, in suit, for the reason that the patent states that the invention refers to certain improvements, which statement,

as is well known, is a most common and customary statement to make in patents.

It is submitted, however, that the first statement in the patent (p. 1, lines 8, etc.), shows that the invention is broadly referred to. It states:

> "My invention has reference to **improvements in the method of and apparatus for recording and reproducing sounds,** the improvements being more particularly directed to the construction of that kind of sound recording and reproducing apparatus which I have called 'gramophone' and for which Letters Patent of the United States, No. 382,790, dated May 15, 1888, have been granted to me."

It is clear, from this statement, that the inventor had *an improved method and apparatus for recording and reproducing sounds,* particularly in connection with that type of record known as the gramophone, for which a method of making records was described and claimed in Berliner's prior patent No. 382,790, of May 15, 1888.

That Berliner had *improvements* in the method and apparatus of recording and reproducing sound over the method and apparatus of Edison and Bell & Tainter is clear from the record in this case, and as decided by the U. S. Circuit Court of Appeals in the Graphophone case.

In Patent No. 382,790, of May 15, 1888 (R. p. 434), it is not stated that anything contained in this patent is an improvement upon the reproducing apparatus of the Berliner Patent No. 372,786, but that it does describe an improvement in the method of making records in solid resisting material by the process of direct etching; that was what the Berliner Patent No. 382,790 covered. The process of making records in the Berliner Patent No. 372,786 differed from this etching process.

Berliner's Patent No. 564,586, filed November 7, 1887, but not issued until July 28, 1896 (which contains

an illustration (Fig. 10), and description of the method and apparatus of claims five and thirty-five of the patent in suit), refers to the Berliner patent, No. 372,786, and states, on line 19, p. 1, etc., that that invention "consists in first causing the sounds to inscribe themselves upon a layer of non-resisting material in a manner substantially like that practiced by the well-known Leon Scott phonautograph, then copying the phonautographic record in solid resisting material, preferably by the photo-engraving, and then reproducing the sounds from the solid copy of the record." None of these patents, however, submitted, detract from the scope of the basic character of the method of claims five and thirty-five. As to Patent No. 564,586, this invention of claims five and thirty-five is in this patent, and shows this basic Berliner invention to have been invented at least as early as November 7, 1887, the date of the application.

All Defences in the Graphophone Suit Regarded as Res Adjudicata by the U. S. Circuit Court of Appeals, and Not Before it as Defences in the Present Suit. Only the Defences Considered Below Should be Reviewed by This Honorable Court.

The U. S. Circuit Court and Court of Appeals in the prior Graphophone case, had everything material before it upon which to determine the breadth and scope of the claims five and thirty-five of the Berliner patent in suit and regarding all the defences raised and previously decided in that case as *res adjudicata* very properly refused to again consider such defences so all such defences as were raised and previously decided in the Graphophone case as the[y] were not considered by the Court below in this case are not the subject of review by this Honorable Court. It had among other things the Berliner patent, No. 564,586, particularly before it, and the other Berliner patents, Nos. 372,786 and 382,-

790, and as will appear from a careful inspection of them, could have no bearing upon the scope of these claims.

For the same reason, the Werner Suess U. S. Patent No. 427,279, of May 6, 1890 (R. p. 446), was intelligibly and fully before the U. S. Circuit Court and Court of Appeals, and these two prior Berliner patents could in no manner affect this interpretation. In relation to this Suess U. S. Patent, Judge Hazel, in deciding the prior suit said (R. p. 68):

> "In the Suess patent is contained a description corresponding to the features of Claim thirty-five, in suit. The primary object of Suess, an employee of Berliner, however, was merely to construct a suitable pivotal support for the diaphragm and stylus, so as to assist such device in its passage across the record. It is expressly stated in the specification of the Suess patent that the invention relates to improvements in the reproducing apparatus of Berliner, and that the construction and mounting of the stylus form no part of the invention. The improvement of Suess, therefore, is not an anticipation."

It is to be borne in mind that the claims of this Suess U. S. Patent were narrowly limited to the Suess details of improvement, and that the patent contained no broad claims.

Defendant's counsel also urged in the Courts below, contrary to the testimony, that Judge Hazel had no means of knowing the extent of Suess's improvements. The testimony was very full and conclusive in this regard, showing that Mr. Berliner invented the basic invention of claims five and thirty-five as early as November 7, 1887, the date of filing of the Berliner application for Patent No. 564,586, in which this invention was illustrated and described, that the Berliner invention was also described in the "Electrical World" of November 12, 1887 (R. p. 243), and that on May 16,

1888, Mr. Berliner delivered a lecture at the Franklin Institute, in Philadelphia, describing and demonstrating his invention, and giving to Mr. Suess, who was present as his assistant, the credit (R. pp. 245, 270) of having suggested that the sounder be mounted on a *pivot*, such as illustrated in reprint of the lecture (R. p. 269, Fig. 2) instead of on a traveling carriage suspended on rollers on a rail, such as illustrated in Fig. 10 of Berliner Patent No. 564,586, filed November 7, 1887, and described in the specification of that patent and such as referred to in the "Electrical World" of November 12, 1887. (R. p. 243.) Mr. Berliner states, in his Franklin Institute lecture (R. p. 270):

> "In the description of November 12, 1887, I advanced the idea of mounting the sounder on a carriage and rails, and have the record groove itself be the screw which was to guide the point of the stylus across the disk from periphery to center. This has been improved upon by Mr. Werner Suess, the gentleman here with me to-night, who is the mechanician of our little shop in Washington. He suggested to mount the sounder on a pivot at some distance from the disk, and then let the reproducing groove guide the sounder across the disk over an arc of flat amplitude."

The Suess U. S. Patent No. 427,279, issued May 6, 1890 (R. p. 446), was filed August 6, 1889, considerably over a year after the date of the Berliner Franklin Institute lecture, and admitted Mr. Berliner to be the inventor of the gramophone. Mr. Suess merely put in his patent application restricted claims for specific improvements, all in accordance with the evidence.

Mr. Berliner's acts were entirely consistent. He had filed his application November 7, 1887, for Patent No. 564,586, embodying in the specification and drawings this invention subsequently claimed in claims five and thirty-five of Patent No. 534,543 later applied for and issued prior to the issue of Patent No. 564,586.

Mr. Berliner, therefore, having filed this application with this invention described and illustrated in it, had a perfect right to assume that he was protected, and that he might safely make such disclosures as he did make in the Electrical World, and in the Franklin Institute lecture.

Notwithstanding the decision of the Courts in the Graphophone case, which the courts below in this case regarded as *res adjudicata,* and did not review the defences there made, counsel for defendant in this case, without any substantial reason, without any material new evidence, is contending that the Honorable Court of Appeals was wrong in giving to claims five and thirty-five the interpretation which it did, his reasons being based upon his reading of the specification of the Patent No. 534,543.

RE ATTEMPT TO MISCONSTRUE THE PATENT IN SUIT.

It is defendant's counsel's attempt, by a juggling of the words of the specification of the patent in suit (R. p. 456), to show that the specification (page 1, lines 17, etc.) stated that the features of the invention related to tracing on a fatty film undulatory lines, etc., and that the other features have reference to the construction of details. If defendant's counsel would take the specification as a whole, he would find abundant authority, as has been found by the U. S. Circuit Court of Appeals, to show that the invention related to improvements in the method and apparatus for reproducing sound, such as that claimed in claims five and thirty-five. The specification (p. 1, lines 8, etc., R. p. 456) states:

> "My invention has reference to improvements in the method of and apparatus for recording and reproducing sounds * * *"

It then goes on to state that the improvements are *more particularly* directed to the construction of that kind of sound recording and reproducing apparatus called the gramophone and referred to in the Berliner Patent No. 382,790.

It is apparent, therefore, that the broad, primary statement is to the effect that the invention of the patent relates to the improvement in the **method** and **apparatus** for **recording and reproducing sounds.**

There is no positive statement here that the improvement described is an improvement on the Berliner Patent No. 382,790, which was for a method of making zig-zag records. It says that the invention is "more particularly directed to the construction of that kind of sound recording and reproducing apparatus which I have called 'gramophone'."

It is apparent that it was an improvement over the prior Edison phonograph and the prior Bell & Tainter graphophone, which Berliner styled the Gramophone.

But even supposing that the invention of the patent in suit was an improvement on the construction shown in the Berliner prior patent, No. 372,786, this fact could in no manner affect, under the circumstances, the scope of claims 5 and 35.

The specification then goes on to state (p. 1, line 17, etc.), after the invention broadly has been referred to, that one feature of the invention is the method of recording sound by tracing on a fatty film the undulatory lines, and then etching the lines in a metal base; and then it goes on to state that other features relate to details.

The specification (p. 4, line 95 to p. 5, line 18) describes *one form of apparatus* for carrying out the method of claim five, being one form of apparatus included in claim thirty-five. The specification, on p. 5, lines 19 to 34, describes *the method* of reproducing,

such as illustrated and described in the specification of that patent, as well as illustrated in Fig. 3 of the patent in suit, in the apparatus shown in Fig. 10 of Berliner Patent No. 564,586 (R. p. 465), which the U. S. Circuit Court of Appeals in affirming the Court below in the Graphophone suit, has decided was full warrant for making the claims five and thirty-five in Patent No. 534,543, in suit. In this connection, the U. S. Circuit Court of Appeals said in the Graphophone suit (R. p. 73):

> "The specifications in that application (for 564,586) were full enough to warrant the making of the claims here in controversy (five and thirty-five); at any time the application might have been amended by adding such claims, and in our opinion it is immaterial that, instead of thus amending it, he took the broader claims on another application filed while the first was pending. The second may fairly be considered a continuation of the first, and thus Berliner's application antedates the public use, and the facts will not sustain the contention that he abandoned his invention here in suit."

Defendant's counsel comments on the fact that Mr. Berliner in the specification of Patent No. 534,543 (p. 1, line 51), refers to "my improved gramophone recorder—" and on p. 4, line 95, in describing the reproducing apparatus, says "*the* reproducing apparatus." It is clear that this was quite a natural change in phraseology at that point of the specification on p. 4, line 95, after he had previously referred to the reproducing apparatus, and referred to it as "*the* reproducing apparatus" meaning that to which he had previously referred. The patentee had stated (p. 1, line 8) that "my invention has reference to improvements in the method of and apparatus for recording and reproducing sounds—." The fact that the patentee happened to use the definite article afterwards, instead

of the possessive pronoun, meant nothing. He frequently, throughout the specification, used the definite article in describing the constructions which were admittedly Berliner's invention, and claimed in the claims.

RE DEFENDANT'S CONTENTION THAT 5 AND 35 ARE FOR SPECIFIC CONSTRUCTIONS OF REPRODUCERS SHOWN IN FIGS. 6 AND 7.

Defendant's counsel also (former Brief, p. 17) endeavored in the Court below, and doubtless will here, to show that the essence of claims five and thirty-five are specific constructions of the reproducer illustrated in Figs. 6 and 7 of the patent, No. 534,543. How he arrives at this conclusion he, however, does not distinctly state.

His reason for making this deduction is manifestly so that, thereafter he may attempt to prove that the Berliner German patent, No. 53,622, *of November* 20, 1889, *embodying a reproducer, and the Berliner French patent, No.* 207,090, *of July* 19, 1890, *showing a recorder and a reproducer, limited the claims by the expiration of those patents.*

The claims of the patent in suit are thirty-five in number; many of them relate to the method of recording the sound waves on a plate to be etched, and the method of etching the same. A number of them refer to the construction of the sound box and its connection with the stylus. Some of them claim the recording apparatus, and some of them certain details of construction. There is no claim for the *specific form* of a pivoted swinging arm reproducer, as shown in Fig. 3. This was merely one form in which Mr. Berliner's invention of claims five and thirty-five could be employed. Other forms could have been shown, as, for instance, that illustrated in Fig. 10 of the Berliner Patent No.

564,586. Mr. Berliner, in his Franklin Institute lecture in May, 1888 (R. p. 270, Fol. 809) describing his basic invention, gave Mr. Werner Suess the credit of having suggested the use of a *pivoted* arm in carrying out Mr. Berliner's invention, instead of the suspended carriage or trolley construction shown in Fig. 10 of the patent No. 564,586, but Werner Suess never claimed to be the inventor of the method of claim five or the broad apparatus of claim thirty-five. Mr. Berliner was the undisputed inventor and was always so regarded. Mr. Suess, when he took out his U. S. Patent, No. 427,279, of May 6, 1890, corroborates this by claiming only details of construction.

Defendant's only ground for the contention that Suess was the inventor is that the patent attorney, in applying for the Suess Canadian patent, taken out by Berliner as assignee of Suess, happened to include two or three claims which were broader than the claims of the prior Suess U. S. application, and which it is contended were broad enough to include the Berliner claims five and thirty-five, of the patent in suit.

In fact, defendant's main contention in this case rests upon the fact that two or three broad claims accidentally got in to the Suess Canadian patent No. 41,901, issued February 11, 1893, applied for May 5, 1891.

At that time the Canadian patent office made no examination into the prior art.

That Mr. Berliner, or his attorney, in conducting the Suess Canadian application had no intention of admitting Suess to be the inventor of the invention of the patent in suit, No. 534,543, is conclusively evidenced by the fact that Mr. Berliner, through the same attorney, applied on a Canadian patent for the same invention as in U. S. patent 534,543 on December 7, 1895, which Canadian patent was granted February 24, 1897, with the same claims, including claims five

and thirty-five in suit (R. pp. 315-317, and stipulation p. 540).

As hereinbefore shown, the Suess Canadian patent was granted for a term of eighteen years, and even if it otherwise would have had any limiting effect upon claims five and thirty-five of the Berliner patent, No. 534,543, *in suit, the term of this Canadian patent has not yet expired.*

Re Question of Applicability of Siemans v. Sellers, 123 U. S., 276.

The defendant contended in the U. S. Circuit Court of Appeals that the Circuit Court was in error in its understanding and interpretation of the decision of Siemans *v.* Sellers, *supra.* As the defendant's counsel will doubtless consider this same question more elaborately in another portion of his brief, we will consider it later under a separate heading.

We submit that the Berliner patent, 372,786, which showed the first Berliner rigidly mounted reproducer without any means for propelling the reproducing stylus through the medium of or in accordance with the record, had nothing to do with claims five and thirty-five in controversy, and could not possibly have anything to do with the limitation of their scope.

As hereinbefore more fully pointed out, prior to the invention by Mr. Berliner of the subject matter of claims five and thirty-five, it had not been discovered that **a vibrating stylus pulsating under the impulses of sound waves, could be automatically propelled by a record groove by contact with the side walls of the groove, without destroying or impairing the sound vibrations imparted to the stylus point.** No method prior to that invention existed for reproducing sound in the manner claimed by Mr. Berliner in claim five, by simultaneously vibrating and propelling the stylus

point across the face of the record through the medium of the record groove alone, and without the aid of any auxiliary feeding mechanism, and no talking machine apparatus existed prior to Mr. Berliner's invention, first shown in his application for patent for 564,586, Fig. 10, which was filed November 7, 1887.

Mr. Berliner's basic invention *for accomplishing this thing,* claimed in claims five and thirty-five, was first illustrated and described in his patent 564,586, filed November 7, 1887, and first claimed in the claims of the patent in suit, No. 534,543, claims five and thirty-five, which was filed March 30, 1892, and issued February 19, 1895, during the pendency of the application for patent 564,586, which was filed November 7, 1887, but not issued until July 28, 1896. His second application for patent 534,543, in suit, has been decided by the U. S. Circuit Court of Appeals "may fairly be considered a continuation of the first—" application for patent 564,586 (R. p. 74).

Even if the subsequent broad invention were an improvement over the first, that fact would not deprive Berliner of basic claims for his great subsequent discovery and invention of the method of claim five and apparatus of claim thirty-five, which has revolutionized the talking machine business in all parts of the globe.

Judge Hazel, in delivering the opinion of the Court below in the Graphophone case, said (Record, p. 68, Fol. 204):

> "it is manifest that the principle of Berliner's invention rests upon the practicability of propelling the stylus in the groove across the surface of the record, without a feed screw or other mechanism. By such adaptation to what is known in the art as a zigzag record (complainants' record) certain imperfections in the talking machines were overcome, and sound when reproduced was ren-

dered more intelligible. There was I think patentable novelty in the method which accomplished the result stated. The broad claims in suit in my judgment cannot be restricted to a record of even depth, such as described in the specification. The essence of such claims would seem to include a sound record which when in juxtaposition with the diaphragm of the stylus propelled in the manner described, is thereby enabled to successfully accomplish the primal object and purpose of the invention."

This was an improvement over what Berliner had previously invented, as shown in the old patent 372,786, but this in no manner detracted from the basic character of the improvement, or from the scope of claims 5 and 35.

Suess did not invent this; this fact was decided by Judge Hazel, and by the Circuit Court of Appeals, in the Graphophone case, and the fact that some broader claim than those of the Suess U. S. patent may have crept into the Suess' Canadian patent, cannot in any manner affect the fact that Berliner was the inventor.

It is clear that the fundamental features of claims five and thirty-five were in no manner embodied in Berliner patent, No. 372,786, or in the Berliner patent, No. 382,790.

Defendants' counsel under this head spends considerable time in criticizing the construction which has been given to the claim in the Graphophone suit by the Courts below, and in contending that claims five and thirty-five are for mere detail improvements.

Berliner Patent, 372,786, No Bearing on the Case.

Defendant's counsel contends that as Berliner's patent, No. 372,786, was not before the Court in the Graphophone Case, the Court held that the Berliner patent, No. 564,586, was the basic patent.

As hereinbefore pointed out, there was nothing in the Berliner patent, No. 372,786, to have caused it to be considered. Had there been it would have been considered, as it is mentioned and referred to in Berliner patent, 382,790, which latter patent is mentioned and referred to in patent in suit, 534,543. The fact is there was no reason for considering it in that case, or in this, any further than any other irrelevant patent.

Defendant's counsel suggests that the Berliner patent, 372,786, was not important in the Graphophone Case, although it is important here, but why it is important here and not in the Graphophone Case, he does not state.

The fact that Berliner described in patent 372,786, a process by which sounds could be inscribed upon a layer of non-resisting material in an undulatory line of even depth, and afterward copied in non-yielding or solid resisting material and reproduced, in no manner affected the scope of his subsequent invention, the subject matter of claims five and thirty-five.

The Foreign Patents Can Have No Effect on Term of Patent in Suit.

Defendant's counsel contends that Berliner's foreign patents tend to prove that claims five and thirty-five were mere improvements.

As hereinbefore more particularly pointed out, none of Berliner's foreign patents ever produced by the defence described or claimed the process of claim five or the apparatus of claim thirty-five, so they in no manner affect these claims, or their basic character, whether they were in evidence or not in the prior suit.

Defendant's counsel states that the Berliner British patent, 15,232, of November 7, 1887, covered the sub-

ject matter of the Berliner U. S. patents No. 372,786 and No. 564,586.

If this British patent covered the subject matter of the Berliner patent, No. 372,786, it could in no manner affect the issue in suit, *and it is admitted, as it must be by defendants' counsel, that Fig.* 10 *and the description thereof of U. S. Patent,* 564,586, *is entirely omitted from the Berliner British patent,* 15,232.

As this omitted part was the only part in 564,586 which had any reference to claims five and thirty-five of the patent in suit, the British patent 15,232 could have no effect upon the issue in controversy, as hereinafter more particularly pointed out. If the Berliner British patent, No. 7,204, of May 15, 1888, corresponds, as stated, to the Berliner U. S. patent, No. 382,790, of May 15, 1888, this can in no manner affect the issue in controversy, as, as hereinbefore pointed out, Berliner patent, 382,790, is not for any reproducing mechanism, nor does it describe any, but is for a process of making records by etching.

For the same reason Berliner's French patent, No. 186,827, of November 8, 1887, and German patent, No. 45,048, of November 8, 1887, if they correspond, as stated by defendants' counsel, to the Berliner British patent, No. 15,232, can have no bearing on the issue in controversy. This is likewise true of the Berliner French patent, No. 190,602, of May 15, 1888, and German patent, No. 47,099, of May 16, 1888, if they correspond, as stated by defendants' counsel, to the Berliner English patent, No. 7,204.

All that the Berliner French patent, No. 207,090, of July 19, 1890 (R., p. 126), describes and illustrates is a sound recorder and reproducer; even if these sound boxes, shown in the French patent, were the same, which is not admitted, as the sound boxes shown in Figs. 4, 5, 6 and 7 of the patent in suit, No. 534,543, it

could not affect the claims five and thirty-five in controversy.

The Berliner German patent, 53,622, shows only a reproducing sound box, which, even if it were the same as the reproducer shown in Figs. 6 and 7 of the patent 534,543, in suit, which we deny, could not affect claims five and thirty-five in controversy.

A Misleading Statement of Defendant.

The attention of the Court is called to the misleading statement of defendant's counsel as contained on pages 31 and 32 of the brief attached to the petition for *certiorari,* to the effect (p. 32) "In addition the said German (45,048), French (186,827) and English (15,232) patents claim and show in Figs. 8-16, the improvements set forth in United States patent, No. 564,586, upon Berliner's basic invention." This is misleading and untrue, as these patents *do not contain Fig.* 10 *of the Berliner U. S. patent,* 564,586, or any description of the apparatus there illustrated, which omitted parts are the only things in the U. S. patent, No. 564,586, which disclose or refer to the constructions claimed in claims five and thirty-five of the Berliner patent, 534,543, in suit. *The Court's special attention is asked to this misleading and unfair statement.* (See British patent, 15,232, R. page 516; U. S. patent 564,586, R. page 465). This statement, however, may not be repeated in defendant's brief to be filed in this Court on appeal.

It will appear from careful reading of these contentions in connection with the patents themselves, that it is a mere captious contention, that claims five and thirty-five are mere improvements upon Berliner's first machine shown in U. S. patent, No. 372,786, and a continuous repetition of defendant's previous arguments. Even if claim five was an improved

method and claim thirty-five an improved apparatus, this fact cannot affect the scope of the claims, and cannot affect the fact that they were basic patents as to the method and constructions which they embody.

The alleged new evidence of Berliner patents, No. 372,786 and No. 382,790, is immaterial, and can have no bearing upon the breadth and scope of claims five and thirty-five. The fact that claims five and thirty-five embody an improved and better method than that illustrated and described in said Berliner prior patents, in no manner affects their scope and character, and no different result would have been arrived at had these patents been specifically in evidence in the graphophone suit, and that they were known, cannot be denied, as 382,790 was specifically referred to in patent 534,543, and in 382,790 patent No. 372,786 was specifically referred to.

Defendant in subdivision (1) of Point One (p. 33) of its brief used in the Court below and attached to the petition in this Court, contends the defendant does not use the reproducer of the patent in suit. This is somewhat misleading. The defendant does not deny that they use the reproducing apparatus of claim thirty-five as construed by the Courts below in the Graphophone case, but what defendant does not use is the exact construction of reproducer illustrated in Figs. 6 and 7 of the patent in suit, which of course makes no difference in this issue.

The complainants do not use this either.

The defendant does use the apparatus of claim thirty-five, embodying the method of claim five as construed by the Courts in the Graphophone case, and does not deny that fact, though this statement contained on p. 33 of defendants' said former brief is misleading.

Defendant's contention in subdivision (m) of Point One in brief attached to the petition in this Court, is that the Berliner invention, called there the

basic invention (but meaning the invention of patent No. 372,786), and the Suess improvement such as illustrated and described in the Suess U. S. patent, No. 427,279 (R. p. 446) were patented in certain foreign countries before the grant of the patent in suit, and that as these patents have expired the corresponding Berliner U. S. patents have expired.

It will be borne in mind, however, that the foreign Berliner patents referred to were those hereinbefore noted, viz., Berliner German patent 53,622, of November 20, 1889; Berliner French patent 207,090, and Berliner English patent 15,232. These three patents, English, French and German, relate to the invention of the Berliner U. S. patent 372,786 and No. 564,586, **with the Fig. 10 of 564,586, and all description thereof, entirely left out, or rather never incorporated in them.**

The Berliner British patent, No. 7,204, of May 15, 1888; French patent, No. 190,602, of May 15, 1888, and German patent, No. 47,099, of 1888, corresponded to the Berliner U. S. patent, 382,790.

It is, therefore, clear that none of these patents embody the substantial invention of the Berliner patent 534,543, in suit, and did not embody the invention of claims five and thirty-five, and that therefore the expiration of these patents, under the authorities hereinafter fully considered, could not affect the life of the U. S. patent for this invention.

It is also contended by defendants that the Berliner-Suess Canadian patent, No. 41,901, of February 11, 1893, contained certain broadly worded claims in addition to the narrower claims corresponding to the Suess U. S. patent, No. 427,279, that as this Canadian patent lapsed at the expiration of six years by reason of the failure to pay the fees for the balance of the period of the term of eighteen years, that the claims in controversy of the Berliner patent 534,543 have lapsed and all rights forfeited. As hereinafter particularly

pointed out, however, it will appear clear that this Berliner-Suess Canadian patent, even if it contained the claims five and thirty-five of the patent in suit, can have no effect upon them, as it was granted for a definite fixed term of **eighteen years,** which period **has not yet expired.** The authorities are hereinafter referred to under a separate head, and it will be shown that Judge Townsend's decision in this regard was based upon the authorities.

Re Defendant's Point 1.

Defendant's point 1, as stated in its Petition for Writ of *Certiorari,* is as follows:

> First. Whether, under a proper construction of Sec. 4887 of the Revised Statutes as it existed when the patent in suit was granted on February 19, 1895, a home patent expires with the expiration of the legal term of a prior foreign patent granted to the same inventor, where the invention described and claimed in the prior foreign patent is an invention for which the home patent was granted, although the home patent contains claims covering subject matter not described or claimed in the foreign patent in addition to claims covering the invention described and claimed in the prior foreign patent.

As stated in the defendant's petition, this question was discussed under points 2 and 3 of the briefs in the Circuit Court of Appeals, both of the defendant and the complainants. A copy of the brief of the defendant in the Court of Appeals was attached to the defendant's petition for *certiorari,* and a copy of the complainants' brief in the Court of Appeals was attached to its brief in opposition to the said petition, which are respectfully called to the attention of this Honorable Court.

Point one of defendant is a contention that the Berliner German Patent No. 53,622, of November 20,

1889, embodies the reproducing sound box illustrated in Figs. 6 and 7 of the Berliner Patent 534,543 in suit, and claimed therein, and that this German Patent having expired on November 7, 1902, that the Berliner Patent in suit, No. 534,543, expired with it.

Point one also contends that the Berliner French Patent, No. 207,090, of July 19, 1890, embodies a sound recording device similar to that shown in Figs. 4 and 5, and a sound reproducing device similar to that shown in Figs. 6 and 7 of the Berliner Patent in suit, 534,543, and claimed therein, and that therefore this French Patent having expired July 19, 1905, that the Berliner Patent in suit, No. 534,543, expired with it.

These patents were not in evidence in the Graphophone suit, *manifestly because they were not regarded by the eminent counsel in that case as having any bearing upon the patent in suit.*

Judge Townsend in the Court below, on the motion for preliminary injunction, in passing upon this question said (R. p. 323):

> "I fail to find in the numerous cases cited by counsel, any authority for the proposition advanced by defendant, that if an article made according to the description of the prior foreign patent would infringe any claim of the American Patent, no matter how insignificant, then the two patents are for the same invention, and the American Patent expires in toto with the prior foreign patent. In fact, the interpretation placed by the Courts upon the decision of the Supreme Court in Siemens *v.* Sellers, *supra,* seems to be that the test is whether the principal invention of the domestic patent is found in the prior foreign patent.
>
> "I think from such brief examination as I have been able to give the authorities cited, that the rule contended for by the defendant does not apply to cases where the foreign patents which have expired do not cover the broad claims for the basic invention."

The German Patent, No. 53,622, is contained in the record (R. p. 150, etc.).

The French Patent, No. 207,090, is contained in the record (R. p. 126, etc.).

Assuming that this German Patent 53,622 was a patent of addition to German Patent No. 45,048, and expired November 7, 1902, with the German Patent 45,048 and that the French Patent No. 207,090 expired July 19, 1905, the complainants' contention is as follows:

Complainant's Contention Re German Patent No. 53,622, and French Patent No. 207,090.

1. These patents merely describe and claim only a sound box, and not the invention of claims five and thirty-five. If the specific sound box claims 24-34 of the Berliner Patent, No. 534,543, filed March 30, 1892, in suit, could be read upon in the sound boxes illustrated and described in the said German or French patents, filed in 1889 and 1890, respectively, or either of them, this fact, we submit, could not affect the fact that the **principal invention** of the patent in suit, viz—the broad invention of claims five and thirty-five had not been previously patented abroad so as to bring the **principal invention** of the patent within Section 4887 of the Statutes.

2. The sound boxes of these German and French patents also differ in detail construction from the sound boxes shown in Figs. 4, 5, 6 and 7 of the patent in suit.

We will consider the second point first.

The complainants contend:

The German Patent, No. 53,622, and the French Patent, No. 207,090, which were filed in 1889 and 1890,

respectively, were for specific detailed improvements relating only to the specific construction of sound boxes.

When Berliner filed his application for United States Patent, No. 534,543, in suit, March 30, 1892, it was for an entirely different invention, viz: his broad invention of claims five and thirty-five, as adjudicated by the Court of Appeals, and the detail construction of the sound box which he illustrated in Figs. 4, 5, 6 and 7, was not only quite materially different from the construction of sound boxes illustrated in the said German and French patents, which he had filed about two or three years previously, but the said sound boxes at best were for **minor details** of invention. Any sound box of the talking machine of that day—among others, such as shown in Berliner's prior United States Patent—could have been used in carrying out his **principal invention**—though this one might have been a preferred form. In these two or three years he had changed the construction of sound box, as hereinafter pointed out.

The complainants also show, for the other reasons hereinafter pointed out, that the German and French patents referred to can have nothing to do with the limitation of the term of the United States patent in suit.

1. The improvements shown in the German Patent, No. 53,622, and in the French Patent, No. 207,090, are admitted by the defendant to be specific improvements on Berliner's early sound boxes, such as shown in United States Patent, No. 372,786, and in the British Patent, No. 15,232, and the French and German patents corresponding thereto.

DRAWINGS OF GERMAN PATENT TO BERLINER NO. 53,622, NOVEMBER 20, 1889.

ie der Patentschrift 53622.

Emile Berliner in Washington. (Columbia, V. St. A.)

Neuerung an dem durch das Patent 45048 geschützten Verfahren und Apparat für das Registriren und Wiederhervorbringen von Tönen.

Fig. 1.

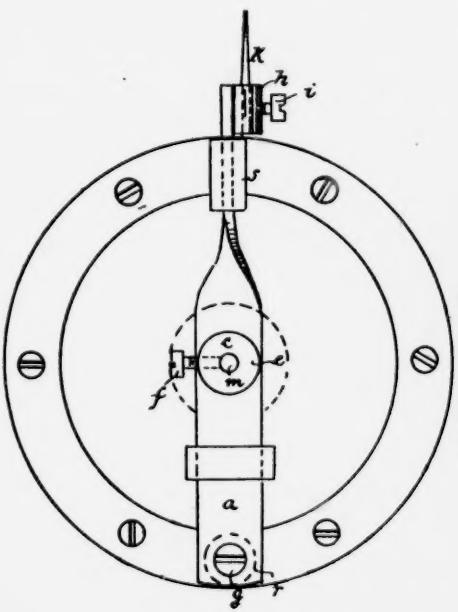
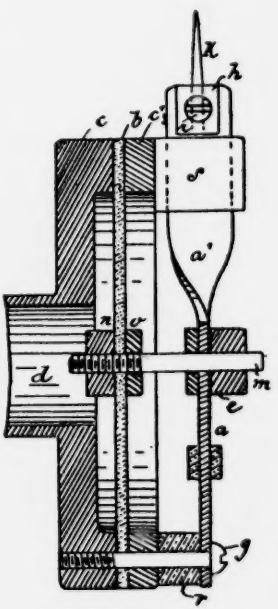


Fig. 2.



2. The German Patent, No. 53,622, is a second patent of addition upon the Berliner German Patent, No. 45,048, and is expressly so stated in the defendant's brief, and in the defenant's affidavits, and is stated in the body of this German Patent, No. 53,622, to be an "improvement upon the process and apparatus protected by Patent No. 45,048 for the recording and reproducing of sound." (This German Patent, No. 45,048, was in the answer in the Graphophone case.) It is further stated that it is a second addition to Patent No. 45,048, of November 8, 1887, and expires with that patent.

The specification of No. 53,622, as shown on page 64 of the defendant's opposing papers, refers back again to the chief Patent, No. 45,048.

3. This German Patent, No. 53,622, is therefore, an improvement on, and second patent of addition to German Patent, No. 45,048, of November 8, 1887, which is in defendant's answer in the Graphophone case, and is, therefore, in a sense, a part of it. (Transcript of Record, Graphophone case, p. 236.)

This French Patent, No. 207,090, is an improvement on the device described in the French Patent, No. 186,827, of November 8, 1887, which is also referred to in the said answer, and is mentioned in this French Patent of addition.

Defendant's counsel admits, in his brief:

> "It thus clearly appears that in Germany as in the United States, the improvements which Berliner describes in the construction of the details of the recorder and reproducer of the gramophone were improvements upon the gramophone set forth in his early German patent, as well as in his early United States patents."

The Claim of the German Patent 53,622.

The claim of this German Patent is (R. p. 153):

> "The replacing of the two armed lever (s) protected by claim 2b of the chief patent No. 45,048

and of the recording stylus (29) protected by claim 4b of the same, by a spring (aa') carrying the stylus for the reproduction of the sound, which with the one end is made fast to the casing (cc') enclosing the diaphragm, while the other end of the same can vibrate freely, so that the vibrations communicated to the latter are carried over by means of the pin (m) connecting the spring and the diaphragm at right angles to the surface of the diaphragm."

This construction is illustrated in Figures 1 and 2 in the drawing of the German Patent (R. p. 154).

This claim shows that it is a reproducing sound box of the peculiar construction as an improvement for the chief German Patent, No. 45,048 (R. p. 132), which is said to correspond to the British Patent, No. 15,232, of 1887, shown in the drawings of Record, pp. 516, etc.

Re Berliner French Patent, No. 207,090, of July 19, 1890, for Sound Box.

The drawings of the French patent show two views of a recording sound box, Figures 1 and 2; and a reproducing sound box, Figures 3 and 4. (R. p. 131.)

Figures 3 and 4 of this French patent are for a reproducer.

The construction shown in Figs. 3 and 4, while it differs somewhat in detail from the construction shown in Figs. 1 and 2 of the German Patent, No. 53,622, yet in general construction and operation is substantially the same.

In these figures of the French patent the stylus bar or spring F is *positively mechanically* connected with the diaphragm B, as is also true in the construction shown in the German patent, so that as the stylus is vibrated laterally, it will *positively move the diaphragm in both directions.* This is not true in the construction shown in Figs. 4 to 7 of the Berliner U. S. Patent, 534,543, in suit, where the stylus bar is not positively connected and involves a very different operation.

DRAWINGS OF FRENCH PATENT TO BERLINER NO. 207,090 OF JULY 19, 1890.

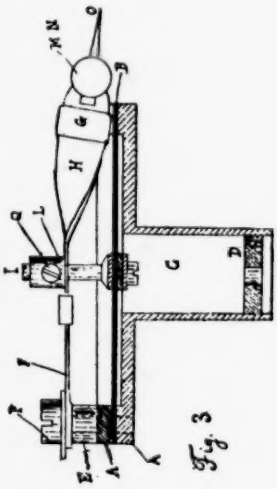


Fig. 3

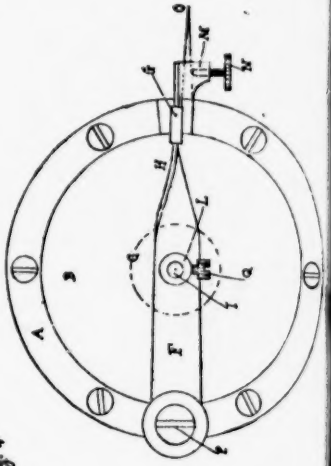


Fig. 4

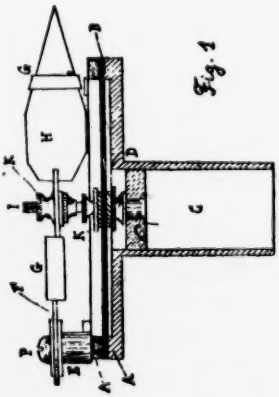


Fig. 1

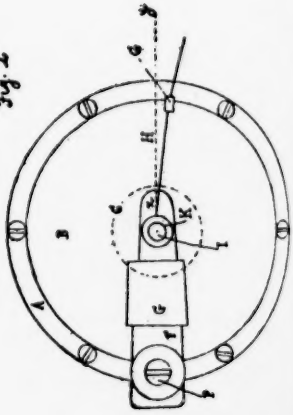


Fig. 2

Manifestly, the sound boxes illustrated and described in the German Patent, No. 53,622, and the French Patent, No. 207,090, are so materially different in construction, and in operation, from those illustrated and described in Figs. 4 to 7 of the Berliner U. S. Patent, No. 534,543, in suit, that they are not, and cannot be construed to be, the same invention, but embody different constructions invented and devised by Berliner at another time. Which invention was the better in construction, and operation, the U. S. invention or the invention shown in the foreign patents, there is no evidence.

The German Patent 53,622 was filed and bears date November 20, 1889; the French Patent, No. 207,090, was filed and bears date July 19, 1890.

The U. S. Patent, No. 534,543, was filed March 30, 1892.

Not only does the U. S. Patent, No. 534,543, Figs. 4 to 7, differ materially from the French and German patents, but the French patent also differs from the German patent.

Berliner, evidently between the date of the French patent and the date of filing of the United States patent in suit, had experimented and found the improvement described in the United States Patent to be the better.

These German and French patents describe and claim only a sound box and do not include the invention of claims five and thirty-five.

The attention of the Court is called to the sheet bound at the end of this brief (a disconnected sheet having been handed up at the argument) showing comparatively the drawing of the Patent No. 534,543 in suit, and the drawings of these French and German patents.

It is Apparent That Berliner Regarded the Specific Sound Box of the German Patent, No. 53,622, and French Patent, No. 207,090, as Quite a Different Invention From the Invention, the Subject Matter of the U. S. Patent, No. 534,543, in Suit.

This is evidenced by

(1) The fact that he stated, in the oath of the subsequent U. S. application for the patent in suit (Record, p. 298 Graphophone case) "that the same has not heretofore been patented to him or to others, with his knowledge or consent in any foreign country——"

(2) By the fact that this German and French patent were stated therein to be improvements on the Berliner construction shown in the prior German patent, No. 45,048, of which it was a patent of addition, and in the prior French Patent, No. 207,090, of which it was stated to be an improvement. These prior German and French patents were set forth in the answer in the Graphophone case, and corresponded with the British Patent, No. 15,232, of November 8, 1887, also set forth in the answer.

(3) That the construction of sound box in the Berliner German Patent, No. 53,622, and the French patent, No. 207,090, differed materially from that shown in Figs. 4 to 7 of the U. S. Patent filed two to three years later, showing that Mr. Berliner in the meantime had changed the construction, as hereinbefore pointed out.

(4) The fact that the U. S. construction differed from the construction of these prior German and French patents is further evidenced by the fact that the U. S. Patent Office, in considering the Berliner U. S. application for the patent in suit, did not cite either, or any of these prior foreign *patents,* as a reference

against the claims. (See Record, Graphophone case *file* of No. 534,543, pp. 275 to 319.)

In the case of the Welsbach Light Co. *v.* Rex Incandescent Co., 94 Fed. Rep., 1006, Judge Lacombe, in deciding that the foreign patent was not identical with the U. S. Patent, said:

> "That he (the inventor) himself, regarded the two processes as involving different inventions is apparent from the history of the abandoned application for United States patent——"

Judge Lacombe also decided in that case:

> "What Welsbach disclosed in those earlier patents was a subsidiary treatment, which lay closely within the lines of his original invention——"

The most that can be contended for in this case by the defendants, is that the sound box of the German and French patents was for a subsidiary detail of improvement.

It is respectfully submitted, even if the said sound boxes of the German and French patents were the same as shown in Figs. 4 to 7, of the U. S. patent, that the prior patenting abroad of a **minor detail**, described and claimed in the subsequent United States Patent, does not and cannot and never was intended to operate to invalidate the **principal invention** of the patent, and that any such contention is contrary to the letter and spirit of Section 4887, and contrary to the decisions of this Court and the other Federal Courts, interpreting the said Statute. It is, therefore, desired now to consider the authorities and fallacy of the defendant's position upon this point.

Defendant's Contention Based on a False Premise.

The defendant, in substance, contends that a patenting in a foreign country of a **part or detail** of an invention contained in a U. S. Patent prior to the U. S. Patent forfeits the whole U. S. Patent at the expiration of the foreign patent. In other words, that the prior patenting abroad of a specific form of a detail of construction which might be used or employed in carrying out the principal invention would operate to invoke the statute, if the home patent should happen to contain a claim for such specific detail.

We submit that even if the sound boxes patented in Germany and France had been the same as the sound boxes illustrated and described in Figs. 4, 5, 6 and 7 of the patent in suit, that the patenting of these details or subsidiary portions of the patent in suit, No. 534,543, in a foreign country prior to the U. S. Patent could not possibly forfeit the U. S. Patent.

A different proposition might be maintained if the device patented in the foreign country, instead of being small details of the U. S. Patent and a subsidiary portion, had been the broad, main invention of the U. S. Patent, in addition to the minor improvements, and the suit had been upon a detailed minor improvement.

There is a very marked difference between such propositions.

The invention of the patent in suit, No. 534,543, as adjudicated by the Court of Appeals, is the **broad, main invention,** consisting of the traveling tablet having a sound record formed thereon, and a reproducing stylus shaped for engagement with the record free to be vibrated and propelled by the same across the face of the record, and the method for accomplishing the same.

The detail construction of the sound boxes illustrated and described in Figs. 4, 5, 6 and 7 was clearly subsidiary. Any suitable construction of sound box could be used carrying out the broad invention.

Defendant's counsel also makes a strenuous effort in order to show a relation between this German Patent and claims five and thirty-five, to put upon these claims a limited interpretation at variance with the decision of the U. S. Circuit Court of Appeals in the Graphophone Case, so that it may be made to appear that claims five and thirty-five related to the wedge-shaped stylus of this reproducing sound box, and did not relate to the automatic simultaneous method of vibrating and propelling the stylus by and through the medium of the record across the face of the record disc. (See defendant's brief, attached to the petition in this case, pp. 42 and 43.) He, however, makes no reference to claim thirty-two in this connection, which calls for a reproducing stylus having a wedge-shaped point engaging the walls of the record groove.

Several minor detail claims of the patent in suit, 534,543, probably embody the elements and features of the sound box illustrated and described in the said German Patent, 53,622, and French Patent, 207,090, but complainants contend most emphatically that the **broad principal invention** of claims five and thirty-five is nowhere illustrated, described or claimed or in any wise hinted at, in either of these German or French patents, and that under the law as understood from the authorities even if a prior foreign patent may contain certain detail features which happen to be embodied in a subsequent U. S. Patent for a broad generic invention, the essential features of the **principal** invention of the said U. S. Patent cannot be affected by the expiration of the foreign patent. As stated by Judge Townsend, in granting the motion in the Court below:

> "In fact, the interpretation placed by the Courts upon the decision of the Supreme Court in Siemans *v.* Sellers, *supra*, seems to be that the test is whether the *principal* invention of the domestic patent is found in the foreign patent." (R. p. 323, Fol. 969.)

CONSIDERATION OF THE AUTHORITIES.

Siemens, et al., v. Sellers, et al., 123 U. S. 276.

The defendants have cited and seem to rely, in support of their contention in this regard, upon the case of Siemens, *et al., v.* Sellers, *et al.,* 123 U. S. 276.

The *facts* in this case are essentially and substantially different from the facts of the case at bar. In the Siemens case the main invention was illustrated, described and claimed in the prior British Patent. On this point the Court said, in an opinion by Mr. Justice Bradley:

> "As to the first question we have carefully compared the two patents, the English and American, and can see no essential difference between them. They describe the same furnace in all essential particulars. The English specification is more detailed, and the drawings are more minute and full; but the same thing is described in both. There is only one claim in the English patent, it is true. Bnt that claim, under the English patent system, entitled the patentees to their entire invention, and is at least as broad and comprehensive as all four claims in the American patent."

There is nothing in that case which is authority for defendant's proposition that, if a minor feature of the U. S. patent happens to be patented abroad before the U. S. patent separately and independently of the main feature of the U. S. patent, that the expiration of that patent forfeits the entire U. S. patent. Such a proposition is absolutely contrary to the intent of Sec. 4887, and has no support in any of the authorities.

Mr. Justice Bradley, in the Siemens case, based his opinion manifestly upon the fact that the "*principal invention is in both patents.*"

He did say that, if the American patent contained additional improvements, that is, outside of the "prin-

cipal invention," that "this fact cannot save the patent from the operation of the law."

It is by no means a fair assumption that Justice Bradley meant to say that the prior patenting abroad of any isolated detailed feature of a U. S. Patent would forfeit the principal invention.

Mr. Justice Bradley's opinion throughout is based upon the question of whether, or not, the *principal invention* was previously described and claimed in the prior English patent, and he found that it was.

Defendant's Counsel Appears to Rest His Whole Contention in This Connection Not Upon the Spirit of the Decision of Siemens v. Sellers, but Upon a Misconstruction of a Short Sentence by Justice Bradley, viz., "a Patent Cannot be Construed as Running Partly From One Date and Partly From Another."

Defendant's counsel predicates his whole argument relative to this branch of the case upon these few words of Mr. Justice Bradley, which he adopts as his text, and attempts to construe and to carry to an extent which Justice Bradley obviously never intended.

As pointed out by the Court of Appeals in Westinghouse *v.* Stanley Improvement Company, 138 Fed. Rep., 623, *there has been too much tendency to misinterpret this decision.*

In Siemens *v.* Sellers the prior English patent, which the Court held limited the term of the U. S. Patent, described the same regenerative furnace in all essential particulars, and the claim of the English patent, as stated by the Court, entitled "the patentees to their entire invention, and is at least as broad and comprehensive as all four claims in the American patent."

It is obvious that that decision was authority for

the proposition that, where the **principal** invention is contained in both patents, the American patent will be limited to the term of the prior foreign patent.

It is equally obvious, and true, we submit, that it is authority for the converse proposition that the foreign patent, in order to come within the statute, Section 4887, *must contain the principal invention of the U. S. patent sought to be curtailed thereby.*

As appears by the decision in that case the original patent was issued while the Act of 1839 was in force, which, as cited by Mr. Justice Bradley,

> "allowed a patent to be taken out here at any time after the inventor had taken out a patent for the same invention in a foreign country, provided it should not have been introduced into public and common use in the United States prior to the application for a patent here; AND *provided also,* that in all cases every such patent shall be limited to the term of fourteen years from the date or publication of such foreign letters patent'."

Justice Bradley also pointed out the subsequent legislation, comparing it with the Act of 1839, which provided, under such circumstances, that the American patent should *expire* at the same time with the shortest term foreign patent. The Court also stated:

> "We are of the opinion, therefore, that the condition imposed by the Act of 1839, that the term of a patent for an invention which has been patented in a foreign country shall commence to run from the time of publication of the foreign patent, was not repealed or abrogated by the Act of 1861——"

It is clear, therefore, what Mr. Justice Bradley had in mind when he made this statement upon which the defendant's counsel has laid so much stress, viz:

"A patent cannot be exempted from the operation of the law by adding some new improvements to the invention; and cannot be construed as running partly from one date and partly from another."

The Court evidently meant that as the principal invention was shown in both the foreign and domestic patents, the adding of certain additional detail improvements to the American patent could not allow it to be "construed as running partly from one date and partly from another." It will be noticed that the word "and" is used in the sentence, and that, therefore, a fair interpretation may be that this conjunction "and" joins the second portion of the sentence to the first.

Further, even if the statement referred to is a disconnected statement, it was an *obiter* of the Court which was not necessary to the facts of the case, as the principal invention was found in both; and,

Further, under the Act of 1839, under such circumstances the U. S. patent *ran for fourteen years from the date of the prior foreign patent;* for instance:—claims for the detail improvements in the American patent, not described in the foreign patent, would run from March 1, 1864, the date of the original U. S. patent, while the claims for the principal invention would have been running for fourteen years from the date of the prior English patent.

This running from different dates might lead to some confusion, as suggested by Justice Bradley, but the law was subsequently changed by Section 4887 of the Revised Statutes, which tended to correct any such confusion arising in such cases, so that under all circumstances *the date from which the patent ran would be the same date,* the date of the U. S. grant, so that the inventions of the claims such as were patented in a prior foreign patent would expire with the term of the foreign patent having the shortest term to run.

Under the Laws of the U. S. the Failure of Some of the Claims Does Not Invalidate the Entire Patent.

This, therefore, places the claims of the U. S. patent regarding validity, or invalidity, by reason of the expiration of a prior foreign patent, upon the same basis as the declaration of a Court as to the invalidity of one, or more, claims of a U. S. patent, by reason of proof of ANTICIPATION of such claims. Under the laws of this country, the remaining claims unanticipated continue to exist for the term of seventeen years from the date of the patent.

Under the laws of this country, one of the objects of allowing a multiplicity of claims in a single patent is to preserve to the inventor his substantial rights for the thing which he invented, even though a part, such as he may have claimed in other claims, may have been found to be invalid. His rights, therefore, to the principal invention, or to such parts of his invention, claimed in claims which remain unanticipated, are still preserved to him.

This theory of the law is as equally applicable to such claims of his invention as may have been patented previously abroad.

This is in thorough accord with the letter and spirit of Section 4887.

The intent of the Act is that the prior patenting abroad shall not debar a person from receiving a patent in this country; the statute so specifically states; and starts out with that statement:

> "**No person shall be debarred** from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country—"etc.

The Act, later, goes on to state:

"But every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term——"

This does not mean that an invention which may be contained and claimed in the U. S. patent, but not embodied or incorporated in any prior foreign patent, shall run for a less period than seventeen years.

Therefore, it is obvious that the main invention of a domestic patent cannot be invalidated, under our system of claims, by the mere fact that some detailed minor specific form, separately claimed in a United States patent, has previously been patented abroad.

CONSIDERED FURTHER.

The Act says "*an invention.*" Under our system of patenting, each claim, for the purposes under consideration, is practically a separate invention.

The Court said in United Nickle Co. *v.* California Electrical Works, 25 Fed. Rep., 475,479:

"Each claim is in effect a separate and distinct patent."

Gage *v.* Herring, 107 U. S. 640, 646;
Leggett *v.* Standard Oil Co., 149 U. S. 287, 293.

The Supreme Court stated in Carlton *v.* Bokee, 17 Wall, 463, 472:

"One void claim, however, does not vitiate the entire patent."

And, again, in Russell *v.* Place, 94 U. S., 606, 609:

> "A patent may be valid as to a single claim and not valid as to others."

And Judge Wallace said in Celluloid Mfg. Co. *v.* Zylonite Brush & Comb Co., 27 Fed. Rep. 291, 294;

> "Each claim of a patent covers a complete invention, and is, in substance, an independent patent."

CONSIDERED IN ANOTHER LIGHT.

It is further submitted that even if defendant's contention and construction of Section 4887 were true, the prior patenting of a minor detail of the invention in a foreign country should not affect the term of the **principal** invention of the U. S. patent, for the reason that if the contention just advanced regarding the patent system of this country as to separate claims be not true, the prior patenting of a *part* of an invention in a foreign country would not be previously patenting abroad *the invention.*

The Statute says, "every patent granted for an invention which has been previously patented in a foreign country—" etc. If, under this interpretation, a single U. S. patent is to be regarded as containing but a single invention, then the patenting in a prior foreign patent of a detail part of the invention is not a prior patenting abroad of the invention. The Act says, "any patent granted for an invention."

If this is to be understood as meaning that there is but one invention in a domestic patent, then, as before stated, the prior patenting abroad of a minor or detailed part of that invention is not a prior patenting abroad of the invention of that domestic patent. At most, it is the prior patenting only of a part of an invention.

It cannot be construed to be the patenting abroad of the principal invention or the essence of the invention.

This apparently is the dominating thought which has influenced the Courts.

Therefore, under this construction, in order to bring a domestic patent within the terms of Section 4887, the whole or principal invention of the domestic patent must have been previously patented abroad.

The Statute manifestly contemplated the principal or essence of the invention, not a minor part.

On the other hand, however, if the other construction be given to the Statute, that under the U. S. system **each claim** contains practically a **separate invention**, then those claims, the subject matter of which has been previously patented abroad, can only be affected by the expiration of the prior foreign patent.

As hereinbefore pointed out, the defendants have not produced a single decision where the Court, under such circumstances, has held a U. S. patent to have expired for the principal invention.

Such an inequitable rule contended for by defendant's counsel, is contrary to the theory and policy of the patent system of this country, and if carried out, would strike at the very foundation of the system.

This theory might pertain with more force in England, and perhaps some of the continental countries, where a patent, bad as to one claim, is invalid as to all. The policy of this country, however, is diametrically opposed to such theory, and allows each claim to stand or fall, independently of the other claims.

> "Every reasonable doubt relevant to any such question should be resolved in favor of the patent, for the law does not favor forfeiture."

Pitt *v.* Hall, 2 Blatchf. 238;
McCormick *v.* Seymour, 2 Blatchf. 256;
Brown Cork & Seal Co. *v.* Aluminum Stopper Co., 108 Fed. Rep. 850;
Walker on Patents, Sec. 108 (4th Ed.)

Defendant's Contention That the Patenting of a Minor Detail in a Foreign Country Previous to the Patenting of the Broad Generic Invention in the United States Forfeits the United States Patent as a Whole, is Contrary to the Letter and Spirit of Sec. 4887.

This is shown by the authorities heretofore cited. Section 4887 says:

"But every patent granted for an invention which has been previously patented in a foreign country shall be so limited——"

This brings us to the question of what is *the invention* of the patent in suit.

What is the Invention of the Patent in Suit?

This Court of Appeals has decided this, and has held that it is the invention specified in claims five and thirty-five.

To now forfeit this patent because of the previous patenting of a minor detail abroad—if such was the case—would be to say that that detail of the sound box was *the invention* of the patent and practically overruled the decision of the Court of Appeals as to what was the invention of the patent.

Any doubt regarding the construction and application of this Statute should be resolved in favor of the patent.

The Court of Appeals for the First Circuit, in

Westinghouse Electric Co. *v.* Stanley Improvement Co., 138 Fed. Rep. 823, has pointed out how the case of Siemens *v.* Sellers, 123 U. S. 276, has been misinterpreted, and referring to the fact that the tendency should be, especially in view of the repealing of this old law, to relax rather than extend the interpretation beyond its letter. (See page 827.)

This Westinghouse case also points out that there has been too much of a tendency to misinterpret this decision in the case of Siemens *v.* Sellers, and says:

> "The petitioner especially relies on what is said near the foot of page 194 of 135 U. S. page 724 of 10 Sup. Ct. (34 L. Ed. 88), that the test is whether, if a person in the United States, after the issue of the United States Patent, should commence the manufacture of a patented article by the precise process described in the foreign patent, the Court would properly restrain him. To begin with, this, as already said, is a mere quotation from the opinion of the Circuit Court, and not an expression devised by the Supreme Court; and it is not to be assumed that where an appellate tribunal, as in this case, quotes long extracts, it is held to be bound by all the expressions contained in them."

The fact is that Siemens *v.* Sellers is to be understood as deciding the case before it, and that all that case really did decide was that as the "*principal invention*" was previously patented abroad, that the United States Patent expired with the foreign patent.

This decision did say that the fact that some "new improvements to the invention" were added to the U. S. Patent, would not save it. We do not contend to the contrary.

Re Invalidating Certain Claims, and Not Others.

We strenuously contend that the Supreme Court, when it said that a patent "cannot be construed as running partly from one date and partly from another,"

did not mean to say that the invalidating of a minor claim by the expiration of a prior foreign patent would invalidate the whole U. S. Patent.

This is contrary to the doctrine of interpretation of United States Patents.

The anticipation, or invalidating of one claim of the U. S. Patent does not by any means according to the well-settled authorities, invalidate the whole patent. This may be true in England, but not in the United States.

There is really no reason why a single claim invalidated by the expiration of a foreign patent should invalidate all the other claims with which the foreign patent had nothing whatsoever to do.

There is no more reason for this than there would be that all the claims of the U. S. Patent should be invalidated because a single claim should be found to be anticipated.

The construction which the defendant seeks to put upon this case that the patenting of a minor detail previously abroad invalidates the broad invention of the subsequent U. S. patent, is contrary to the spirit, as well as the letter, of Sec. 4887, and is contrary to all the authorities regarding the interpretation of the claims.

Sawyer Spindle Co. *v.* Carpenter, 133 Fed. Rep. 238, though it did not decide, it assumed, for the sake of argument, that a patent may be limited in the term by a foreign patent as to some of its claims, and not as to others.

Therefore:

Even if the detailed construction of the sound box of Figs. 4 to 7 of the U. S. patent had been previously patented in the German and French patents, which is not admitted, there is no warrant in the authorities, we submit, under the circumstances of this case to invalidate the *principal invention* of the U. S. patent in suit.

Not one case has been cited by the defendant where the substantial invention of the patent has been declared forfeited by reason of the prior patenting in a foreign country of a minor detail.

In all the authorities, however, which have been considered where it was held that the prior foreign patent limited the domestic patent, the *substantial invention* of the U. S. patent had been patented in the prior foreign patent, or the *invention* of the foreign patent has been so nearly like the *substantial invention* of the U. S. patent as to render them practically one and the same.

Where they have not been substantially one and the same, the defence has failed.

Aquarama Co. *v.* Old Mill Co., 124 Fed. Rep. 333;

Welsbach Light Co. *v.* Rex Incandescent Co., 94 Fed. Rep. 1006;

Electric Accumulator Co. *v.* Brush Electric Co., 52 Fed. Rep. 130.

See also

Westinghouse Electric Co. *v.* Stanley Instrument Co., 138 Fed. Rep. 823.

Is the principal invention of the domestic patent found in the foreign patent? Is the subject matter of one the same in all essential particulars as that of the other?

These were the main tests applied in Siemens *v.* Sellers, 123 U. S. 276.

See also

Accumulator Co. *v.* Julien Electric Co., 57 Fed. Rep. 605;

Robinson on Patents, Vol. 2, Sec. 623, says:

"In order that the term of the foreign patent may thus limit that of the domestic patent, it is essential that the inventions covered by the two patents should be identical."

In this connection, Judge Townsend, in delivering the opinion of the Circuit Court, said (R., p. 323):

> "I fail to find in the numerous cases cited by counsel any authority for the proposition advanced by defendant that if an article made according to the description of the prior foreign patent would infringe any claim of the American patent no matter how insignificant, then the two patents are for the same invention and the American patent expires *in toto* with the prior foreign patent. In fact, the interpretation placed by the Courts upon the decision of the Supreme Court in Siemens *v.* Sellers, *supra*, seems to be that the test is whether the principal invention of the domestic patent is found in the prior foreign patent."

The same strict requirement recognized by the authorities as to **anticipation** by a prior patent or publication under Sec. 4886, requiring exact description of the patented thing claimed, should be observed in construing Sec. 4887.

We submit that there should be no doubt as to the complainants' contention.

ADDITIONAL AUTHORITIES CONSIDERED.

Western Electric Co. v. Citizens' Tel. Co., 106 Fed. Rep. 215.

This case is a decision of Judge Severens, of the Michigan Circuit, following the decision of Siemens *v.* Sellers, *supra.*

The decision of this case incorporates a considerable portion of one of the foreign patents to show that "the essence of the patent in suit" was contained in the expired foreign patent. The patent was for improvements in telephone exchange system and apparatus, and while the foreign patents differed somewhat in the description from the home patent, it con-

tained the "essence of the patent in suit." The Court said:

> "**But, what is more directly to the point,** the **essence** of the patent in suit contained in the first claim thereof, namely, the cutting out of the annunciator from the circuit employed for conversation, is embodied in the description of the invention in the foreign patents. The construction given in the specifications necessarily involves it. The case is, therefore, brought under the operation of the rule laid down in Siemens' Adm'r *v.* Sellers, 123 U. S. 276, 8 Sup. Ct. 117, 31 L. Ed. 153, even though it be conceded that there are differences in some details between the foreign and the home patents upon which independent claims might be based."

It is, therefore, clear that the conditions of this last mentioned case were the converse of the conditions of the case at bar, even supposing Figs. 4, 5, 6 and 7 to have been in the German and French patents, which they were not.

It is not fair, therefore, and there is no warrant for assuming, as the defendant does, that when the Court in this latter case, as in the Siemens case, referred to a patent expiring in parcels, that it meant to support the defendant's contention. In both cases the main and substantial invention was patented abroad. In the case at bar what was adjudicated by the Court of Appeals to be the main and substantial invention, or "the essence of the patent in suit," has not been patented abroad.

The citation from the Federal Statutes Annotated, Vol. 5, p. 470, cited in defendant's brief (p. 58), attached to its petition for *certiorari,* is based upon the case of Siemens *v.* Sellers, hereinbefore considered, and the statement contained can be construed as no broader than the decision of Siemens *v.* Sellers. None of the other decisions cited go any further, nor do they support the defendant's contention in this case.

Commercial Mfg. Co. v. Fairbank Canning Co., 135 U. S. 176.

In this case also the principal invention of the U. S. patent was previously patented in certain foreign countries, among them Bavaria and Austria. It was a process for treating animal fats. The complainants contended that the subsequent U. S. patent differed in various respects from the invention patented abroad. The foreign patent purported to be for the basic, broad invention, and the Court held that it was. It also held that the features of differences in the American patent were "purely wholly differences in degree."

It is, therefore, evident that a very different condition of facts existed in this case of the Commercial Manufacturing Company *v.* Fairbank Canning Co., and that the statements of the Court had application to these conditions, which do not exist in the case at bar.

According to the defendant's contention and interpretation of the authorities, if a peculiarly shaped arm for attaching certain parts to the receiver of preferable construction, had been previously patented in Germany and claimed in the Bell Telephone U. S. patent, the broad claims for the basic invention of the U. S. patent for the transmission of speech would have expired with the expiration of the foreign patent for the peculiarly shaped arm.

There is nothing in any of the authorities to warrant such an interpretation of Sec. 4887.

Clark v. Wilson, 28 Fed. Rep. 95.

This case is also cited by the defendant. It appears that the claims of the U. S. patent in that suit were the same claims as in a prior English patent which had expired, which illustrated and described the same invention as in the U. S. patent for improvement in

Corrugated Metallic Rolling Shutters. The Court, in the decision of Judge Wheeler, said:

> "The question on this provision of the Statutes is whether the invention patented in this patent is the same as that patented in the English patent. The only thing added is the fastening of the strips, before fastened at the ends, at such intermediate points as should be required. This was such an obvious thing to do, to avoid their 'rucking up,' which the inventor testifies would prevent the operation of the device, as not to appear to amount to any real invention by itself."

Judge Wheeler found that the substance of the invention was patented in the English patent prior to this patent, and that the claims were substantially the same.

Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co., 33 Fed. Rep. 254.

This case, cited by the defendant, we submit is not in point. It turned almost wholly upon the question of abandonment, and Judge Coxe's decision practically included no consideration of this question of identity and forfeiture by reason of the expiration of the prior foreign patent. His only reference is at the conclusion of the opinion, where he refers to Insurance Co. *v.* Sellers, 8 Sup. Ct. Rep. 117. Judge Coxe, here in quoting from the decision, has italicized the statement:

> "*The principal invention is in both;* and if the American patent contained additional improvements, this fact cannot save the patent from the operation of the law which is invoked, if it is subject to that law at all."

Judge Coxe by this statement evidently understood Justice Bradley's decision in Siemens *v.* Sellers to mean that the *principal invention* must be found in both patents.

Accumulator Co. v. Julien Electric Co., 57 Fed. Rep. 605.

This case is cited by the defendant. It is a decision of Judge Coxe in the Circuit Court. The facts are materially different from the facts in the case at bar. The invention was for secondary batteries, and Judge Coxe found that the *principal invention* was clearly embodied in the prior Spanish patent for the product.

It is submitted that the decision of Judge Coxe is favorable to the complainants in this case, in that it, in substance, holds that the *principal invention* of the U. S. patent must be in the foreign patent in order to anticipate. He says:

> "In the leading cases of Siemens' Adm'r *v.* Sellers, 123 U. S. 276, 8 Sup. Ct. Rep. 117, and Commercial Manuf. Co. *v.* Fairbank Canning Co., 135 U. S. 176, 10 Sup. Ct. Rep. 718, the Supreme Court has made the test of identity to depend upon the following propositions. Is the *principal invention* of the domestic patent found in the foreign patent?"

And then refers to other tests.

J. L. Mott Iron Works v. Henry Co., 80 Fed. Rep. 516.

In this case, cited by the defendant, it appears that the inventor had invented a construction of balanced float attached to the valve spindle of an outlet in closet constructions, and had previously patented substantially the same thing in Canada, as in the later U. S. patent in suit. The principal invention in the U. S. patent was patented in the Canadian patent. Judge Wheeler said:

> "*The identity of invention patented required by the statute is of material substance, and does not extend to minor details,*" citing Siemens *v.* Sellers, 123 U. S. 276.

This case supports the complainants' contention that the doctrine of Siemens *v.* Sellers "*does not extend to minor details,*" such as the specific construction of sound box of Figs. 4 to 7, but has reference to cases where the principal invention, such as claims five and thirty-five were found in the foreign patent.

The case of Oval Co. *v.* Sandy Co., 60 Fed. Rep. 295, cited by the defendant, appears to have no bearing upon the question.

Williams Co. v. Miller Co., 108 Fed. Rep. 967.

In this case, cited by the defendant, the prior British patent covered two other patents of the patentee, and included *the whole invention of the U. S. patent in suit.* This, therefore, has no bearing upon the proposition before us.

Aquarama Co. v. Old Mill Co., 124 Fed. Rep. 229.

This case is cited by the defendants, but practically supports the complainants' contention that the prior foreign patent, in order to limit the U. S. patent, must be for the principal invention of the U. S. patent. It also supports the complainants' contention that as between the sound boxes illustrated and described in the U. S. and in the French and German patents, there are differences which are important and occasion a difference in operation. The British patent in the Aquarama case differed in that the longitudinal partition in the Pleasure Canal in the U. S. patent extended through the center to the ends, dividing the canal entirely, while in the British patent it was left open at each end, *which made a material difference.*

Mr. Hicks, defendants' counsel, criticises this decision and contends that the question decided was not fully argued, though we submit this statement of coun-

sel should go for nothing, as there is no evidence to support this statement.

We agree with Mr. Hicks, however, in his statement that Judge Thomas did not hold contrary to the decision of the Supreme Court in Siemens *v.* Sellers, which latter decision merely held, in substance, that where the *principal invention* of the U. S. patent is previously patented abroad, the U. S. patent is limited.

It is submitted that the case of Miller *v.* Eagle Manf. Co., 151 U. S. 186, has no bearing upon the present case.

Sawyer Spindle Co. v. Carpenter (Circuit Court), 133 Fed. Rep. 238.

This case is a decision of Judge Brown, of the Rhode Island Circuit. In this case the Court did not decide the proposition raised that,

> "Though the patent in suit may have expired as to four of its claims, it may still exist as a valid patent for the invention of the fifth claim."

but said,

> "But assuming, for the argument only, that a patent may be limited in term by a foreign patent as to some of its claims, and not as to others, that it may expire in part and survive in part—it would still seem impossible that a single *claim* should in part expire and in part survive."

And the decision in the case was on this latter proposition.

Sawyer Spindle Co. v. Carpenter (Court of Appeals), 143 Fed. Rep. 976.

This is the decision on appeal in the preceding case and the opinion by Judge Lowell, written for the Court

of Appeals of the First Circuit, leaves no doubt but that the Court was clearly of the opinion that if the fifth claim of the patent in suit had not been substantially identical with the claims of the British patent, the Court would not have held that the American patent was limited by said British patent, although it was admitted that the first four claims of the American patent were substantially identical with the first four claims of the British patent, and that said first four claims of the American patent had expired with said British patent.

After briefly stating the facts of the case, and pointing out that the date of the British patent was prior to that of the American patent and had expired, the opinion states:

> "The first four claims of the patent in suit are admitted to be substantially identical with the first four claims of the British patent, and to have expired with them."

If the Court of Appeals in this case had considered the law to be that if any of the claims of the American patent are for the same invention as any of the claims of the British patent, the American patent expires *in toto* upon the expiration of the British, it would not have been necessary for said Court to go into an exhaustive and minute comparison of the fifth claim of the American patent in that suit, to determine whether that was identical with the invention of the British patent, as such an inquiry would have been unnecessary. But the Court's action in that case, after stating that only the fifth claim of the American patent was in suit in that case, and then stating that it was the complainant's contention that that fifth claim differed from any claim in the British patent in carefully comparing in detail the elements of that fifth claim with the subject-matter of the claim of the British patent, and in point-

ing out in detail where the subject-matter of this claim five was substantially identical with the claims of the British patent, leads inevitably to the conclusion that the said Court of Appeals of the First Circuit considered that if this fifth claim of the American patent was not substantially identical with the invention of the claims of the British patent, that said American patent in suit could have been sustained as to the fifth claim, although claims 1 to 4 of said American patent were admitted to be substantially identical to the claims of the British patent, and to have expired with the latter.

And so it is with all the decisions which have been brought to our notice. The Courts have carefully and critically compared the claims of the American patent in suit with the prior foreign patent, to determine whether the subject-matter of the claims in suit were substantially identical with the foreign patent, notwithstanding the fact that there was no dispute that other claims of the American patent were substantially identical with the foreign patent. In all these cases the Courts have gone to the time and trouble to determine the identity, or lack of identity, between the claims of the American patent in suit, and the subject-matter of the foreign patent, and throughout all these decisions we see that the underlying rule is that the foreign patent, to limit a later U. S. patent, must contain the principal invention or the essence or essential features of the American patent, and that reading Siemens *v.* Sellers, *et al.,* and Commercial Co. *v.* Fairbanks, as indicated by Judge Putnam in Westinghouse E. & M. Co. *v.* Stanley Co., 138 Fed. Rep. 823, we find that the tests referred to by the Supreme Court were tests that were sufficient for the cases then under consideration, and that, being sufficient, it was unnecessary to set any qualification with reference thereto, but that in other cases, where the conditions were entirely

different, the test was not sufficient and the rulings in Siemens *v.* Sellers and Commercial Co. *v.* Fairbanks were so interpreted and applied by the said Circuit Court of Appeals for the First Circuit.

Westinghouse Co. v. Stanley Co., 138 Fed. Rep. 823.

While this case is cited by the defendants, a reading of the case will show that it is quite in accord with the complainants' contention that the Rev. Stat., Sec. 4887, was not intended to be so broadly construed as to occasion the forfeiture of the principal invention of a subsequent U. S. patent by reason of the expiration of a prior foreign patent, which happened to claim only one minor detailed feature of the U. S. patent. This Westinghouse case is a decision of the Court of Appeals of the First Circuit, by Judge Putnam. This is one of the later cases, and the Court considers the error of the prior tendency of some of the cases to extend the meaning of the Statute, Sec. 4887. The Court says:

> "These positions find no support in the natural reading of Section 4887 of the Revised Statutes; and the provisions of this section are too severe, as apparent to the ordinary comprehension, and as has been since declared by Congress by its amendments thereto, to justify any relaxation which would extend it beyond its letter. No authorities can be found to sustain the petitioner on this point, unless it is an expression in Walker on Patents (4th Ed., 1904), 150. The learned author there cites as authority for the proposition Commercial Company *v.* Fairbank Company, 135 U. S. 194, 10 Sup. Ct. 718, 34 L. Ed. 88, already referred to, as also does the petitioner; but a careful examination of that decision fails to disclose any justification for assigning to it such an effect. In view of the fact that the learned author is discussing an obsolete statute it is not at all strange that he nodded. On the other hand, Robinson on Patents, in Sec. 623, reiterates the natural reading of the

Statute, as follows: 'In order that the term of a foreign patent may thus limit that of the domestic patent, it is essential that the inventions covered by the two patents should be identical.' It will be noticed that the author uses the word *'covered,'* and not *'shown'* or *'disclosed.'* He makes his position clear by his note to this section, wherein he cites a decision that the foreign patent is not effective *unless the claim,* as well as the patent itself, *describes the same invention.''*

IF THE PRINCIPAL INVENTION OF THE SUBSEQUENT UNITED STATES PATENT IS NOT DESCRIBED OR CLAIMED IN THE PRIOR FOREIGN PATENT THE PRINCIPAL INVENTION CANNOT FORFEIT.

This proposition is in strict accord with the doctrine of Siemens *v.* Sellers, 123 U. S. 276, upon which most of the cases rely.

Judge Putnam further considers what was intended to be decided by Siemens *v.* Sellers, and the tendency of counsel for defendants, in many cases, to strain and misconstrue what was intended. He shows that the Supreme Court did not intend that all the defences referred to could be applied to all cases irrespective of the conditions—a test regarding the scope of claims, etc. The Court says:

> ''A test of this character is too dangerous unless applied to the circumstances of the particular case in which it is used.''

Judge Putnam also considers carefully the question of ''identity,'' and what the Supreme Court meant. The Court said:

> ''The petitioner maintains that, on the question of identity of the patent, this claim falls within the decision of the Supreme Court to which we have referred; but we do not so understand it. These were based on the proposition that a difference in mere detail does not avoid identity.''

Appellant's counsel seeks to find in the decision of the Supreme Court, in Commercial Manufacturing Co. *v.* Fairbank Co., 135 U. S. 176, an iron-clad rule for all cases wherein is involved the question as to the expiring of United States patent, by reason of the expiration of a prior foreign patent, that is to say, to make the following test:

Were a person in this country after the issue of the American patent to manufacture the article described in the foreign patent, supposing that the article had not been patented abroad, would the courts refuse an injunction to restrain the use of the article, on the ground that it infringed that covered by the American patent?

But the Circuit Court of Appeals, for the First Circuit, in Westinghouse E. & M. Co. *v.* Stanley Instrument Co., 138 Fed. Rep. 823, has explained and interpreted Siemens *v.* Sellers, *supra,* and Commercial Co. *v.* Fairbank Co., *supra,* and explains that these decisions are not to be taken as making such a broad and general rule, but are to be construed in connection with the particular facts connected with each case, as the following quotation from the decision of Judge Putnam, in Westinghouse E. & M. Co. *v.* Stanley Instrument Co. clearly discloses:

> "The petitioner relies on Siemens *v.* Sellers, 123 U. S. 276, 8 Sup. Ct. 117, 31 L. Ed. 153; but that case, so far as it touches the present question, discusses merely the identity of what was in fact patented. This is emphasized at page 283, of 123 U. S., page 119, of 8 Sup. Ct. (31 L. Ed. 153), where the Court carefully explains the claim in the English patent, and not merely what the patent disclosed. The same observation applies generally to Commercial Company *v.* Fairbank Company, *supra,* which is also strenuously relied on by the petitioner. The discussion in the opinion in the last case cannot be said to par-

ticularly bind the Court, because it was carried out for the most part by simply making long extracts from the opinion passed down in the Circuit Court; but, at the foot of page 188, of 135 U. S., page 722, of 10 Sup. Ct. (34 L. Ed. 88), it speaks of the question of the identity of one foreign patent with the patent then in suit. What has this to do with what is merely disclosed by either one patent or the other? The petitioner especially relies on what is said near the foot of page 194, of 135 U. S., page 724, of 10 Sup. Ct. (34 L. Ed. 88), that the test is whether if a person in the United States, after the issue of the United States patent, should commence the manufacture of a patented article, by the precise process described in the foreign patent the Court would properly restrain him. To begin with, this, as already said, is a mere quotation from the opinion of the Circuit Court, and not an expression devised by the Supreme Court; and it is not to be assumed that where an appellate tribunal, as in this case, quotes long extracts, it is held to be bound by all the expressions contained in them."

Judge Putnam states further on:

> "However, for that particular case, this test was a sufficient one, and it was not necessary, therefore, for the Court to state any qualifications with reference thereto. For other cases, including the one at bar, the test is not sufficient."

As shown by the foregoing quotations from Judge Putnam's decision in this case, he follows the Supreme Court in that the language of Section 4887 is "so plain and unambiguous" that there is no difficulty in reading the natural and obvious meaning of said section, as he states:

> "It is a 'patent' granted for an invention which has been previously 'patented' in a foreign country, etc., which is limited. 'It is a domestic patent against a foreign patent.'"

In other words, it is what is covered by the statute, or as he points out on page 827, in referring to Robinson on Patents, 623, "the author uses the word 'covered,' and not 'shown' or 'disclosed,'" to make it clear that the foreign patent is not effective to curtail the United States patent, unless it claims, as well as describes, the same invention, and we have seen that throughout all of the decisions, it is not an isolated detail to which the statute is directed, but it is the *principal invention,* as referred to by the Supreme Court, in Siemens *v.* Sellers, *supra,* and it is this meaning or interpretation of Section 4887, to which Judge Putnam refers when he states, on page 828:

> "Therefore we are unable to find any authority, which requires us to disregard the natural reading of Section 4887, of the Revised Statutes, and no authority which leads in that direction."

Judge Putnam also clearly states that the case under consideration does not fall within the decisions of the Supreme Court, because in those decisions of the Supreme Court, that is, Siemens *v.* Sellers, and Commercial Co. *v.* Fairbank Co., *supra,* the differences were merely of details which did not avoid identity; and it is so with practically every one of the cases cited where the courts have held that there was a limitation by the foreign patent on account of identity, because the differences were merely in detail and very minute, and in the case of the Westinghouse E. & M. Co. *v.* Stanley Co., Judge Putnam found that there was a substantial difference between the British and the American patent and that, therefore, the latter was not limited by the expiration of the former.

Bate Refrigerator Co. v. Sulzberger, 157 U. S. 1.

This case, cited by the defendants, has no bearing upon the question of identity of invention, but merely relates to the bald proposition that where the prior foreign patent is for the same invention, the subsequent U. S. patent will expire at the end of the full term of the foreign patent.

Electric Accumulator Co. v. Brush, 52 Fed. Rep. 130.

In this case it was decided by the U. S. Circuit Court of Appeals, for this Circuit, that a subsequent U. S. patent for secondary batteries did not expire with the expiration of the term of a prior Italian patent, as there was some *difference in identity* of invention. It was held that the Italian patent was designed to cover, not the main invention of the U. S. patent, but a prior construction or improvement of Mr. Brush.

It is therefore, respectfully submitted that for the various reasons heretofore set forth, that the sundry defences presented by the defendants are not material, and that, if they had been before the United States Circuit Court of Appeals in the consideration of the Graphophone case, they would not have changed the result.

Alleged German and French Patents to Berliner, Not Properly Proven by Defendant.

The attention of the Court is also particularly called to the fact that the defendant's proofs of alleged foreign patent, according to the copies submitted to the complainants, are incomplete, and were formally objected to in the Court below, viz:

Referring to the German patent, No. 53,622, of November 20, 1889, and to the French patent, No.

207,090, of July 19, 1890, certified copies of which are referred to and offered in evidence, in Mr. Hicks's affidavit (R., page 81), forming part of defendants' papers in opposition to the motion for preliminary injunction, together with translations thereof.

I beg to call the attention of the Court to the fact that the defendants have not offered in evidence certified copies of these *letters patent,* but only documents which are alleged to be copies of the *specifications and drawings* thereof.

The papers containing the alleged grant are not included. The patents themselves or full certified copies have not been exhibited.

Referring to page 126 of the Record, in opposition to motion for preliminary injunction, we find what is alleged to be a translation of the French patent, No. 207,090, but which is nothing more than a translation of the *specification.* The *grant* or the *letters patent,* which under the authorities, as hereinafter referred to, is necessary to prove the existence of these foreign patents, has not been offered in evidence. The most that has been offered in evidence is this copy of the *specification.*

So also with respect to German patent, No. 53,622, an alleged translation of which is found on page 150 of the Record, in opposition to the motion for preliminary injunction. As will be seen this is not a copy of the *letters patent* or the *grant issued by the Imperial Patent Office of Germany,* but is merely a copy of the *specification,* and does not prove, under the authorities, the existence of the German *patent.*

The same applies to the French patent, No. 186,827, of November 8, 1887 (R., p. 123); No. 190,602, of May 15, 1888 (R., p. 124), and also to German patent, No. 45,048, of November 8, 1887 (R., p. 132), and No. 47,099, of May 15, 1888 (R., p. 145), the alleged trans-

lations of these letters patent accompanying defendant's papers in opposition to motion for preliminary injunction, not being, as Mr. Hicks alleges (R., p. 81) in his affidavit "certified copies of *letters patent*" of France and Germany, respectively, since the "correct, true and full translation thereof," which are said to be attached to said defendants' papers, in opposition to this motion for preliminary injunction, are not translations of the said *letters patent,* or the *grant* from France and Germany, as before stated, but are merely alleged translations of the *specification.*

The Court of Appeals, of the District of Columbia, in the case of Rosseau *v.* Brown, reported in 21 Appeal Cases, Dist. of Columbia, page 73, in a late decision of January 20, 1903, has considered this question of proving a foreign patent, and held that the offering in evidence of

> "Only a copy of the specifications and drawings annexed to a French patent"

does not have the effect of putting the French *patent* in evidence, or, as the Court said, referring to the fact that only a copy of the *specification* and *drawings* of the French patent had been submitted.

> "The *patent* itself has not been exhibited,"

and later on in this decision, again referring to this French patent, which was sought to be placed in evidence, it is stated that:

> "As we have before stated, the French patent alleged to have been granted on July 18, 1890, has not been exhibited in evidence."

So also in the case at bar, the complainants submit, that the mere certified copies of the *specifications* and *drawings* of these alleged French and German patents are, under the authorities, plainly insufficient

to place the alleged *patents* in evidence, or to exhibit the same to the Court, and these exhibits offered on behalf of the defendants were duly and are now objected to for this reason.

RE POINT TWO.

The defendant here contends that the Berliner Patent, No. 534,543, in suit, expired before suit brought with the British Patent, No. 15,232, of November 8, 1887, on November 7, 1902, and with the German Patent, No. 45,048, of November 8, 1887, on November 8, 1902, and with the French Patent, No. 186,827, of November 8, 1887.

The defendant's second point, as stated, may be misleading and confusing, among other things, in that the second point as stated by the defendant, assumes a condition of fact which the facts show in this case do not warrant.

In order to avoid any misunderstanding it should be understood that the principal invention claimed in the home patent, such for instance, as claims five and thirty-five of the patent in suit, was not illustrated, described or claimed in any of the said prior foreign patents. In other words, the broad invention in issue in this case was entirely and absolutely omitted, or not included in any of the said foreign patents; perhaps for the very reason that the inventor did not wish to jeopardize this important invention by including it in a foreign patent to be issued prior to the issue of the patent in suit. Or, it may be, as hereinafter pointed out, that at the time these foreign applications, filed abroad November 8, 1887, were forwarded for filing necessarily some time previously, the invention now in issue had not been invented. According to the record in this case, the earliest date of this in-

vention was the date of filing of the Berliner U. S. application for patent No. 564,586, which was November 7, 1887. This statement is made preliminarily so that there may be no misunderstanding in the consideration of defendant's point 2 regarding the facts, which are hereinafter more particularly considered.

These three patents were set out in the answer in the prior Graphophone suit, though they were not used in evidence, manifestly for the very good reason that they have no bearing upon the claims of the patent in suit.

It is assumed, for the sake of argument, that the drawings of the British Patent, No. 15,232 (R. p. 516), show in Figs. 1 to 7 (R. p. 526) the same devices and constructions as shown in the drawings of the Berliner U. S. Patent, No. 372,786 (R. p. 416), and that Figs. 8 to 16 (R. p. 526) of this patent show substantially the same devices as illustrated in Figs. 1 to 9 of the Berliner U. S. Patent, No. 564,586 (R. p. 463), and that the description in the British patent, No. 15,232, describes these constructions illustrated.

It is stipulated (R. p. 540) that the drawings of the French Patent, No. 186,827, of November 8, 1887, to Berliner, and the drawings of the German Patent, No. 45,048, of November 8, 1887, to Berliner, are the same as the drawings of the Berliner English Patent, No. 15,232, and that the English drawings may be used on appeal in connection with the French and German Patents.

All References to Claims 5 and 35 Omitted From Foreign Patents and Invention Covered Thereby.

The only drawing, Fig. 10, of No. 564,586 (R., p. 465), which in any manner illustrates the apparatus or method of claims 5 and 35, of the patent in suit, is distinctly omitted from the British Patent, No. 15,232 (R.,

p. 516), and from the said French and German patents, as well as all description of Fig. 10, and any and all description of Claims 5 and 35 which was specifically embodied in the U. S. patent, No. 564,586 (R., p. 465). Neither are there any claims in any of these foreign patents, for the method, or apparatus, of Claims 5 and 35, and could not be, as there is nothing in the specification or drawings of any of these patents upon which to base such a claim.

As the drawings of the British, French and German patents are assumed to be the same, we will refer, for purposes of brevity, to the British patent only.

In order that the comparison may be clear, we submit an enlarged independent sheet which contains on the one side all the drawings of Berliner's British Patent, No. 15,232, of 1887, and on the opposite side all the drawings of the Berliner U. S. Patent, No. 564,586.

From an examination of these drawings it will be clear that the English drawings include, in addition to the drawings of the Berliner Patent, No. 372,786, *only a part* of the drawings of the Berliner Patent, No. 564,586; **they do not contain and specifically omit the most important figure, Fig. 10, of the U. S. drawings of 564,586.**

An examination of the specification of the British Patent will also clearly show that that portion of the U. S. Patent, No. 564,586, which describes Fig. 10, and describes the method of claim five of the patent in suit, No. 534,543, is entirely omitted.

Claim 9, of the British Patent, which defendant states corresponds to Claim 8, of the U. S. Patent No. 564,586, notwithstanding the strained contentions of defendant's counsel, is not for, and does cover, the

invention of Claims 5 and 35, of the Berliner patent in suit, as hereinafter more particularly pointed out.

The only disclosure of the subject matter of claims five and thirty-five of the patent in suit, No. 534,543, which was in the U. S. Patent, No. 564,586, and upon the basis of which the Court of Appeals (R., p. 73) held that claims five and thirty-five were in 564,586, namely, Fig. 10 and description thereof, was never incorporated in the foreign patents, and has been specifically omitted from them.

Fig. 10 of the Berliner Patent, No. 564,586, was the only figure in the drawings which illustrated any form of the apparatus claimed in claim thirty-five of the Patent, No. 534,543, in suit, and the only description of Fig. 10, or of any apparatus or method such as claimed in claims five and thirty-five, was contained on page 4 of Patent No. 564,586, lines 93 to 128. This Fig. 10 was omitted from said Berliner British Patent, No. 15,232, of 1887, and all that portion of the specification of the U. S. Patent, No. 564,586, just mentioned, descriptive of the apparatus of claim 35 and method of claim 5 was also omitted.

Certain other portions of the specification of the Berliner Patent, No. 564,586, were also omitted from the British Patent.

The portion of the specification which was descriptive of Fig. 10, and of the apparatus of claim thirty-five, in No. 564,586, and which was never incorporated in the British Patent, reads as follows (R. p. 469, l. 90):

> "Both the process and the apparatus thus far described may be modified in various ways without departing from the main features of my invention. So, for instance, I can dispense with the centering device and can rotate the record upon a stationary axis, if the diaphragm, with its attached stylus, is mounted in a manner to make

it follow the spiral record. An arrangement of this character is shown in Fig. 10. The reproducing disk 54 is in this case mounted as hereinbefore described, but without regard to the centering device. The support 7, may be fixed in position so that the bevel gear 9, mounted upon the same in the manner described with reference to Fig. 3, will turn without progressive motion. Bevel gear 9, and with it the reproducing disk 54, are rotated by a bevel gear 14′ upon a shaft 6′, to which power is applied by a weight, as shown, or in any other suitable manner. The diaphragm casing 31 is secured to a small truck 55 upon rails 56 arranged vertically above and parallel with a diameter of the reproducing disk, and at such height above the same that the stylus 29 will be in engagement with the undulatory grooves of even depth which represent the record of sounds.

The listener applies his ear to the ear-piece, and when the shaft 6′ is rotated the stylus and diaphragm will be forced to vibrate, as in the apparatus shown in Fig. 1, but will at the same time move with the truck 55 across the face of disk 54. A tolerably good reproduction may also be obtained by simply holding one end of a reed between the teeth and the other pointed end of the same in engagement with the record grooves while the disk is rotated."

There is absolutely nothing in the specification of the Berliner British Patent, No. 15,232, of 1887, which describes, directly or indirectly, the method of claim 5, or the apparatus of claim 35, of Patent No. 534,543, in suit.

There is absolutely nothing in the drawings of the Berliner British Patent, No. 15,232, of 1887, which illustrates, or shows the apparatus of claim 35, or anything which is operated in accordance with the method of claim 5, of the Patent No. 534,543, in suit.

The only drawing, Fig. 10, and the only description of Patent, No. 564,586, which in any way relates

to claims five and thirty-five, of the patent in suit, never was a part of these British, French or German Patents.

Mr. Hicks' affidavit (R. p. 91) says that claims 9, 12, 13 and 14 of the English Patent are the same, respectively, as claims 8, 9, 10 and 13 of the U. S. Patent, 564,586, and concludes with the sweeping assertion that "The two patents, therefore, unquestionably cover the same invention."

These claims *all relate* to details *of construction* shown in the other figures of the patents mentioned, and have no relation whatsoever to Fig. 10 of Patent No. 564,586, or to claims five and thirty-five of the patent in suit.

Re Claim 9, of British Patent.

Claim 9 of the British Patent does not relate to the apparatus of claim thirty-five of the patent in suit, but relates to the apparatus shown in Fig. 8 of the British Patent. In this construction the *support* for the record is to be "*traveled in the plane of the vibration of the point of the stylus,*" in other words, the support of which carries the record is positively propelled or traveled to and fro so that the revolving disc may be moved in a horizontal plane past the fixed reproducing point in the plane of vibration of the point of the stylus.

These words in the claim were words of limitation, as hereafter more particularly pointed out.

Claim 9 of the British Patent reads as follows:

> "In a gramophone, the combination of a sound receiving diaphragm or other sonorous body; with a pivoted stylus controlled by a diaphragm and controlling the same, and a support adapted to carry a phonautographic record sheet or a copy of such record, in solid resisting material, traveling in the plane of vibration of the point of the stylus, substantially as described."

This claim 9 referred to the apparatus shown in Fig. 8 of the British Patent, which was a *recording* machine and a *reproducing* machine combined in which the *support* 7, adapted to carry the disc record or copy of such record, was positively traveled back and forth in the plane of vibration of the stylus point by means of screw threaded shaft 6, the threads of which passing through the threaded nut bearing 5 operated to travel the said support 7, carrying the record back and forth in the plane of vibration of the point of the stylus, or, in other words, in a horizontal plane.

This claim, which is said to correspond to claim 8 of the U. S. Patent, No. 464,586, referred to and was intended to cover this construction. While this fact is obvious, it is also apparent that it could have referred to no other construction, as there was no other construction illustrated or described in the British Patent, No. 15,232, which would answer or conform to the terms of such a claim.

Mr. Berliner then states (p. 4, l. 90) in the U. S. Patent, 564,586, that both the "process and apparatus thus far described may be modified in various ways without departing from the main features of my invention. * * *" This is quite clear.

Mr. Berliner then goes on to describe the apparatus shown in Fig. 10 of Patent No. 564,586 (R. p. 469, l. 90).

Re So-Called Modified Form.

Defendant's counsel contends that because the specification of the Berliner U. S. Patent, 564,586, states at page 2, lines 22 to 24, in referring to the drawings, that Fig. 10 is a sectional elevation of a *modified* form of my reproducing apparatus; and afterward at page 4, lines 90, etc., states "both the process and the apparatus thus far described may be modified in various ways without departing from the main

features of my invention''— and then describes Fig. 10—defendant's counsel for this reason contends that if it is a modified form it must be practically the same thing as the other apparatus.

It is respectfully submitted that this is not, and can not be the fact. It is clear that the form shown in Fig. 10 and described in the specification of 564,586 is a materially different form from the form of apparatus shown in Fig. 8 of the British Patent, and in this sense it is modified as stated in the specification, and very much modified. So much modified that it is a different apparatus, working in an essentially different manner, and by an essentially different method. The apparatus in Fig. 10 is so modified and changed from the apparatus in Fig. 8 that it is *only a reproducer,* and *not a recorder.* The apparatus of Fig. 10 could not operate as a recorder, as it has no means for mechanically positively propelling the stylus across the surface of the record, or propelling the record under the stylus.

The apparatus of Fig. 10 is essentially and solely a *reproducing* apparatus which does not require any means for positively propelling or traveling a support carrying the phonautographic record beneath the stylus in the plane of vibration of the point of the stylus. In other words, in a to and fro movement on a horizontal plane. It is so thoroughly modified and changed from anything shown in the previously described apparatus, namely, the apparatus of Fig. 1 of the U. S. Patent, *that it involves and embodies an essentially new and novel method of reproducing the sound from the phonautographic record, such as claim five in the patent in suit; and the apparatus itself is so modified and changed from the apparatus shown in Fig.* 1 *of the U. S. Patent that it, as before stated,* is a *reproducing apparatus only,* consisting of a traveling tablet having a sound record formed thereon

and a stylus adapted for engagement with the said record and free to be vibrated and propelled by the same, without any extraneous means whatsoever, such as shown in Fig. 8 of the British Patent, or Fig. 1 of the United States Patent, and becomes the new and novel apparatus subsequently embodied in claim thirty-five of the patent in suit, No. 534,543, which was co-pending in the Patent Office at the time the application for the Berliner Patent, No. 564,586, was there pending.

Defendant's counsel is making a desperate effort in order to endeavor to introduce Fig. 10 into the Britist Patent, No. 15,232, and into the corresponding French and German Patents, which is not and never was in those patents, or any description thereof. The method pursued by defendant's counsel is to lay hold of claim 9 of the British Patent and to endeavor to misconstrue its terms so as to make it appear that it should read upon Fig. 10, and refer to and embody that construction.

As before pointed out, this is obviously unfair, and without any substantial foundation.

The contention, therefore, that the expiration of this Berliner British Patent, No. 15,232, of 1887, and the corresponding German and French Patents, occasioned a forfeiture of claims five and thirty-five of the Berliner Patent, No. 534,543, is absolutely without foundation.

The authorities which have been herein considered are clear that the prior foreign patent, in order to curtail the term of the United States Patent, must be for identical invention.

Further Consideration of Points Raised in Defendant's Brief on Point 2.

The defendant's strained contention regarding these foreign patents is that, notwithstanding the fact that they do not contain any reference to Fig. 10, such as in No. 564,586, or any description of the same, either apparatus or process, is stated (under Sub-Division (d), Brief accompanying petition for writ of *certiorari*, p. 93, as follows):

> "It has been held by the Circuit Court of Appeals, as will be presently shown, that claims five and thirty-five, in suit, claim broadly the invention of United States Patent, No. 564,586. It follows, therefore, if such holding be correct, that claims five and thirty-five cover broadly the invention of the three prior English, German and French Patents mentioned, to Berliner, and that the patent in suit expired with each of the three prior foreign patents mentioned, before the beginning of suit, at the dates above given."

The defendant then quotes the concluding portion of the decision of the Court of Appeals in the Graphophone case (R. p. 74). It is thought that further comment is hardly necessary. What the U. S. Court of Appeals found, and evidently meant to state as finding in considering the question of alleged "public use," was, in substance, that as U. S. Patent, No. 564,586, filed November 7, 1887, contained Fig. 10, and a description thereof, this fact warranted the embodying of these claims five and thirty-five in the application for the patent in suit, filed while the first application was pending, which second applicaton became a patent before the Patent No. 564,586 was granted; that for the purposes of carrying back the date of invention of claims five and thirty-five, "the second may fairly be considered a continuation of the first, and thus Berliner's application antedates the public use."

The defendant also contends, in effect, that this patent in suit comes within the decision of Miller *v.* Eagle Mfg. Co., 151 U. S., 186, though we submit that there is nothing in the decision of this latter case which could possibly render void the patent in suit, No. 534,543, under the doctrine laid down in that case.

The patent in this present suit was the first to issue, whereas the patent in controversy in Miller *v.* Eagle Mfg. Co., was the second patent. However, there is no analogy between the two cases.

Defendant's counsel (Brief on petition for writ of *certiorari*, bottom p. 103, top p. 104), in this connection states, that his position is "that claims five and thirty-five of the patent in suit cover the invention of Patent No. 564,586, and, therefore, cover the invention of the prior English, German and French Patents mentioned."

It is difficult to understand how he brings such a contention within the decision of Miller *v.* Eagle Mfg. Co.

It is also difficult to understand his contention that these claims were patented in the prior English, German and French Patents when all description, and all reference to the subject matter of these claims are **distinctly and specifically omitted from these foreign patents, and no reference whatsoever made to them in the said foreign patents.**

Defendant's contention as to claim nine of the British Patent would be impossible, among other reasons, for the reasons:

(1). That the claim itself contains limitations which prevent such a construction, and shows that the construction to which it refers is the apparatus shown in Fig. 8 of the British Patent, No. 15,232, having a

feed screw for positively traveling the record support in the plane of the vibration of the point of the stylus.

The claim specifies as one of its elements, "a **support** adapted to carry a phonautographic record sheet, or a copy of such record, in solid resisting material, *traveling in the plane of vibration of the point of the stylus, substantially as described.*" The support is the support 7.

(2). Fig. 8 is the only construction in the British Patent, No. 15,232, of 1887, upon which this claim would fit, and as there is absolutely no other description, or illustration, in the British Patent of the subject matter of claims five and thirty-five, there is absolutely nothing else upon which to base defendant's construction of claim nine.

Claim nine of British Patent, No. 15,232, of 1887, defendant states is substantially similar to claim eight of the Berliner Patent, No. 564,586, which reads as follows:

> "8. In a gramophone, the combination of a sound-receiving sonorous body; with a pivoted stylus controlled by and controlling the same, and a support adapted to carry a phonautogramic recording surface, or a copy of such record in solid resisting material, traveling in the plane of vibration of the point of the stylus; substantially as described."

(3). There is nothing in claim nine of the British Patent, or claim eight of the U. S., No. 564,586, which specifies, or requires, that the reproducing stylus shall be *free to be propelled by the record.* The "pivoted stylus" mentioned in claim nine of the British Patent, and claim eight of the U. S. Patent, means, as described in the specification, the stylus 49 pivoted upon the sound box and connected with the diaphragm 30, as shown in Fig. 9 of the British Pat-

ent, and in Fig. 2 of the U. S. Patent. This pivot mounting is shown in section in Fig. 5 of the U. S. Patent, which is stated to be a cross-section on the lines x-x of Fig. 2. This pivoted construction is quite fully described on page 3 of the U. S. specification, Patent No. 564,586, lines 20 to 44 (R. p. 468), and in the coresponding portions of the British Patent. It is also referred to in other parts of the specification.

It is the only construction of pivoted stylus described, or illustrated, in the Patent No. 564,586, or in the British Patent referred to.

(4). Claim nine of the British Patent manifestly **combines both a recording and a reproducing apparatus**—it includes in the combination "**a pivoted stylus controlled by a diaphragm, and controlling the same.**" This can mean only one thing, viz.: that in the apparatus claimed the pivoted stylus is controlled by the diaphragm, and that also the construction is that that pivoted stylus controls the diaphragm; this means that the pivoted stylus is controlled by the diaphragm when the apparatus, such as shown in Fig. 8 of the British Patent, is being used as a *recorder*—that is, where the diaphragm operated by the sound waves of the voice in the act of recording moves, or controls, the stylus so that its pulsations will be recorded upon the recording material on the surface of the disc shown in Fig. 8. And that the construction shall also be in the same apparatus that the pivoted stylus shall control the diaphragm, as when operating as a *reproducing* machine, in which case, as in Fig. 8 of the British Patent, the stylus is pulsated by the sound waves of the previously recorded record, then desired to be reproduced, and thereby being pulsated the stylus moves, or controls, the diaphragm to which it is attached so as to reproduce the recorded sound.

Further, claim nine calls for a support adjusted

to carry "a phonautographic **record** sheet," which is the recording sheet upon which the record is to be formed when the apparatus is being used as a *recorder*, or "a **copy** of such record," which is the copy when completed as described and ready to be reproduced when the apparatus is to be used as a *reproducer*.

It is respectfully submitted that these facts in themselves are convincing and conclusive—that claim nine embodies an apparatus which is both a recorder and a reproducer, such as illustrated and described in Fig. 8.

As previously pointed out, this construction can not refer to Fig. 10 of the Berliner U. S. Patent, 564,586, as that can not operate as a **recorder** by any possible means, but is simply a *reproducing apparatus*, and nothing else.

The words "pivoted stylus" used in the claim have no reference to the mounting of the frame carrying the reproducer, but as stated refer to the mounting of the stylus on the sound box.

Claim nine, therefore, of the British Patent, and claim eight of the U. S. Patent, No. 564,586, could not possibly be construed as being for the invention of claims five and thirty-five of the patent in suit.

Re Testimony of R. M. Hunter.

Complainants have examined their expert, Mr. R. M. Hunter, in taking its *prima facie* proofs in this case for final hearing.

Parts of this Hunter testimony were quoted by defendant into his Brief in the Court below attached to Defendant's Petition (see p. 110) and also by the Complainants, without objection, and will also be referred to and quoted here.

In answer to XQ. 121 Mr. Hunter testified that he

did not understand the word "traveling" as used in claims 1, 2, 3, 7, 8 and 13 of Patent, No. 564,586, as meaning the longitudinal movement of the record tablet, or its support, and that the words referred to the rotation.

It is clear, however, how Mr. Hunter was misled into including claim eight in this category by reference to XQ. 120, immediately preceding XQ. 121, wherein defendant's counsel, in purporting to quote the language of claim eight, in this connection, misquoted it.

XQ. 120 reads as follows:

> "A traveling tablet in Patent 564,586 is a tablet rotating and moving longitudinally, is it not? I call your attention to claim one where a 'traveling plate;' claim two where a 'traveling support;' claim three where a 'traveling plate of glass;' claim seven where a 'traveling plate;' claim eight where a 'traveling recording surface, or a copy of such record in solid resisting material;' claim thirteen where a 'traveling support' is mentioned" (R. p. 470).

Mr. Hunter's answer to this question was:

> "The drawings show the record tablet as a disc, but many of the claims do not by their terms restrict the invention to a disc or a tablet of circular form or intended to be rotated, so that I am not prepared to say that those claims to which you have referred which do not indicate in some manner the requirement of a disc are limited to such form of tablet."

Mr. Hicks, defendant's counsel, then asked Mr. Hunter (XQ. 121) "whether the word 'traveling' as used in Patent No. 564,586 does not include a tablet which rotates and at the same time moves longitudinally." Mr. Hunter then made the answer to XQ. 121 referred to on page 110 of Defendant's Brief, attached to the Petition.

In making this answer Mr. Hunter had in mind the quotation from the claim, as given by defendant's counsel in XQ. 120, relative to claim eight, viz.:—"a traveling recording surface, or a copy of such record in solid resisting material," which language is not found in the claim. The quotations in XQ. 120 from the other claims 1, 2, 3, 7 and 13, however, are correct.

That Mr. Hunter was relying upon the accuracy of counsel's quotations is evident from a portion of his answer to XQ. 120, which states "I am not prepared to say that *those claims* to which you have referred *which do not indicate in some manner the requirement of a disc are limited to such form of tablet,*" meaning a tablet rotating and moving longitudinally.

Appreciating, therefore, that Mr. Hunter had been misled, or had misunderstood the question, he was asked on re-direct at a subsequent meeting.

"RDQ. 137. Your attention is called to XQ. 120 and 121 and your answers thereto. Please state whether or not you desire in any way to modify either of these answers or to make any additional statement concerning the same.

* * * * * * *

"A. In reply to those questions XQ. 120 and XQ. 121, I assumed that the quotations in the questions were correct and I have since found that the said quotations in XQ. 120, so far as they refer to claims 1, 2, 3, 7 and 13, are correct, but that the quotation purporting to be from claim eight is not correct. Under the assumption that the quotations were correct, in answering XQ. 121 I was misled into including claim eight without relying upon a careful examination of the language of the claim itself. If the only language in claim eight referring to the traveling record were that quoted in XQ. 120, my answer to XQ. 121 would be the same as originally given, but as I find that this

is a misquotation and that the language is different, my answer to XQ. 121 must be different regarding claim eight. Claim eight reads as follows:

> "8. In a gramophone, the combination of a sound-receiving sonorous body; with a pivoted stylus controlled by and controlling the same, and a support adapted to carry a phonautogramic recording surface, or a copy of such record in solid resisting material, traveling in the plane of vibration of the point of the stylus; substantially as described."

"The language, therefore, in claim eight, to which the 'traveling' refers, is 'a support adapted to carry a phonautogramic recording-surface, or a copy of such record in solid resisting material,' the said support being so adapted that it shall have the capacity of '*traveling in the plane of vibration of the point of the stylus, substantially as described.*'

"This language of claim eight can have but one meaning, viz., that the support for carrying the recording surface or a copy of the record must travel in the plane of vibration of the point of the stylus, which would mean that it must travel in a substantially horizontal plane back and forth in the plane of the vibration of the point of the stylus, which construction is accurately illustrated in Fig. 1 of the said Patent, No. 564,586, which shows the support 7 journalled on a longitudinal rib 3 and carrying the disc 13. As the shaft 6 revolves, the screw threads on a portion of its surface passing through the nut bearing 5 causes the support 7 to travel in a rectilineal direction in the plane of vibration of the point of the stylus 29. This is fully described in the specification, particularly on page 2, lines 43, etc., also page 2, lines 104, etc., where it states:

> 'If, on the other hand, the weight is allowed to descend, it will rotate shaft 23, this in turn will

rotate gear wheel 22, which, meshing with pinion 20, will rotate the latter and the connected shaft 6, and in the manner hereinbefore described support 7 will receive a rectilinear motion, while flange 10, upon bevel gear 9, will both rotate and move in a straight line. For every complete revolution of bevel gear 14, support 7 and bevel gear 9, with its connected flange 10, will be moved in the line of a diameter a distance equal to the pitch of the screw threads upon shaft 6, and it will now be understood that if a plate 13 is fixed to flange 10 and a fixed pencil or stylus be lightly pressed upon the plane surface of said plate a spiral line will be drawn upon the plate.'

"There can be no other interpretation of the language of claim eight than that which I now give, and I therefore wish to correct my former statement with respect to said claim eight, to conform with the opinion above expessed.

"In corroboration of what I have stated above, I find that during the prosecution of claim eight (formerly claim nine) on appeal before the Board of Examiners-in-Chief, as shown by the file wrapper, the particular language found in claim eight, and more particularly the following words 'traveling in the plane of vibration of the point of the stylus' were used to denote the direction of travel of the *support* for the record tablet in relation to the direction of the vibation of the stylus, and more particularly were intended to distinguish the invention of Berliner from that of the Edison Patent, No. 227,679, of 1880 (R. p. 346), in which the support for the record tablet was caused to travel in a direction at right angles to the line or direction of vibration of the stylus point. This distinction between the invention disclosed in the Edison Patent and the invention disclosed in the Berliner Patent under consideration was intended to be defined by the particular words 'traveling in the plane of vibration of the point

of the stylus' found in claim eight of the Berliner Patent, No. 564,586.

"In connection with this, I find, in the decision rendered by the Examiners-in-Chief on November 15, 1895, when referring to this claim eight (then claim nine):

> 'As pointed out in the applicant's brief, there is a difference between the apparatus of the patent and that called for by this claim in that while the support for the recording surface of the patent travels in a plane at right angles to the plane of vibration of the point of the stylus, the support called for by the claim travels in the plane of the vibration of such stylus. The difference is clear. The result due to this difference in the plane of travel of the support is material. The apparatus of the reference cannot effect the drawing of an undulatory line of even depth which results from the use of the apparatus of this claim.'

"The above quotation, in speaking of the reference, refers to the Edison Patent, No. 227,679 (R. p. 346), to which I have before referred.

"In view of what I have said, it is quite clear that the words 'traveling in the plane of vibration of the point of the stylus' do not refer to the rotation of the record disc, but refer solely to the travel of the support, which is the last element of the combination of the claim. In other words, this last element, defined by the last four lines of the claim, might have been stated as follows:

> 'and a support traveling in the plane of vibration of the point of the stylus, and adapted to carry a phonautogramic or recording surface, or a copy of such record in solid resisting material.'"

The construction shown in Fig. 1 of Patent No. 564,586, as shown on page 4, lines 46 to 89 (R. p. 469), was used for reproducing as well as recording.

It is, therefore, clear that claim nine of the British Patent (R. p. 524) related to such construction, as illustrated in Fig. 8 of that patent (R. p. 526), corresponding to Fig. 1 of the U. S. Patent, No. 564,586 (R. p. 463), and could have no reference whatsoever to the apparatus or process of claims five and thirty-five of the patent in suit. The British Patent, No. 15,232 (R. p. 516), contained absolutely no description, or drawing, whatsoever relating to such a process, or apparatus.

While the U. S. Patent, No. 564,586, was filed November 7, 1887, and the British Patent November 8, 1887, it is clear that the application for the British Patent must, in order to have been filed on November 8, 1887, have been forwarded for filing at least ten days prior to the filing of the domestic patent. It is a fair inference, therefore, that Fig. 10 in the U. S. Patent, No. 564,586, and the description thereof, was incorporated into the U. S. specification after the British application had been mailed. At all events, there was a very good reason why it was not incorporated.

Atention is also called to the fact that it was not until after the U. S. Patent had been applied for, November 8, 1887, that the description of the process and apparatus such as illustrated in Fig. 10, was published in the Electrical World of November 12, 1887 (R. p. 243).

Re Nature of the Defences.

We would call this Honorable Court's attention to the unfair and misleading statements regarding the identity of the said British, French and German Patents with the U. S. Patent, No. 564,586, which occur in a number of places in the defendant's brief accompanying the petition for a writ of *certiorari* herein, under Point Four (p. 90), where he claims the exact similarity, and frequently disregards the fact that the

only portion of the drawings and specification of Patent No. 564,586, which related to claims five and thirty-five, of the patent in suit, were never incorporated in the British Patent, No. 15,232, or in the German Patent, No. 45,048 (R. p. 132), or the French Patent, No. 186,827 (R. p. 123).

The defendant's counsel illustrates the desperate character of the defence in the numerous trivial and flippant points which he insists on, and enlarges upon, among others that noted under sub-division (i) of Point Four (Brief accompanying the petition for writ of *certiorari*, p. 104), viz.: He contends that claims thirty-one and thirty-two and six and eight of the patent in suit are infringed by the lever and stylus of the prior German Patent.

This question has particularly been covered in the discussion of Point One of this brief, and is, we submit, disposed of by the authorities which we have heretofore cited. Claim thirty-one is for the minor detail of construction of a pivoted stylus adapted to move under the vibrations of the diaphragm, and elastic in a plane at right angles to such motions. Claim thirty-two relates to a wedge-shaped reproducing stylus. Claim six relates to a detail of construction of a recording stylus, with elastic leaf spring, with a point of harder material. Claim eight relates also to a recording stylus with an elastic leaf spring, with an iridium point.

A comparison of these claims with the German Patent referred to is requested, and it is respectfully submitted that it will be found that the German Patent embodies a different construction from that of the claims referred to; even if it were the same, under the authorities, the U. S. Patent could not be invalidated by the expiration of this German Patent for such a minor detail, as hereinbefore pointed out.

The defendant's voluminous brief is burdened

with *reiterations* of this above noted defence, not only under Point One, where it is properly considered, but under sundry other points.

The character of the defendant's defences is well illustrated by their contention, that because a stylus point shown in a prior British, German or French Patent, may be *wedged shaped*, that, therefore, the patent in suit as to claims five and thirty-five, and all other claims, must be invalidated and forfeited by reason of the existence in the patent in suit of a claim, such as claim thirty-two, calling for a reproducing stylus having a *wedge-shaped* point.

If this is the law the defendant has cited no authorities to this effect. As hereinbefore pointed out, however, the authorities are to the contrary.

The authorities referred to in this brief under *Point One* apply equally to defendant's *Point Two*, and we shall, therefore, not repeat them here, but ask this Honorable Court's attention to the authorities in this brief, as set forth under *Point One*.

RE POINT THREE.

Re Alleged Prior Public Use.

In the suit against the American Graphophone Company, the defence of prior public use was based upon an alleged public use in a lecture delivered before the Franklin Institute, in Philadelphia, by Mr. Berliner on May 16, 1888. The United States Circuit Court of Appeals in the Graphophone case (R. p. 73) decided this question, holding that no question of this kind could arise in this case for the reason that Berliner had filed his application for U. S. Patent, which subsequently became number 564,586, on November 7, 1887, some six months prior to said Franklin Institute lecture, holding that the specifications in that applica-

tion were full enough to warrant the making of the claims five and thirty-five which were subsequently incorporated in the Berliner Patent in suit, No. 534,543, while the two ases were co-pending in the Patent Office. In this connection, the Circuit Court of Appeals in the Graphophone case said:

> "*Per Curiam:*
>
> In affirming this decree we do not find it necessary to add anything to the careful and exhaustive discussion of the issues which will be found in Judge Hazel's opinion, with one single exception. In disposing of the defence of prior public use based upon the lecture and exhibition before the Franklin Institute, the Circuit Court apparently relied mainly upon the proposition that what took place there was not a public use, but rather an experimental one. Without discussing the questions thus raised or expressing any definite opinion either way, we prefer to dispose of the alleged prior public use by means of the application of Berliner which was filed six months prior to the Franklin Institute lecture, and which eventuated in Patent 564,586, issued subsequent to the patent in suit. The specifications in that application (for 564,586) were full enough to warrant the making of the claims here in controversy (five and thirty-five) at any time the application might have been amended by adding such claims, and in our opinion it is immaterial that instead of thus amending it, he took the broader claims on another application filed while the first was pending. The second may fairly be considered a continuation of the first, and thus Berliner's application antedates the public use, and the facts will not sustain the contention that he abandoned his invention here in suit.
>
> The decree is affirmed."

The defendant in the present case relies upon an alleged prior public use which he says occurred in New York during the week preceding August 18, 1888,

and upon the publication and disclosure of such alleged use in the "Electrical World" for August 18, 1888, as well as upon the alleged Franklin Institute public use.

As hereinafter averred by defendant's affidavits of T. C. Martin and Joseph Wetzler (R. p. 191-194), this alleged public use shortly prior to August 18, 1888, consisted in Mr. Berliner inviting these two gentlemen to his bedroom in the Union Square Hotel, New York, to let them see the said invention, and there reproducing a record in the manner, as the affidavit says, subsequently described in the "Electrical World" of August 18, 1888 (R. p. 274). It is understood that and the defendant claims that this demonstration in Mr. Berliner's private bedroom at the Union Square Hotel to his two invited guests, Mr. Martin and Mr. Wetzler, constituted a public use.

While it is obvious that this could not possibly be construed a public use within the statute, this incident, as well as the Franklin Institute lecture, occurred a number of months subsequent to the filing on November 7, 1887, of the application for Patent 564,586, and for the reasons set forth by the Court of Appeals, could not possibly constitute a prior public use, as it was not prior.

We will, however, consider more in detail each of these alleged prior uses.

We will consider the subject in the following order:

1. Even if such demonstrations had constituted a public use, which they did not, the application for the patent in suit, under the authorities, in considering questions of this character, is construed to be the date of the filing of the first co-pending application disclosing the invention, viz.: November 7, 1887.

2. The use of the reproducing machine referred

to at the Franklin Institute, on the evening of May 16, 1888, did not constitute a *public use,* within the meaning of the Statute.

3. The use of the reproducing machine in playing a record by Mr. Berliner, about a week prior to August 18, 1888, in his private bedroom at the Union Square Hotel, New York, before his invited guests, Mr. Martin and Mr. Wetzler (R., pp. 191-194), was unquestionably a *private* use, if anything, and could not be construed to be a *public* use within the statute, even if the application were filed later.

4. As to the "Electrical World" of March 18, 1888, at that time there was no provision in the statute requiring that there should be no publication for more than two years prior to the date of application. The amendment to the statute came subsequently in this regard.

It is respectfully submitted, while it is clear, as before pointed out, that the demonstration by Mr. Berliner of the apparatus in suit before the Franklin Institute, on the evening of May 16, 1888, was of an experimental character and could not possibly, under the decisions, be construed to be a "Public Use" within the statute, and the bed room exhibition was manifestly a private use, it is desired to consider first the first point above noted; viz:—

At the Time of the Alleged Public Uses Berliner had Pending an Application for Patent, Filed November 7, 1887, Embodying and Disclosing the Invention in Suit.

As is clearly shown by the proofs, the invention claimed in claims 5 and 35, of the patent in suit, was clearly illustrated and described in an application for

U. S. Letters Patent, filed November 7, 1887, which resulted in the U. S. Patent No. 564,586. This invention was illustrated in Figure 10, of the drawings of that application, and described in the specification which fact has been referred to in the decision of the Court of Appeals, in the Graphophone case, carrying back the date of the Berliner invention at least to the date of the filing of this application for patent No. 564,586 (Rec. p. 73).

It is, therefore, apparent that, at the date of the Franklin Institute lecture, of May 16, 1888, Mr. Berliner had an application for U. S. Letters Patent on file in the Patent Office at Washington, which application embodied and included the invention which was subsequently patented and claimed in the Berliner Patent No. 534,543, in suit. The patent in suit was not filed until March 30, 1892, during the pendency of the application for patent No. 564,586, which latter patent did not issue until July 28, 1896, though it was applied for November 7, 1887.

The fact did not make any difference that the application for patent No. 564,586 did not, up to March 30, 1892, (the date of filing of application for patent No. 534,543), contain the claims such as 5 and 35, which were then embodied in the patent in suit, No. 534,543, filed March 30, 1892; the invention claimed in these claims was fully illustrated and described in this application for patent No. 564.586, and the applicant would have been entitled at any time during the pendency of this first case to have incorporated these claims in that case, if he so desired.

The patent in suit, No. 534,543, is, therefore, while not strictly a divisional case, an outgrowth, so far as claims 5 and 35 are concerned, of the first application, filed November 7, 1887. Had Mr. Berliner not filed this second application for the patent in suit, No.

534,543, he would have been entitled to the same claims, 5 and 35, in the previously filed application, which was then pending, had he seen fit to have filed them in that case, and which he could have done at any time before that application was allowed on April 11, 1896.

It is manifest, therefore, that Mr. Berliner, at the date of the Franklin Institute lecture and of the bed room exhibition, had an application on file in the United States Patent Office, embodying the invention in the present suit.

Authorities.

It is desired to submit a few authorities to the effect that, under such circumstances as involved in the present question of alleged "Public Use" for more than two years prior to the filing of the application, the second application containing the claims in controversy is so corelated to the first application that for the purpose of the question of whether within two years from the date of the alleged "Public Use" the inventor had filed an application for a patent, the date of filing may be construed to be the date of the filing of the previous application.

Robinson on Patents, paragraph 580, Note 4, states:

> "That where a second application is made for part of an invention disclosed in a former and still pending application, the latter is a continuation of the former so far as the question of two years' public use is concerned. See Graham *v.* McCormick, 11 Fed. Rep., 859."

Also in another note under this paragraph, it is stated:

> "That when applications are continuous they take the date of the original on questions of novelty and abandonment. See Henry *v.* Francestown Soap Stone Co., 2 Bann. & A., 221."

In Volume 22, of the Am. & E. Enc. of L., (2d Ed.) page 340, in discussing the time and continuance of the use or sale prior to the date of the application of patent which will defeat the patent, it is stated:

> "In the case of successive applications which may be considered as one proceeding, the public use or sale must have existed two years before the date of the first application in order to defeat the patent."

In support of this proposition, several authorities are cited, which will now be referred to.

In Stirling Co. *v.* St. Louis Brewing Assen., 79 Fed. Rep. 80, the application of the patent in suit was filed June 5, 1894, and the invention was shown to have gone into public use over two years prior to that date, and the record showed that an application for patent for the same subject-matter, so far as regards the claim in controversy was concerned, was filed December 22, 1893, and the Court gave to the patent in suit the benefit of the filing date of the earlier application and states:

> "On these facts I hold that, so far as regards the defense of two years' public use, the claims sued on relates back to the first application, and hence, that the defense of public use is not made out. Godfrey *v.* Eames, 1 Wall. 317, 325; Smith *v.* Vulcanite Co., 93 U. S. 486,500; Graham *v.* McCormick, 5 Ban. & A., 244,248, 11 Fed. 859."

International Tooth Crown Co. *v.* Richmond, *et al.*, 30 Fed. Rep. 775, heard before Judges Wallace and Shipman, is to the same effect. In this case the application upon which the patent in suit was granted, was filed December 20, 1880, and there had been a public use of the invention over two years prior to that date, but, the same inventor had filed a prior application for patent on January 6, 1879:

"Which had never been abandoned for substantially the same invention."

As in the case at bar, the first application contained some matters foreign to the subject of the second application, and the Court held that it disclosed the invention of the claims of the patent in suit and held that:

"Both applications are to be considered as parts of one continuous proceeding, and the two years within which the invention could not be publicly used without invalidating the patent did not begin to run until January 9, 1879. Godfrey *v.* Eames, 1 Wall., 317; Smith *v.* Goodyear, etc., Co., 93 U. S. 500; Graham *v.* Geneva Lake, etc., Co., 11 Fed. Rep., 138."

In another case of Howe against Newton, 12 Fed. Cas. Case No. 6771, before Justice Clifford and Judge Lowell, it was decided that two applications pending at the same time in the Patent Office, and embodying the same invention, are continuous and that the public use for two years prior to the date of the second application would not defeat the patent as the date to be given the second application was, so far as relates to the defense of public use, the date of the original application.

In the case of Henry *v.* the Francestown Soapstone Stove Co., 2 Ban. & A., 221 and 11 Fed. Case No. 6382, it was stated that:

"It has frequently been held that the date of filing the application on which the patent was granted is not the date on which the time of use or sales is to be reckoned, but that the time is to relate back to the date of *any* co-pending application."

In Bell *v.* Daniels, 3 Fed. Cas., case No. 1247, it

was held that where a second application was filed before abandonment of the first application, that the two years during which the invention might be used before the application without working abandonment, or, in other words, public use, must be dated from the first application. It was held that where the first application, or first two prior applications were not abandoned, that so far as the defense of public use was concerned, the date of the application upon which the patent eventually was patented dates back to the first application.

As in the case at bar where the subject-matter of the claims in question of the second application was embraced in the first application, it was held in Graham *v.* McCormick, *et al.*, 11 Fed. Rep., 859, that:

> "The subject-matter of the second application was embraced in the first, and the invention now in controversy was described in the specifications and the drawings which constitute part of the first application, and we think it may be said that the continuity of the proceeding which originated in the first application was not broken, up to the time when the patent for the invention in suit was granted in 1868. See also, Blandy *v.* Griffiths, 3 Fish. 616."

In the Circuit Court of Appeals for the Eighth Circuit, in Hayes-Young Tile Plate Co. *v.* St. L. Transit Co., 137 Fed. Rep., 80, Judge Sanborn, held as follows:

> "In cases in which the first application has not been abandoned, subsequent applications and amendments constitute a continuance of the original proceeding, and the two years' public use or sale which may avoid the patent, must be reckoned from the presentation of the first application, and not from the filing of subsequent applications or amendments. U. S. *v.* American Bell Telephone Co., 167 U. S. 224, 17 Sup. Ct. 809, 42

L. Ed. 144; Colgate *v.* Western Union Tel. Co., Fed. Cas. No. 2,995; Miehle *v.* Read, 96 O. G. 426; Thomson-Houston Electric Co. *v.* Winchester Avenue R. Co. (C. C.), 71 Fed. 192, 73 O. G. 2155; Godfrey *v.* Eames, 1 Wall. 317, 17 L. Ed. 684; Smith *v.* Goodyear Dental Vulcanite Co., 93 U. S. 486, 23 L. Ed. 952; Cain *v.* Park, 14 App. D. C. 42, 86 O. G. 797, 798; *Ex parte* Stewart, 4 O. G., 665; Stirling Co. *v.* St. Louis Brewing Ass'n (C. C.), 79 Fed. 80; Dederick *v.* Fox (C. C.), 56 Fed. 714, 717; Ligowski Clay-Pigeon Co. *v.* American Clay-Bird Co. (C. C.), 34 Fed. 328, 333."

And the same rule is laid down by the Supreme Court, in Smith *v.* Goodyear Dental Vulcanite Co., *et al.*, reported in 93 U. S., 486.

It is contended by defendant that because Berliner's first application did not contain these particular claims 5 and 35, that the second application should not have the benefit of the date of the first, but the effect of the foregoing decisions is that if the first application contains a disclosure of the subject-matter of the matter claimed in the second application, the rule of continuity applies, and it has been so held. Walker, on patents, states (4th Ed., Page 84), that:

> "An application which described a particular invention, takes date on the date of its filing, whether or not it claimed that invention at that time."

Citing Edison *v.* American Mutoscope Co., 110, Fed. Rep. 662.

In Graham *v.* McCormick, *et al.*, 11 Fed. Rep. 859, the second application was filed for a certain part of the invention disclosed in a prior application. It was held that the two applications should be regarded as a *continuous proceeding*, and that the public use of the invention to defeat the patent granted upon such

second application must be shown to have occurred more than two years prior to the first application.

It is important to note that in this case the facts were quite similar to the case at bar in that each of the applications included other matters of invention. It is held that where a person has, within the meaning of the patent law, made an invention which he has described in his specification, including other matter of invention, for which a patent has been issued, *that he should not be precluded, for that reason, from applying for, and obtaining, a patent for that which was not claimed in the first patent.* This is the decision of U. S. Circuit Court, for the Northern District of Illinois (1880).

In Godfrey *v.* Eames, 68 U. S. 317, the Court held, as follows:

> "In this case the patentee filed his application in the Patent Office on the 31st of January, 1855, and from that time it was constantly before the office, until the patent was issued on the 2d of March, 1858, except that on the 24th of April, 1857, it was withdrawn and refiled on the same day with an amended specification. It was admitted and proved 'that the patentee, in the summer and fall of 1854, and since, publicly manufactured and sold boot-trees containing his alleged invention.' The sales and use, as thus shown, were less than two years before the first application was filed, and hence, according to the letter of the Act of March 3, 1839, cannot affect the validity of the patent."

In Smith *v.* Dental Vulcanite Co., 93 U. S. 486, the Court held:

> "If, then, as we think it must be held, the proceeding to obtain the patent was a continuous one from 1855 until it was granted; if the application of 1855 is not severable from the proceed-

ings of 1864, there is no foundation whatever for the allegation that the invention was abandoned to the public, and that it was in public use or on sale for more than two years before the inventor's application."

In *ex parte* Livingston (Commissioners of Patent Decisions of 1881, pg. 42), the Commissioner of Patents said:

> "In ascertaining the time when public use began to run against the patentee, under the provisions of the laws of 1836 and 1839, the Courts followed a principle which may be stated as follows: Where an inventor has once disclosed his invention to the Patent Office, and manifested his intention to obtain a patent therefor by duly filing an application for a patent, any subsequent application filed by him for the same invention will be deemed *obtain continu* or renewal thereof, unless such first application has been in the meantime abandoned in fact or by operation of law. * * * I know of no recent decisions or provisions of law which render this doctrine obsolete at the present day." Citing the following authorities: Godfrey *v.* Eames, 1 Wall., 317; Bell *v.* Daniels, 1 Bond, 212; Singer *v.* Braunsdorf, 7 Blatchf., 521; Jones *v.* Sewall, 3 O. G., 630; Johnson *v.* Fassman, 5 Fish., 198; Colgate *v.* Western Union Telegraph Company, 14 O. G., 443; Goodyear Dental Company *v.* Willis, 7 O. G., 43; Henry *v.* Francestown Soapstone Company, 9 O. G., 408; U. S. Rifle and Cartridge Company *v.* Whitney Arms Company, 11 O. G., 373.

It is fundamental that as long as the application of Patent No. 564,586 was pending, these claims, five and thirty-five, of the patent in suit, could have been inserted therein, and that patent could have been granted with these claims. Surely the defendant does not contend that had this patent No. 564,586 contained these claims it would have been invalidated by reason

of the scientific lecture at the Franklin Institute delivered after the application was filed or the subsequent disclosure in Mr. Berliner's bed room. And the attention of the Court is directed to the fact that these broad and basic claims were inserted *in the patent which was granted first,* so that the patentee cannot be charged with attempting to extend the term of his monopoly.

And again, it will be conceded that the practice of the Patent Office is such that if the application of Patent No. 534,543, in suit, had been placed in interference with another application in the Patent Office, as far as the burden of proof was concerned, and the date of invention in the Patent Office, the Commissioner of Patents would have given to Berliner the date of his earlier application, the practice being that, as far as the Patent Office is concerned, the date of an invention, is the date when a complete application disclosing such invention was filed in the Patent Office, and we have shown that the application of Patent No. 564,586 contained a complete disclosure of the subject matter of claims five and thirty-five.

And again, in public use proceedings, which often occur in the Patent Office, it must be conceded on all sides that a second application containing a claim having subject matter disclosed in a prior co-pending application, takes the date of the earlier application for such public use proceedings.

No Extension of the Term of the Patent.

By patenting the method and apparatus of claims five and thirty-five in the application filed March, 1892, instead of in the application filed November 7, 1887, Mr. Berliner did not prolong his monopoly, as intimated by defendant's counsel, but he in fact *shortened* the period of expiration of his rights. If he had in-

serted these claims in the application filed November 7, 1887, the patent would not have expired until July 28, 1913, as that patent did not issue until July 28, 1896. As it is, the patent in suit, in which the claims were inserted, filed March 30, 1892, issued February 19, 1895, and consequently will expire Februay 19, 1912.

While it is submitted that the foregoing is conclusive, we will consider the two alleged public uses.

(2) The demonstration at the Franklin Institute lecture did not constitute a "Public Use."

Defendant seems to contend that Berliner's act in exhibiting and operating the device at his Franklin Institute lecture, on the evening of May 16, 1888, constituted such a public use as would invalidate the patent in suit:

(a) If it was an operative device;

(b) If it embodied the invention of the claims.

Defendant further contends that this use on this particular evening at the Franklin Institute was not an experimental use.

It is proven, admittedly, that the device of the claims was not sold to the public until the autumn of 1894, over six years subsequent to the date of this lecture.

It is not contended that Mr. Berliner received any profit from the public for his invention, in any way, prior to the application for the patent in suit. So that the only contention is, that Mr. Berliner, in reproducing a few etched sound records at the conclusion of this lecture at the Franklin Institute, on the evening of May 16, 1888, upon the reproducing apparatus, illustrated in his lecture in the centre figure on page 269 of

the Record, placed his invention in public use within the contemplation of the Statute, Sec. 4886.

It is contended, on behalf of the complainants, that this use did not constitute a *public use* within the contemplation of the Statute, but was of an *experimental* character, as shown by Mr. Berliner's Franklin Institute lecture (R., pp. 245-269), as held by the lower Court.

It stands to reason that before a device can be properly experimented with—where the experiment must be more or less of a public nature—it must be finished and completed before the experiment commences, otherwise, there can be no fair test or experiment of the completed invention.

A test or experiment of an incompleted invention would not prove the capacity or capabilities of the real invention, that is, the *completed thing.*

The test may prove that certain changes may be necessary, but the mere fact that it may show that none are required does not make the use before an audience any the less an experiment.

Defendant's counsel seems to utterly fail to appreciate this distinction.

In this connection, Mr. Justice Bradley, in deciding the case of Elizabeth *v.* Pavement, 97 U. S., 126, hereinafter more fully referred to, in considering this question of the experiment in public of the completed thing, said:

> "If durability is one of the qualities to be attained, a long period, perhaps years, may be necessary to enable the inventor to discover whether his purpose is accomplished.
>
> "And though, during all that period, HE MAY NOT FIND THAT ANY CHANGES ARE NECESSARY, yet he may be justly said to be using his machine only by way of experiment; and no one would say that such a use, pursued with a *bona fide* intent of testing the qualities of the machine, would be a public use within the meaning of the statute."

In the American and English Encyclopedia of Law, 2d Ed., Vol. 22, p. 338, it is said that the experiment in public, more than two years, prior to the date of the application, in testing the operation of the invention, does not invoke the bar of the statute, "*though no changes may be made*" in the device by reason of the experiment. Other authorities will be hereinafter referred to.

Robinson on Patents, Vol. 1, Sec. 355, states: "A use clearly experimental, in good faith and for a reasonable time, though it may show that the invention *is in fact complete,* does not affect the exclusive rights of the inventor or constitute a dedication to the public."

The attention of the Court is also called to the testimony of Mr. Berliner (Record, pp. 240-242), wherein he clearly shows that his apparatus, claimed in claim thirty-five, involving the method of claim five, was never sold until 1894, and that prior to that time, there had never been any public use of it.

The Franklin Institute Lecture of May 16, 1888.

We would first call attention again to this lecture (R. p. 245, etc.), which shows that a large portion of it was devoted to a *scientific review of the development of the talking machine art.* Mr. Berliner then describes his method of producing etched sound records, devoting a considerable portion of the lecture to this subject. He then refers to the recording apparatus for making the records, and to the reproducing apparatus (See Record, p. 267). He states:

> "In having attempted, therefore, to do justice to all sources of error, I am not yet prepared to say that my present recording apparatus is constructed and adjusted to the greatest attainable correctness.

"Those who are familiar with the tediousness of original research, will admit that a new subject of this kind cannot be solved in its entirety within the space of a few months, and what I bring before you to-night, being the hasty results of a new machine finished but ten days ago, should be measured rather by the possibilities it opens than by the results so far attained, whatever merit you may accord to them.

"My impression, however, is that there is very little of lost or added motion in my present apparatus, and whatever imperfections may exist must be looked for *in the mode of reproducing the sound* rather than in the recorder. (Fig. 2.)"

Defendant's counsel contended in the Court below that the Circuit Court erred in its understanding of this statement above quoted, on the ground that the above statement quoted referred to the *recording* machine, and not to the *reproducing method and apparatus.*

That defendant's counsel is the one who errs in this matter, and not the Court below, is clear from careful reading of the above quotation from Mr. Berliner's lecture, as it is obvious that Mr. Berliner was referring not only to the recorder, but particularly to the *reproducing,* when he apologizes for the hasty construction of the devices. The last clause shows that while there is very little lost or added motion in the recordng apparatus, it specifically states, "whatever imperfections may exist must be looked for in the mode of reproducing the sound rather than in the recorder. (Fig. 2.)" Figure 2 referred to, is shown in the centre figure of page 269 of the Record.

It is apparent that Mr. Berliner did consider, as shown by his statements in this lecture, that the *reproducing* of sound by that apparatus before that audience on that evening was of an *experimental character.*

The reproducing machine which he exhibited that

night embodied his invention of the apparatus claimed in claim thirty-five, of the patent in suit, and operated by the method of claim five, both of which were invented, as hereinbefore shown, by him in November, 1887. He refers, in fact, in this lecture (p. 270) to the description of November 12, 1887, which was the publication in the "Electrical World" (Record, p. 243), wherein he had described his invention at that early date. It is true, he did give credit to Werner Suess, his assistant, in this lecture (p. 270) for having *suggested* a particular method of pivoted arm for carrying out the Berliner invention of November, 1887, claimed in claims five and thirty-five, but this, the Suess contribution, was a mere improvement in the specific construction in a device embodying Berliner's invention, and was so recognized and never disputed by Mr. Suess. When Suess applied for the United States Patent, No. 427,279 (Record, p. 446), he made no effort to claim Berliner's invention, but limited himself to minor specific constructions, such as a counterbalanced arm, and a "lazy-tongs" construction of pivoted arm.

A Test Before a Scientific Body.

Under the heading of "Demonstrations" (R. p. 268), Mr. Berliner states in this lecture:

> "While the plate is being etched, I will now let you listen to some phonautograms which I prepared in Washington within the last two weeks." * * * "In reproducing the sound I find that it is louder with hard contact substances, like metal, than with soft ones like rubber or plaster of Paris. Hard metals, like copper, nickel or brass, sound louder than zinc or type metal, but the scraping sound, which is due to friction, is also increased unless the record surface is smooth and very highly polished."

Mr. Berliner then, according to his deposition (R. p. 232, Q. 13), stated that he produced a number of records on the apparatus which is illustrated in the centre figure of his lecture (R. p. 269).

It is clear from this lecture (Record, p. 272) that it was Mr. Berliner's intention to adapt the machine, among other things, for *use in public halls*. He states (Record, p. 272):

> "Addresses—congratulatory, political, or otherwise—can be delivered by proxy so loudly that the audience will be almost as if conscious of the speaker's presence.
>
> "A singer unable to appear at a concert may send her voice and be represented as per program, and conventions will listen to distant sympathizers be they thousands of miles away."

This scientific paper was subsequently published in the Journal of the Franklin Institute, issue of June, 1888. At the end of the published proceedings is the following note (Record, p. 273):

> "At the close of the paper and after the exhibition of the apparatus, Prof. E. J. Houston moved a vote of thanks to M. Berliner for his interesting and valuable communication. The motion was carried unanimously and the meeting was adjourned."

It is manifest that the use of this apparatus in this hall, on the evening of May 16, 1888, was of an *experimental character*, to test its efficiency before a scientific body of men, not only from a phonetic standpoint, but also to test its ability and capacity to fill a lecture, or concert hall, so that the sounds could be heard by all those present, even to the remote parts of the hall.

The evidence of the lecture itself is the strongest possible evidence of the experimental character of the

demonstration. This is further corroborated by Mr. Berliner's deposition in the Record (pp. 240, etc.), where he shows (Q. 6) **that the invention was not sold, or put in public use, to his knowledge, in this country until the autumn of 1894.** On cross-examination (Record, p. 241, XQ. 11), he states:

> "By 'public use' I mean any other use but of my own and my assistants of the laboratory."

He also states (XQ. 12), he understood by "public use" the use in public of an invention for profit. It was clearly never Mr. Berliner's intention to give the invention to the public prior to having filed an application for a patent.

The fact that Mr. Berliner's Franklin Institute lecture was subsequently published, can have no bearing upon the question of whether the act of producing a record upon the apparatus on the evening of May 16, 1888, before a scientific body, constituted a public use, such as contemplated by the statute. If the publication of the Franklin Institute lecture proved anything, it would rather tend to prove the complainants' contention that the demonstration was of an experimental character, as the lecture shows on its face the demonstration was of an experimental character.

Re Authorities.

If an inventor allows his invention to be used by others generally, either with or without compensation, then it will be "in public use" within the meaning of the statute.

Exceptions to this rule are:

Where the use is experimental;

Where it was piratically, or fraudulently obtained.

Authorities re Experimental Use.

Walker on Patents, Sec. 95 (4th Ed.), states:

> "Experimental use is never public use within the meaning of the statute, if it is conducted in good faith, for the purpose of testing the qualities of the invention, and for no other purpose not naturally incidental to that.
>
> "In such a case it is immaterial whether the experimental use disclosed a necessity for improvement, or disclosed no such necessity; and it is also immaterial whether the use was conducted with secrecy or not."

Mr. Walker (Sec. 95) also states, after referring to Elizabeth *v.* Pavement Co., 97 U. S., 134:

> "Indeed, Judge John Lowell went still further in the direction of liberally allowing scope to experimental use, and decided that such use is not public use within the meaning of the law, where, in order to test its comparative as well as its absolute utility, and in order to convince others of its merits, an inventor allows them to use his invention after he has himself become satisfied that it is useful."
>
> (Citing Sinclair *v.* Backus, 5 Bann. & Ard., 81, 1880.)

Mr. Walker also then shows that where the main object was profit, and the improvement was only an incidental aim, the use might not be regarded as experimental, though incidental profit is not inconsistent with the use being experimental.

It must also be clear that the use was experimental. In the present case, however, the Franklin Institute lecture itself shows, by a careful reading of it, that the single demonstration, on the evening of May 16, 1888, by Mr. Berliner, was of this experimental character. Mr. Berliner's evidence that the invention was not put out to the public, or sold, until the

autumn of 1894, and his intent, gathered from his evidence, is also strong proof of the experimental nature of the demonstration on the evening referred to.

Where an invention is in a complete form, and is not subsequently changed, an experimental use, more than two years before the application, certainly does not come within the statute. (See Elizabeth *v.* Pavement Co., 97 U. S., 134; Walker on Patents, Sec. 95, etc.)

Where a minor completed invention, which requires no experiment to demonstrate its capacity, is used in connection with a large machine, which is being experimented with, in such a case as where the car has been used in public, the minor invention has been held to have been in public use, for the reason that its use was not of an experimental character. This is the case of Thomson-Houston Electric Co. *v.* Lorain Steel Co., 110 Fed. Rep., 654, referred to by the defendant. The patent was to Van Depoele, Patent No. 390,921, for commutator brush, the essential feature of which was the use of carbon as the material for the brush. It was shown that for more than two years prior to the date of the application for this patent, Van Depoele had constructed a cable across an empty lot, on which a car was suspended, with a motor started by a generator in the factory. On the car was an automatic reverser. On this car, which Van Depoele was experimenting with, he used one of these carbon brushes, claimed in the patent. The car, having this carbon brush as an auxiliary part of the mechanism on it, was run across the lot for four or five weeks prior to the statutory period, whenever there were visitors at the works.

The use of the carbon brush was shown by Judge Lacombe in deciding the case, not to have been, in any manner, experimental, but that the experiment

was with the new car or "telpher." The carbon brush merely performed its function in the operation of the motor, and there was nothing experimental about the use of this carbon brush.

IF the nature of the invention is such as to require test and demonstration before others, such a use before the invention is put on sale, is not a public use, within the meaning of the Statute.

Even if a price were charged for the device during such use, numerous decisions have held that this would not bring it within the statute, under the circumstances.

Walker on Patents, Sec. 96, states:

> "If, however, the nature of the invention is such that the inventor is obliged to put it into the hands of others for crucial experiment, he may sell specimens to those others for that purpose, and such a sale will not be obnoxious to the law now under consideration."
>
> (Citing Graham *v.* McCormick, 5 Bann. & Ard. 244; Graham *v.* Mfg. Co., 11 Fed. Rep., 142.)

The very character and nature of the device claimed in the Berliner Patent in suit required test, experiment and demonstration before hearers, in order to ascertain its qualities and capabilities, and to ascertain whether it required change or improvement. The device was designed, among other things, for lecture and concert halls. How else could its capabilities and phonetic capacity be fully known by the inventor than by testing and experimenting with it before an audience in a hall? That Mr. Berliner was uncertain as to its ability to accomplish all that he desired, is evidenced by the lecture itself, when he states (Record, p. 267), before giving the demonstration:

"My impression, however, is that there is

> very little of lost or added motion in my present apparatus, and whatever imperfections may exist must be looked for in the mode of *reproducing* the sound, rather than in the recorder. (Fig. 2)."

In the case of Shaw *v.* Cooper, 32 U. S., 292, cited by the defendant, while the principles enunciated in the decision are in accordance with the complainants' contention, the facts in that particular case required the Court to hold that the invention had been in public use, as cited by the Court, p. 322:

> "For three years before the emanation of this patent, his invention was in public use, and he appears to have taken no steps to assert his right."

In the case of Egbert *v.* Lippman, 104 U. S., 333, referred to by defendant, while the facts justified a finding that there had been a two years' public use with the consent and allowance of the inventor, the principles and exceptions laid down by the Supreme Court, when applied to the case at bar, would clearly show that there was no public use by Mr. Berliner. The Court said:

> "Nevertheless, if its inventor sells a machine of which his invention forms a part, and allows it to be used without restriction of any kind, the use is a public one, within the meaning of the law. So, on the other hand, a use necessarily opened to public view, if made in good faith, solely to test the qualities of the invention and for the purpose of experiment, is not a public use within the meaning of the patent law."
>
> (Citing Elizabeth *v.* Pavement Co., 97 U. S., 126; Shaw *v.* Cooper, 32 U. S., 292.)

Berliner certainly comes within this exception.

In Elizabeth *v.* Pavement Co., 97 U. S., 126, Mr. Justice Bradley, in commencing the consideration of the question relative to alleged public use, states:

> "It is perfectly clear, from the evidence, that he did not intend to abandon his right to a patent."

And then shows that the use of the Nicholson pavement in Boston, on one of the public streets, for a space of about six years before he filed his application for his patent, was experimental, and for the purpose of testing its qualities, and could not be construed as a public use. Mr. Justice Bradley further states:

> "The use of an invention by the inventor himself, or of any other person under his direction, by way of experiment, and in order to bring the invention to perfection, has never been regarded as such a use. Curt. Pat., Sec. 381; Shaw *v.* Cooper, 7 Pet. 292."

Defendant endeavors to distinguish the present invention from the street pavement, upon the ground that this is a machine, and could be tested privately.

In this connection, Mr. Justice Bradley stated:

> "When the subject of the invention is a machine, it may be tested and tried in a building, either with or without closed doors. In either case, such a use is not a public use, within the meaning of the statute, so long as the inventor is engaged, in good faith, in testing its operation. He may see cause to alter it and improve it or not. His experiments will reveal the fact whether any and what alterations may be necessary. If durability is one of the qualities to be obtained, a long period, perhaps years, may be necessary to enable the inventor to discover whether his purpose is accomplished. **And though, during all that period, he may not find that any changes are necessary, yet he may be justly said to be using his machine only by way of experiment;** and no one

would say that such a use, pursued with a *bona fide* intent of testing the qualities of the machine, would be a public use within the meaning of the statute.

"So long as he does not voluntarily allow others to make it and use it, and so long as it is not on sale for general use, he keeps the invention under his own control, and does not lose his title to a patent.

"It would not be necessary, in such a case, that the machine should be put up and used, only in the inventor's own shop or premises. He may have it put up and used in the premises of another and the use may inure to the benefit of the owner of the establishment. Still, if used under the surveillance of the inventor, and for the purpose of enabling him to test the machine and to ascertain whether it will answer the purpose intended, and make such alterations and improvements as experience demonstrates to be necessary, it will still be a mere experimental use and not a public use, within the meaning of the statute.

"Whilst the supposed machine is in such experimental use, the public may be incidentally deriving a benefit from it. If it be a grist mill, or a carding machine, customers from the surrounding country may enjoy the use of it by having their grain made into flour, or their wool into rolls, and still it will not be in public use, within the meaning of the law."

Mr. Justice Bradley also pointedly states in the opinion:

"It is not a public knowledge of his invention that precludes the inventor from obtaining a patent for it, but a public use or sale of it."

It is respectfully submitted that this portion of the decision most aptly applies to the case at bar, and that the citation of further authorities is unnecessary.

The device of the patent in suit is a talking machine, and method of reproducing sound; certainly to

fully test the efficacy of a sound producing machine, it must be listened to by hearers; not by a single hearer, or two or three, but if it is designed for public halls for concert and like purposes, it must be experimented with in a hall and before a body of people to properly ascertain its effect upon the hearers as an assembled body. Therefore, the experiment with the apparatus could not be conducted in the absence of an audience, in a cellar, or in a dark closet, but must be with unclosed doors before an audience. While it is true that some machines might be tested privately, such as a printing press, or a spinning machine, a talking machine, from its very nature, in order to be properly experimented with and tested must be demonstrated before hearers.

Robinson on Patents, relative to experimental use not being a public use, states (Vol. 1, Sec. 355):

> "A use which is experimental, or is designed to test the capability or merits of an art or instrument, is not a use from which abandonment can be inferred. Such use assumes that the inventor does not yet regard his own idea of means as perfectly developed, *or fears that his embodiment of it is not adapted to its full expression; and therefore his experimental use of the invention,* whether in public or in private, and for however long a time continued, *indicates no intention to surrender it to the public,* but, on the contrary, a design to retain entire control over it for the purpose of completely realizing his idea. That from a use like this benefit accrues indirectly to the public, or some advantage is obtained by the inventor, does not change its character. A use clearly experimental, in good faith and for a reasonable time, though it may show that **the invention is in fact complete,** does not affect the exclusive rights of the inventor or constitute a dedication to the public."

Lyman *v.* Maypole, 19 Fed. Rep., 735;

Sprague *v.* Smith & Griggs Mfg. Co., 128 Fed. Rep., 721;
Smith & Griggs Mfg. Co., *v.* Sprague, 123 U. S., 249.

An experimental use of apparatus employed in the process more than two years before the application for the process patent is no abandonment of the process.

Eastern Paper Bag Co., *v.* Standard Paper Bag Co., 30 Fed. Rep., 63;
Emery *v.* Cavanagh, 17 Fed. Rep., 242.

In the case of Harmon, *et al.*, *v.* Struthers, *et al.*, 57 Fed. Rep., 637, an inventor of an improvement in reversing gearing for engines, without profit to himself, and for the sole purpose of advertising the efficiency of his invention by practical use, placed his device on engines manufactured by his employers, who sold them with a view to experimental use.

Judge Acheson, in delivering the opinion of the Court, held that there was no public use of the invention within the meaning of the statute. (See cases cited in the decision.)

The attention of the Court is also called to the consideration of this question in the Am. & Eng. Enc. of Law, 2nd Ed., Vol. 22, p. 338:

> "*Experimental Use.*—Use, even in public, merely for experimental purposes, is not a public use within the statute, and will not defeat a subsequent patent, though such use may have continued for considerably more than two years named in the statute. So long as the inventor is engaged in good faith in testing the operation of his invention, though the test may extend over a period of years, *and though no changes may be made*, the use is merely experimental and not public, within the meaning of the statute, and it is immaterial that while the device is in such exper-

imental use the public may be incidentally deriving a benefit from it, or that there is an incidental sale of its products, or an incidental profit."

— (See Lyman *v.* Maypole, 19 Fed. Rep., 735.)

In the case of Railway Register Manufacturing Company *v.* Broadway Co., 22 Fed. Rep., 655, it was held, in an opinion by Judge Wheeler (Southern District of New York), that the public use of the cash register, according to the evidence, upon street railway cars, was the only manner in which they could be conveniently used for the purpose of actual experiment to ascertain the best mode of construction, and that this was permissible and would not bar a patent.

In the case of Ennis *v.* Oil City Boiler Works, 22 Fed. Rep., 780, it was held by Judge Acheson (Western Dist. of New York) that a single sale by an inventor of a machine embodying his complicated invention, more than two years before his application for a patent, will not render the patent void where such a sale is made for less than the value of the machine, without profit to the inventor, for the sole purpose of testing it, and with the understanding that it will be taken back if it does not work satisfactorily.

If necessary, in making tests, an inventor may sell a machine on trial, so as to get it fully and fairly tested in practical use, by the class of persons for whose use it is intended, and such sale or use, even for more than two years, if made for the purpose of practical test, will not be a sufficient sale or public use to invalidate the patent.

See Graham *v.* Geneva L. C. M. Co., 11 F., 138.

The Defendant's Brief may refer to the case of Manufacturing Co. *v.* Sprague (123 U. S., 249). That

case contains a very full review of the decisions, and while the facts in that case warrant, the holding that there was a public use, the facts were very different from the facts of the present case. The principles of law therein set forth are the same as contended for herein by the complainant, and Mr. Justice Matthews quotes therein from the decision in the case of Elizabeth *v.* American Nicholson Pavement Company (97 U. S., 126) at length, with approval, among other portions, that portion of the pavement case which states:

> "And though during all that period *he may not find that any changes are necessary*, yet he may be justly said to be using his machine only by way of *experiment;* and no one would say that such a use, pursued with a *bona fide* intent of testing the qualities of the machine, would be a public use within the meaning of the statute."

The facts in Manufacturing Company *v.* Sprague, show that the prior public use was from the fall of 1874 until the fall of 1877, more than two years prior to the filing of the application on December 2, 1878, and that the complainant had the patented device in use *for the purpose of profit* in his business, operated in his business, operated in his factory by his workmen for the production of Arctic overshoe buckles. It is, therefore, apparent that there was here a use for a period of three years for profit in business. Of couse, under such circumstances, the experimental character of the use must have been proved by the strongest kind of evidence, as such a use was palpably contrary to the theory of experiment.

Full Evidence of the Experimental Character of the Use.

In the present case, however, the alleged public use consisted in a *single act* on the evening of May 16,

1888, in the course of a scientific lecture, before a scientific body, and for which no charge was made.

We submit that the evidence of the lecture itself, and of the circumstances surrounding the demonstration before this scientific body, *to which the public were not admitted,* is the strongest kind of evidence, of the fullest and most convincing character, that this single demonstration on this particular evening before this particular body in the course of this scientific lecture was of an *experimental character.*

No further evidence was necessary, though Mr. Berliner's deposition clearly shows that there was not, and could not have been, and was not intended to have been, any public use in the statutory sense of this invention at that time.

It was clearly a *bona fide* test, of an experimental character, of an invention which the inventor in his lecture (Record, p. 267), stated in referring to that reproducing apparatus, before trying it before these scientific men:

> "and whatever imperfections may exist must be looked for in the mode of *reproducing* the sound rather than in the recorder."

There was clearly no public use of this invention, and there is nothing in the law which required Berliner to file his application for the patent in suit before the date he did file it in March, 1892.

If this Franklin Institute lecture or the demonstration in his bed room at the hotel in New York, constituted a public use, then the inventor was obliged to file his application within the two year period; if, however, it was not a public use—which it was not—the fact that he did not file the application for the patent in suit until after the period of two years had elapsed cannot affect the validity of his patent.

The evidence of the experimental character of Berliner's demonstration of his reproducing apparatus on the evening of May 16, 1888, on the occasion of the delivery of his scientific lecture relating to the subject before a scientific body, in a hall to which the public were not admitted, is full, clear and unequivocal.

That this use could not constitute a public use, such as contemplated by the statute is decided by the authorities herein cited.

Re Alleged Prior Public Use in Mr. Berliner's Bedroom.

The new alleged prior public use set out by this defendant purporting to be proven in the affidavits of T. C. Martin and Joseph Wetzler, in Record, pp. 191-194, is to the effect that Mr. Martin and Mr. Wetzler, about a week prior to March 18, 1888, visited Mr. Berliner's bedroom, in the Union Square Hotel, New York City, and that he there played several records for them on a machine similar to that illustrated in the "Electrical World," of March 18, 1888, and that Mr. Wetzler subsequently wrote the article published in the said paper of that date.

It is respectfully submitted that this could, in no sense or manner, be constituted a *public* use within the statute, but, if anything, was nothing more than a *private* demonstration in Mr. Berliner's bedroom to two guests.

It is submitted that the authorities hereinbefore cited, abundantly prove that this could in no manner be considered as a public use within the statute.

POINT FOUR.

Under this point in the petition for *certiorari* (p. 23), and under Point Six (p. 115), in defendant's brief in the U. S. Court of Appeals, a copy of which is attached to said petition, the defendant contends by reason of the issuance of the Suess Canadian Patent No. 41,901, of February 11, 1893 (R. p. 155) to Berliner, that Berliner is now estopped from claiming that claims five and thirty-five of the patent in suit cover the broad principle of Berliner's invention, for which the complainants contend, and to which, the U. S. Circuit Court of Appeals has decided, he is entitled.

The defendant makes this contention, for the reason that in addition to illustrating, describing and claiming the Suess invention as illustrated, described and claimed in the U. S. Patent to Suess, No. 427,279 (R. p. 446), it also contained two or three broad claims the language of which, it was contended, was broad enough to cover the apparatus and process of claims five and thirty-five of the patent in suit.

The Suess-Canadian Patent Considered.

The drawings of the Canadian Patent are identical with the drawings of the Suess U. S. Patent, 427,279. (Stipulation, R. p. 541.) The specification is printed in the Record on pages 157 to 186. It states:

> "My invention has reference to improvements in the reproducing apparatus, adapted for use in the method of recording and reproducing sounds **heretofore invented and published by Emile Berliner.**"

The application was filed on December 7, 1895, and was never amended, or changed. (See Lyon's Affidavit, Record, p. 314).

It will be remembered that Mr. Berliner's invention

of claims five and thirty-five was "PUBLISHED," as stated in the Suess-Canadian specification, in the "Electrical World," of November 12, 1887 (R. p. 243), which publication was known to Mr. Suess, as he was present on May 16, 1888, when Mr. Berliner delivered his Franklin Institute lecture in Philadelphia, describing this, his, Berliner's invention, when he, Berliner, stated, referring to the "Electrical World." "In the description of November 12, 1887, I advanced the idea of mounting the sounder on a carriage and rails and have the record groove itself to be the screw which was to guide the point of the stylus across the disc from periphery to centre."

Mr. Berliner then stated that this had been improved upon by Mr. Werner Suess, who was present with him there that evening, at the time of the delivery of the lecture, by pivoting the arm carrying the reproducer, instead of carrying the reproducer on a suspended rail, as illustrated, for instance in Fig. 10 of Patent No. 564,586.

This publication of the "Electrical World," of November 12, 1887, also stated on page 255 (R. p. 243):

> "If now the engraved record is rotated with uniform speed, and the stylus be held in the groove, the end of the stylus will be forced to follow the undulations of the groove, and any vibratory surface attached to the stylus will be vibrated positively in both directions, in strict accordance therewith; and will, therefore, reproduce the exact sounds which originally produced the record."

The "Electrical World" further states (R. p. 244), after describing one way to mount the phonautogram:

> "Another way is to mount the phonautogram on a circular, wooden, resonant box, which simply rotates without progressive motion, and to press an ivory point into the groove. In this case the hand which holds the ivory easily follows the

groove, and the point is led along the volute of the record, and vibrates the sound box by undulatory shocks.

"This suggests the plan of mounting the reproducing diaphragm and stylus on a carriage moving on rails, and permitting the point of the stylus not only to vibrate, but also to push the carriage across the revolving disc, and thereby follow the volute of the sound record.

"Mr. Berliner believes that it is more than likely that the gramophone is destined to fulfill many of the expectations which were placed ten years ago on the phonograph, and which are partly realized by the graphophone——"

Mr. Suess, in making this statement hereinbefore quoted in the specification of his Canadian application, which was sworn to by him on April 13, 1891, specifically recognizes Mr. Berliner as the inventor of this invention which had been thus published, among other places, in the "Electrical World" November 12, 1887, and a description of which invention was also published in the Journal of the Franklin Institute in June, 1888, the lecture having been delivered May 16, 1888. (See R. pp. 254 to 273.) It will be noted on page 273 of the record, that at the conclusion of this interesting paper before the Franklin Institute, the well-known electrical inventor, Dr. E. J. Houston, moved a vote of thanks to Mr. Berliner "for his interesting and valuable communication."

The "main features" of the Suess-Canadian relate to details of construction.

The attention of the Court is directed to this Suess-Canadian application (assigned to Mr. Berliner), a careful reading of which will show that Mr. Suess did not claim to be the inventor of this broad invention, but *admitted Mr. Berliner's prior invention,* and, in effect, stated that the features of his, Suess', present inven-

tion in this Canadian application related to certain detail improvements.

Among other improvements, the specification notes, first, that as the weight of the intensifying horn is carried by the reproducer, it should be supported and balanced, so that the recording stylus "will bear with light, but sufficient pressure upon the record tablet."

His other feature is a lazy-tongs construction of frame for making the stylus travel in a straight radial line.

The means which he shows for counterbalancing is illustrated in Fig. 1 of the Suess U. S. Patent, No. 427,279 (R. p. 446), of which the Canadian drawings are a copy. The means for making the path of the stylus travel in a straight radial line are shown in Fig. 3 of the drawings, having a lazy-tongs construction.

The specification then describes in detail the constructions illustrated in the drawings.

The specification contains no broad statement of invention whatever, and is confined to the details referred to.

Claim eleven, while broadly worded, if valid at all must, in view of the admission in the specification of Mr. Berliner's invention, and in view of the statement that the main features of the Suess invention refer to certain details be narrowly interpreted. Claim eleven, which is the most broadly worded claim of the patent, reads as follows:

> "11. In an apparatus for reproducing sounds from a rotating record tablet, a reproducing stylus mounted to have a free movement over the surface of the record tablet, substantially as described."

The words "substantially as described," it is submitted, should be understood as limiting this claim, if it is valid at all, to the lazy-tongs construction illustrated in Fig. 3 for making the reproducing stylus travel in a straight radial line across the record tablet.

Claim five reads:

> "5. In an apparatus for reproducing sounds from a record tablet, the combination with a reproducer mechanism consisting of a sound conveying tube and a diaphragm and stylus mounted at one end of the tube, of a **freely swinging supporting frame** for the said reproducer mechanism, substantially as described."

In view of the statement that the main feature of the invention, other than the counterbalancing feature, was the mechanism for making the path of the stylus across the face of the record disc as nearly as practicable a straight radial line, the words of the claim, "of a freely swinging supporting frame for the said reproducer mechanism, substantially as described," evidently refer to the lazy-tongs construction shown in Fig. 3 of the drawings.

Even if it referred broadly, to the pivoted swinging arm, it would not conflict with claims five and thirty-five of the patent in suit, as those claims have no such restrictions, or requirements, in them.

Claim seven of the Canadian Patent reads:

> "7. In an apparatus for reproducing sounds from a record tablet, the combination with a reproducer mechanism consisting of a sound conveyer, and a diaphragm and stylus mounted at one end thereof, of a supporting frame for the said reproducer, **loosely pivoted to swing freely both laterally and vertically,** substantially as described."

The same comment directed to claim five also applies to claim seven.

Claim twelve, which need not be quoted, specifically includes "a swinging lever system," referring to the lazy-tongs construction of Fig. 3 of the drawings, as does also claim thirteen include "a lever system" referring to the same construction.

It is, therefore, apparent that this Canadian Patent was not intended for any broader invention than the Suess U. S. Patent, No. 427,279, and did not describe any broader invention than that patent; the Circuit Court in the Graphophone Case (R. p. 68, fol. 203), affirmed by the Circuit Court of Appeals, held in this connection:

> "The primary object of Suess, an employee of Berliner, however, was merely to construct a suitable pivotal support for the diaphragm and stylus, so as to assist such device in its passage across the record. It is expressly stated in the specification of the Suess Patent that the invention relates to improvements in the reproducing apparatus of Berliner, and that the construction and mounting of the stylus form no part of the invention."

We submit that Judge Townsend in the Court below was right in granting the preliminary injunction, though he was apparently mistaken in his conclusion where he stated (R. p. 325), "the Canadian Patent in terms describes and claims the broad generic invention of Berliner covered by the claims here in suit."

Defendant's counsel apparently bases his whole contention relative to this Suess Canadian Patent upon claim eleven.

It is upon the basis of this claim, or these claims, notwithstanding the true and proper interpretation of the specification which should be given to them, defendant contends that the fact that these claims (interpreted as defendant interpret them), were inserted in the Canadian Patent, conclusively proves that, as Berliner was the assignee of this application, Berliner thereby admitted that Suess, and not he, was the inventor of claims five and thirty-five.

It is respectfully submitted that there is no warrant in this Canadian Patent for this assumption, but that the evidence is conclusive, as adjudicated by this

Court in the Graphophone Case, that Berliner was the inventor as early as November, 1887 (Rec. p. 73), and there is no evidence in this case to affect that decision.

The defendant contends that thus its interpretation of the Canadian claim eleven must affect the interpretation of claims five and thirty-five, which should, therefore, be narrowly restricted, which connection we submit is without foundation.

The fact that Berliner subsequently applied for and secured his Canadian Patent No. 55,079, for his invention in suit, containing claims 5 and 35, corresponding in all material respects in drawings, specification and claims to the patent in suit, No. 534,543, is, we submit, further conclusive evidence that Berliner did not consider that the Suess Canadian Patent contained his invention of the patent in suit, otherwise he would not have subsequently patented it, as he did.

The Berliner Canadian Patent, No. 55,079, was applied for by him December 7, 1895, and issued February 24, 1897 (R. pp. 314-317). It is admitted that this Canadian Patent is identical with the patent in suit (R. p. 541, Fol. 1622).

The defendant's contention under Point Four is in effect, that as the Suess-Canadian Patent included claim eleven, and was applied for by Berliner as assignee of Suess, it is proof that Suess *anticipated* Berliner, and that claims five and thirty-five are, therefore, invalid. As hereinbefore pointed out, there is no proof in the Suess-Canadian patent that Suess was the inventor of the subject matter of claims five and thirty-five, and there is on this point no material evidence which was not before the Court of Appeals and the Circuit Court in the Graphophone Case.

Suess never claimed to be the inventor of the Ber-

liner invention claimed in claims 5 and 35, **and always acknowledged Mr. Berliner, either directly, or indirectly, as the inventor as shown by the foregoing facts.** Mr. Suess admitted, in his U. S. patent, that what he claimed was a mere improvement on Mr. Berliner's invention. Mr. Suess was an employee of Mr. Berliner in May, 1888, and was present at the Franklin Institute lecture of May 16, 1888, assisting Mr. Berliner when Mr. Berliner described the said invention as his invention, crediting Mr. Suess, however, for the suggestion of the detailed pivot mounting (R., p. 270, fol. 809). The details of Mr. Suess's invention were claimed in the Suess U. S. patent, and nothing else. In the said Franklin Institute lecture, Mr. Berliner refers to his prior disclosure, of November 8, 1887, in the "Electrical World," of his broad invention. Mr. Suess was not in his employ at that date (see Berliner's Test., R., p. 236, XQ. 29). All Mr. Berliner's acts were thoroughly consistent with the facts that he was the inventor of the broad invention of claims 5 and 35, and in his application for his, Berliner's, Canadian Patent, No. 55,079, filed December 7, 1895, by Mr. Berliner, corresponding in all material respects to the Berliner U. S. Patent, No. 534,543, he inserted claims similar to claims 5 and 35.

It is respectfully submitted that Mr. Berliner's acts are thoroughly consistent with his claim for his invention dating back to November 7, 1887, and that there is nothing in the Suess-Canadian patent which could in any manner operate to estop Mr. Berliner from maintaining this claim as contended for by the defendant under Point 4.

POINT FIVE.

Under Point Five of the petition for *certiorari*, and Point Seven of defendant's brief in the U. S. Court of

Appeals, which is attached to the said petition, the defendant claims that this Berliner-Suess Canadian Patent is incontrovertible proof of abandonment by Berliner (defendant's brief attached to petition for *certiorari*, p. 130).

The defendant claims that if Berliner, prior to the date of the Suess-Canadian application, had had any claim to claims five and thirty-five, he abandoned the invention when, as assignee of Suess, he made the application in Canada for the patent.

The cases the defendant cites does not support this proposition, and, as pointed out in this brief under Point Four, there is no foundation whatsoever for this contention of defendant.

The Suess-Canadian Patent in the specification, and drawings, was as narrow and as restricted as the Suess U. S. Patent, No. 427,279 (R. p. 446), which the Court in the Graphophone Case decided was for an improvement on the Berliner invention, and not for the broad claim of the Berliner invention.

In fact, if anything, the Canadian specification even more specifically admits Berliner's broad invention, as hereinbefore pointed out, as it states:

> "My invention has reference to improvements in the reproducing apparatus adapted for use in the method of recording and reproducing sounds **heretofore invented and published by Emile Berliner.**" (Record, p. 157, fol. 471.)

This is a broad and far reaching statement.

It is shown too by Suess, and if the defendant's contention is true, that it is acquiesced in by Berliner because he was the assignee, this statement also would naturally be acquiesced in by Berliner.

The only means shown and described in the Suess Canadian Patent for traveling the reproducing stylus in a straight radial line, is the "lazy-tongs" construction

shown in Fig. 3 of the drawings. When the straight arm shown in Fig. 1 of the drawings, was used with the counter-balancing weight, the reproducing stylus did not travel in a straight radial line, as shown in the Canadian specification (R. pp. 161 and 162), where it states, fol. 483:

> "As the rotation of the tablet is continued, the convolutions of the record groove will cause the stylus to be slowly drawn across the tablet, turning the entire support of the reproducing apparatus on its pivot bearing, the said stylus moving along a *slightly curved path* over the said tablet."

Fig. 1 showed the improvement relative to the adjustable counter-balancing weight.

The only construction for making the reproducer travel in a straight radial path, is that shown in Fig. 3, with an articulated frame so arranged that the stylus will travel in the path of the straight dotted line shown in the lower portion of Fig. 3. The specification states, in describing this (R. p. 163, fol. 488):

> "The outer ends of the links 50, are pivoted to opposing corners of an articulated frame 51, composed of links 52, of equal length, connected together at the ends by pivot pins 53, 54, 55, and 56, respectively, the pins 54 and 55 also connecting the links 50, to the frame at the points before mentioned.
>
> "The pin 56, also pivotally connects one end of a link 57, to the corresponding corner of the frame 51, the other end of the said link being pivoted to the outer end of the arm 44.
>
> "The frame 51, together with the links 50, and 57, constitutes a well-known mechanical movement, by which a curvilinear movement is converted into a rectilinear movement, provided the various links have the proper relative lengths; which is supposed to be the case in this instance, and, therefore, no detailed description of the operation thereof is deemed necessary."

If these claims five, seven or eleven should be broadly interpreted, as contended for, the mere fact that this Canadian patent contains such claims could not possibly prove abandonment by Berliner of his invention of claims five and thirty-five, merely because he happened to be the assignee of the application and patent.

The specification was not executed, or sworn to, by Berliner, but by Werner Suess. The fact that the application was conducted in the interests of Berliner, by reason of the assignment to him by Suess, certainly cannot be construed to operate on such grounds as these, as an abandonment by Berliner of his invention.

Berliner had long previously placed himself indisputably upon record as the inventor of claims 5 and 35 and was so recognized by the scientific public. The great scientific institute, the Franklin Institute, recognized his invention and honored him with an invitation to address the society upon the subject in May, 1888.

Further, the proofs in this case are conclusive that Berliner was the inventor of the invention as early as November, 1887 (R. p. 73), and he so declared himself to be such *in the presence of Suess* in his lecture of May 16, 1888, at the Franklin Institute.

Suess never controverted this proposition, but on August 16, 1889, considerably over a year after the Franklin Institute lecture, filed his application for U. S. Patent No. 427,279 (R. p. 446), in which he laid no claim to being the inventor, and in which he restricted his invention to five narrow, limited claims.

The Suess Canadian Patent was filed by Suess, May 25, 1891, over a year and a half after the filing of the Suess application for the U. S. Patent.

The Suess U. S. Patent was also assigned to Mr. Berliner *before issue,* and if Mr. Berliner regarded

Suess as the inventor of claims five and thirty-five he would have had such claims incorporated in the Suess U. S. Patent, in order that this most important invention should be protected properly.

The Berliner Canadian Patent for the Invention in Suit Filed December 7, 1895.

On December 7, 1895, Mr. Berliner applied for a Canadian Patent with the same drawings, description and claims as the patent in suit, No. 534,543, which Canadian Patent was issued to him, No. 55,079, on February 24, 1897 (R. p. 315). *This is conclusive evidence that Mr. Berliner did not regard the prior Suess Canadian Patent as containing the invention of the U. S. Patent in suit, and is conclusive evidence that there was nothing in the Suess Canadian patent which was intended to convey any intention on his part, direct, or indirect,* to abandon the invention *of the patent in suit.*

Even if there had been an abandonment, which there was not, in Canada, there is no evidence of abandonment of the United States rights.

The Court in the Graphophone Case has passed upon the question of ABANDONMENT and decided that there was none; as herein shown, there is no evidence whatsoever upon which to base any different decision.

Re Alleged New Evidence That the Apparatus of Fig. 10, of the Berliner Patent No. 564,586, Was Impracticable.

The Court of Appeals passed upon the fact of the practicability of the apparatus of Fig. 10 of No. 564,586, as illustrated and described in that patent. A model constructed in accordance with Fig. 10 of that patent, was produced in evidence in the Graphophone Case,

and practically operated in Court. Mr. Berliner's testimony is also clear on this subject.

His testimony (R. pp. 230 to 238 and 239 to 240), refers to and described the construction and the operation of the apparatus shown in Fig. 10. In answer to Q. 3 (R. p. 239), Mr. Berliner produces the model marked "Complainants' Exhibit, Berliner Model," which he states:

> "is practically a copy of a *device used by me in* 1887, about the time the patent in question was filed. We did not then have a box-motor machine, and the records were larger, and the mounting of the rail on which the carriage moved was on separate posts, but otherwise this is such a construction as I then made and *successfully operated.*"

Referring to this construction, such as Fig. 10 as described in the "Electrical World" of November 12, 1887, Mr. Berliner was asked (R. p. 236, Q. 29):

> "You may state whether Mr. Suess had anything to do with inventing this construction of apparatus and method just quoted.
>
> "A. Mr. Suess was not then in my employ, and he had nothing to do with this idea."

(As shown elsewhere, Mr. Berliner meant that Mr. Suess was not in his employ at the time that he made this invention.)

Defendant's counsel contends (Brief attached to the petition for *certiorari*, pp. 140, 141, etc.), that Fig. 10 is an impracticable apparatus, although he has no evidence of this fact, and merely relied upon the assumption that the stylus 29 attached to the diaphragm casing which is secured to carriage 55 on rails 56 in Fig. 10 of patent, No. 564,586 (R. p. 465), must be absolutely perpendicular. The specification, however, states in describing this construction, "The diaphragm casing 31 is secured to a small truck 55, upon rails 56, arranged vertically above and parallel with a diameter of the

reproducing disc, and at such height above the same that the stylus 29 *will be in engagement* with the undulatory grooves of even depth which represent the record of sounds." (R. p. 469, l. 110.)

The words "will be in engagement" obviously mean that the stylus is in such a relation in engagement with the grooves in the record that it will traverse the spiral record groove from start to finish. It cannot be assumed to mean that it will be in engagement *at intervals*. To be "in engagement" throughout the length of the spiral groove, the stylus is placed at an angle slightly out of the perpendicular, with the point pointing in the direction of the travel of the record tablet, as is common in talking machines, and as, for instance, is illustrated by the stylus marked "29" in Fig. 1. Any skilled mechanic in making a construction from Fig. 10 would make it in this way, so that the point would rest or drag in the bottom of the record groove under slight tension, thus it would always be in contact, as shown by the model produced in court, which is a practical working model.

The defendant's contention, therefore, that the apparatus of Fig. 10 is impracticable, is without foundation.

There is nothing in Mr. Hunter's deposition, which defendant's counsel quotes on pages 142 and 143 of his brief, attached to the petition for *Certiorari*, in conflict with this statement. The substance of the testimony is that if in a talking machine there was no capacity for vertical adjustment, this fact would be a disadvantage. Mr. Hunter nowhere here states that there is no capacity for vertical adjustment in the construction shown in Fig. 10.

The stylus resting at a slight angle in the bottom of the groove under slight tension a portion of the weight of the suspended sound box, would, of course, have the capacity for the necessary vertical adjustment

due to any slight irregularities in the record, or turntable.

This point of the defendants, we submit, is another of the captious contentions made without any foundation in fact, but which requires some consideration here in order that the true condition of affairs may not be misunderstood.

POINT SIX.

Under Point Six of the petition for *certiorari*, and under Point Eight of defendant's brief in the U. S. Court of Appeals, a copy of which is attached to said petition, the defendant contends that Berliner Patent, No. 534,543, expired February 11, 1899, before this suit was begun, with the expiration of the term of six years, when the Suess Canadian Patent lapsed by reason of failure to pay the renewal fees.

This is the point concerning which Judge Townsend in his opinion expressed some doubt (R. p. 324, fol. 971). However, the doubt was not sufficient to preclude him from granting the complainants' motion.

It is respectfully submitted that:

1. As hereinbefore pointed out under Points Four and Five, the Suess Canadian Patent was for nothing more than the Suess improvements upon Berliner's invention of claims five and thirty-five, and that the specification did not warrant any broad claim such as five and thirty-five.

2. The fact that the Canadian Patent Office subsequently granted a Canadian Patent to Berliner, No. 55,079, for the invention of Berliner U. S. Patent in suit, is strong evidence that the Canadian Patent Office did not regard the Suess Patent as covering the invention of claims five and thirty-five, and is conclusive evidence that Berliner did not so regard it.

No matter how broad the Suess Canadian Patent may be the term of 18 years for which it was granted has not expired and the Berliner Patent in suit could not be affected.

If the Suess Canadian Patent, No. 41,901, is to be interpreted as contended for by the defendant, and as interpreted by Judge Townsend, who said that it "discloses and broadly claims the invention covered by the claims here in suit," the fact that it lapsed, or expired, on February 11, 1899, at the end of six years, by reason of the failure to pay the renewal fees, can have no effect upon the term of the Berliner U. S. Patent, No. 534,543, in suit, under the authorities.

This Suess Canadian Patent was granted "for the period of eighteen years from the date of these presents," as appears upon its face. Record, p. 156, fol. 467.)

It is also stated in the grant:

> "The partial fee required for the term of six years having been paid to the Commissioner of Patents, this patent shall cease at the end of six years from date, unless at or before the expiration of the said term the holder thereof pay the fee required for the further term or terms, as provided by law."

It is respectfully submitted, under the well-settled authorities, that in construing Section 4887 the period of the prior foreign patent to be taken into consideration with the domestic patent, is the *longest possible term of the foreign patent;* is the period of duration expressed in the grant; or, in other words, the duration of the United States patent is fixed when the United States patent issues by the longest possible term of the foreign patent, and shall not be subject to be terminated by the occurrence or non-occurrence of certain facts which would require extraneous proof.

In this connection the following authorities are cited:

Authorities Re Definiteness of Term of Foreign Patent Upon Which the Term of the United States Patent is Dependent Under Section 4887.

Throughout all the decisions it is clear that the term of the prior foreign patent must be something definite, and not left to subsequent occurrences or non-occurrences.

This question as to whether, when a Canadian patent *ceases* at the end of the first period of the term for which it is granted, by failure to pay the renewal fee, a subsequently issued United States patent for the same invention, expires also, has been decided to the effect that the United States patent does not expire, and is limited only by the *term* for which the Canadian patent was granted, namely, eighteen years, as in the present case.

Diamond Match Co. v. Adirondack Match Co., et al., 65 Fed. Rep. 803.

This was a case in the District of Vermont, decided by Judge Wheeler. A Canadian patent was granted November 13, 1884, for fifteen years, and the partial fee for five years only having been paid, the Canadian patent expired on November 13, 1889. It was contended that the U. S. patent expired at the same time. Bate Co. *v.* Hammond Co., 129 U. S. 151, was relied upon in the argument to support the contention. Judge Wheeler held, in view of the ruling in the Bate Co. case, that the U. S. patent did not expire at the end of the first five-year term of the Canadian patent, and said:

> "The term of the foreign patent seems to be the space of time during which the monopoly is placed within the patentee's control, without reference to whether he sees fit to retain it for the whole time or not. Therefore, the provision of section 4887 of the Revised Statutes that patents shall

be so limited as to expire with any foreign patent for the same invention 'having the shortest term' seems to mean the expiration of such term of the foreign monopoly as the patentee is by the grant of the foreign patent given power over and control of. By the Canadian statute now in force, the term limited for the duration of this monopoly was fifteen years which has yet several years to run. The patent in suit appears to have the same time to run."

Pohl, et al., v. Anchor Brewing Company, 134 U. S., p. 381.

Pohl *v.* Brewing Company is one of the leading cases on this subject, and the law as there expounded by Mr. Justice Blatchford is followed and quoted generally in all of the later decisions of the Supreme Court and of the Circuit Courts in cases where this question is involved.

The following is a portion of Mr. Justice Blatchford's opinion in this case, namely:

"There is nothing in the statute which admits of the view that the duration of the United States patent is to be limited by anything but the duration of the legal term of the foreign patent in force at the time of the issuing of the United States patent, or that it is to be limited by any lapsing or forfeiture of any portion of the term of such foreign patent, by means of the operation of a condition subsequent, according to the foreign statute. In saying that 'every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent,' the statute manifestly assumes that the patent previously granted in a foreign country is one granted for a definite term; and its meaning is, that the United States patent shall be so limited as to expire at the same time with such term of the foreign patent. Such term was held, in Bate Refrigerating Co. *v.* Hammond Co., to be fifteen years and not five years."

In referring in the opinion to the reasons above quoted, Mr. Justice Blatchford further states:

> "This view is made conclusive by the requirement of Section 4887, that if there be more than one prior foreign patent, the United States patent shall be so limited as to expire at the same time with that one of such foreign patents 'having the shortest term.' This means the foreign patent which, at the time the United States patent is granted, has then the shortest term to run, irrespective of the fact that the foreign patent may afterwards lapse or become forfeited by the non-observance of a condition subsequent prescribed by the foreign statute.
>
> "In the view that Section 4887 is to be read as if it said that the United States patent is to be so limited as to expire at the same time with the expiration of the term of the foreign patent, or if there be more than one, at the same time with the expiration of the term of the one having the shortest term, the interpretation we have given to it is in harmony with the interpretation of the words 'expiration of term' in analogous cases. Oakley *v.* Schoonmaker, 15 Wend, 226; Beach *v.* Nixon, 9 N. Y. 35; Farnum *v.* Platt, 8 Pick. 339. In those cases it was held that the words 'expiration of term' do not mean expiration of term through a forfeiture by breach of a condition, but mean expiration by lapse of time."

Pohl, et al., v. Heyman, and
Same v. F. & M. Schaefer Brewing Company, 58 Fed. Rep. 568.

The Honorable Judge Townsend, in this case, reviews the authorities on this subject, quotes from Pohl, *et al. v.* Anchor Brewing Co., *supra,* the portion first above quoted, and adds:

> "THIS SEEMS TO MEAN THAT THE TERM OF THE UNITED STATES PATENT SHALL BE DEPENDENT UPON SOMETHING WHICH IS FIXED AND DEFINITE

IN THE FOREIGN PATENT AND LAWS, AND SHALL NOT BE SUBJECT TO BE TERMINATED BY THE OCCURRENCE OR NON-OCCURRENCE OF CERTAIN FACTS WHICH WOULD REQUIRE EXTRANEOUS PROOF. Bate Refrigerating Co. *v.* Hammond Co., establishes, I think, that the term of the Austro-Hungarian patent was fifteen years at the time the United States patent was granted, and I think that Pohl *v.* Brewing Co. indicates that the term of the United States patent could not be shortened by failure to pay the tax on the Austro-Hungarian patent."

Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co., 21 Fed. Rep. 458.

The Honorable Judge Wheeler, in discussing the lapse of a prior British patent on account of non-payment of taxes, and its effect upon the United States patent, states:

> "The statute merely requires that in such case the patent shall be so limited as to expire at the same time with the foreign patent. Rev. St., Sec. 4887. This seems to mean that the term of the patent here shall be as long as the remainder of the term for which the patent was granted there, without reference to incidents occurring after the grant. Henry *v.* Providence Tool Co., 3. Ban. & A., 501; Reissner *v.* Sharp, 16 Blatchf., 383. It refers to fixing the term, not to keeping the foreign patent in force."

This decision was quoted with approval by Mr. Justice Blatchford, in Pohl *v.* Brewing Co., *supra.*

Consolidated Roller Mill Co. v. Walker, 43 Fed. Rep., 575.

The Honorable Judge Acheson, in discussing the term of expiration of an Austrian patent, lapsing by

reason of a condition subsequent to its grant, and its effect upon the term of a subsequent United States patent, states (on p. 581), as follows:

> "It seems, therefore, to be the logical and necessary conclusion from these two decisions of the Supreme Court, that, if by the foreign law under which a patent is granted, the patentee, by virtue of the original grant, is invested with the right, at his mere option, to have the patent extended or prolonged for a fixed term, it is this latter term which limits the United States patent, under Section 4887 of the Revised Statutes. Thus is the life of the United States patent definitely fixed when it is granted, and its duration is not left in perplexing uncertainty, depending upon the future exercise of an option in a foreign country, or the observance there of conditions subsequent."

Welsbach Light Co. v. Apollo Incandescent Light Co., et al., 96 Fed. Rep. 332.

In this case, Judges Wallace and Shipman, for the Circuit Court of Appeals for the Second Circuit, speaking through the Honorable Judge Shipman, held that where a foreign patent lapses for non-payment of a tax, although it was while the application for United States Patent was pending, such lapsing of the foreign patent does not render the United States Patent void when issued, but said United States Patent will remain in force to the end of the term prescribed in the foreign patent, in this case, it being a French Patent, the term of the United States Patent was held to be 15 years.

All of these authorities, without exception, make it clear that it is the *term for which the foreign patent is granted*, or to which it is capable of being extended at the option of the patentee, or, in other words, the term of the foregn patent at the time it is issued, and

not an indefinite and uncertain duration of the patent right consequent upon the non-observance of some condition subsequent to the grant of the patent.

The Berliner-Suess Canadian Patent, No. 41,901, was granted February 11, 1893. The grant contained in the letters patent reading, in part, as follows, namely (R. p. 156):

> "Now therefore the present patent grants to the said Emile Berliner, his executors, administrators, legal representatives and assigns, for the period of **eighteen years** from the date of these presents, the exclusive right, privilege and liberty of making, constructing and using, and vending to others to be used, in the Dominion of Canada, the said invention, subject nevertheless to adjudication before any court of competent jurisdiction."

As in all Canadian letters patent granted under the same act, if only a partial fee is paid, the term of years for which this partial fee is paid is cited.

Therefore, applying the above authorities to the present case, we find that this Berliner-Suess Canadian Patent, being granted in February, 1893, for eighteen years, if it were for the same invention as claims five and thirty-five of the patent in suit, which we deny, and have pointed out, would not cause the patent in suit to expire until the expiration of eighteen years from February, 1893, namely, February, 1911, notwithstanding the fact that the renewal fees may not have been paid, and notwithstanding the fact that this Canadian Patent may have lapsed in six or twelve years by the non-payment of the second or third year partial fee.

Paillard, et al., v. Bruno, 29 Fed. Rep. 864.

This was a case in the Southern District of New

York, decided by Judge Wallace, who held that under Section 4887 the expiraton of an English Patent, by failure of the patentee to pay the stamp duty, did not cause the expiration of the U. S. Patent.

After referring to the cases of Holmes Electric Protective Co. *v.* Metropolitan Burglar Alarm Co., 21 Fed. Rep., 458, and Henry *v.* Providence Tool Co., 3 B. & A., 501, and Reissner *v.* Sharp, 16 Blatch., 383, Judge Wallace states:

> "It was held in both cases that the section in question (4887) should be construed to mean that the United States patent is to expire at the time **of the original term of a foreign patent for the same invention.**"

Judge Wallace also quotes from Mr. Justice Clifford in Henry *v.* Providence Tool Co., as follows:

> "Congress employs the words 'the foreign' patent, evidently referring to the **term** of the foreign patent to define the term of the domestic patent."

and then states that the conclusion of Mr. Justice Clifford

> "was reached upon the consideration that Congress could not have intended to grant a patent for an indefinite term, or for an uncertain and undefined duration, which would be the case if its duration could not be ascertained by referring to the foreign patent, or were to depend upon any events occurring subsequently to the issue of the foreign patent."

In this case it is seen that Judge Wallace makes the expiration of the United States Patent depend upon the expiration of the *full term* of the foreign patent, holding that unless the duration of the foreign patent can be ascertained from the foreign patent itself, the term of the United States Patent would be indefinite

and uncertain, namely, that it would be dependent upon the "occurrence or non-occurrence of certain facts which would require extraneous proof," as held by Judge Townsend in the later cases of Pohl, *et al., v.* Heyman, and Pohl, *et al., v.* The Brewing Co., 58 Fed. Rep., 568, which was decided in 1893. Judge Wallace also employs the same reasoning as did Mr. Justice Blatchford in Pohl, *et al., v.* Brewing Co., 134 U. S., 381, with regard to the meaning of the word "term" in reference to a foreign patent, when there is more than one foreign patent, that is to say, that it "indicates" that the time of expiration is to be ascertained by the term of the patent, because the use of the word "term," in reference to a foreign patent, when more than one such patent exists, indicates the *time of duration.* Judge Wallace further states:

> "Upon this construction, the duration of the term **United States Patent is fixed when the patent issues,** according to the maxim *'id certum est quod certum reddi potesti.'* Upon any other construction, neither the commissioner of patents, nor the patentee, nor the public would know the duration of the grant. **The term of a patent is the period of duration expressed in the grant."**

It is in this case that Judge Wallace refers to the fact that of two or more foreign patents the one having the foreign patent, that is to say, that it "indicates" that the time shortest term may have the longest life; that is to say, **the non-payment of the taxes or the failure to work the foreign patent having the longest term, would cause it to expire before another foreign patent having a shorter term** in connection with which these conditions were complied with.

Walker on Patents, p. 151, in referring to the termination of a United States Patent by reason of the forfeiture of a prior foreign patent, states:

> "The termination of a foreign patent, prior to its appointed end, because of an omission of the patentee to do what the foreign laws require in order to keep it in force, has no effect upon the duration of a corresponding United States Patent."

and cites Pohl *v.* Brewing Co., 134 U. S., 381; Holmes Co. *v.* Alarm Co., 21 Fed. Rep., 458, and Paillard *v.* Bruno, 29 Fed. Rep., 864.

Bate Refrigerating Co. v. Gillette, 31 Fed. Rep. 809.

This case was decided by Mr. Justice Bradley on Circuit (District of New Jersey).

In this case there was a prior British Patent granted for 14 years, which became void within three years owing to the failure of the patentee to pay the stamp duty, and it was contended on behalf of the defendant that the United States Patent, by operation of law, ceased and terminated at the same time. Mr. Justice Bradley states:

> "I do not think that this position is maintainable. The English patent was granted for a term of 14 years, subject to be defeated by the non-performance of a condition subsequent. I do not think that the American patent became subject to the same condition. **The term of the English patent fixed the term of the American patent; nothing more, nothing less.** The subsequent fate of the English patent had no effect upon the American. **The life of each after its inception proceeded independently of the life of the other.** See Protective Co. *v.* Burglar Alarm Co., 21 Fed. Rep. 458; Paillard *v.* Bruno, 29 Fed. Rep. 864."

Edison E. Co. v. Electric E. S. Co., 60 Fed. Rep. 400 (404), Judge Coxe:

> "Where a foreign patent clearly and unmistakably shows on its face a definite term of years,

it would seem, in the absence of proof to the contrary, that the term so shown must be accepted by the Court as limiting the life of a patent."

In Am. & E. Enc. of L., Vol. 22, p. 384, it is stated:

"Where the foreign patent, once granted, lapses or becomes forfeited for the non-observance of some condition subsequent, or some formality, the United States Patent, if granted, **before such lapse or forfeiture,** is not affected thereby, but continues in force for the definite term granted as if no lapse had occurred." Citing:

Pohl *v.* Anchor Brewing Co., 134 U. S. 381;
Paillard *v.* Bruno, 29 Fed. Rep. 864;
Bate Refrigerating Co. *v.* Gillett, 20 Fed. Rep. 192, and 31 Fed. Rep. 809;
Pohl *v.* Heyman, 58 Fed. Rep. 568;
Diamond Match Co. *v.* Adirondack Match Co., 65 Fed. Rep. 803;
Welsbach Light Co. *v.* Apollo Incandescent Gas Light Co., 96 Fed. Rep. 332.

Bonsack Machine Co. v. Smith, 70 Fed. Rep. 383.

The Honorable Judge Simonton, after reviewing Pohl *v.* Brewing Co., *supra,* and the authorities therein referred to, reaches the following conclusion, namely:

"What, then, is the term of these Canada patents? Evidently, from these cases quoted above, the contract in the grant of the patent between the government and the patentee is that the life of the patent shall be governed by the term originally granted to him by the foreign patent, notwithstanding any premature termination thereof by non-performance of conditions subsequent by him. THE GRANT OF THE UNITED STATES LOOKS TO AND IS GOVERNED BY THE FOREIGN PATENT, AS IT IS AT THE TIME OF THE ISSUE OF THE UNITED STATES PATENT."

And further on in this decision (p. 394) the learned Judge states that the "term of the original patent must expire by its own limitation, and **not by subsequent forfeiture.**"

Under Point Eight of defendant's brief attached to the petition for *certiorari* (page 145), under which point it is contended that the patent in suit expired February 11, 1899, with the expiration of the first period of six years of the Berliner-Suess Canadian Patent, No. 41,901, of February 11, 1893, defendant's counsel seeks, beginning on page 154, to place an interpretation upon the decision of Judge Simonton in this case, which is entirely at variance with what Judge Simonton decided, and with the facts of the case.

Defendant's counsel would lead this Court to believe that the facts in the case of the Bonsack Machine Co. *v.* Smith were practically the same as the facts in the present case, but this is not so. The facts in these two cases could not be more at variance, for in the Bonsack case the Canadian Patent was *granted for a term of five years,* and in the present case the Canadian Patent in question was granted for a term of eighteen years. In interpreting this Bonsack case it must be remembered that the Canadian Patent in question in that case was not granted under the Canadian law under which the Canadian Patent in this case was granted. Judge Simonton, on page 393, points this out, and referring to the Canadian Patent, states, "The express language of these patents fixes the term of each at five years," that being under the Act of 1872. This Act permitted the Canadian patentee to tack on to this original term of the grant of five years, for which his patent was granted, two more successive terms of five years, upon the performance of certain conditions. *But the Canadian Patent was only* GRANTED *for five years.* Judge Simonton further says, on page 394:

"By examining the Canadian patents to Bonsacks it will be seen that **the term of each patent is distinctly declared to be for five years.**"

The point decided by Judge Simonton was, that the Canadian Patent having been granted for a term of five years, *the duration of the term of the grant* was what controlled the American Patent. In the Bonsack case it was sought to construe the term of the Canadian Patent to be fifteen years, because by the payment of two subsequent fees the patentee could have secured two additional terms of five years each; and under an amendatory act in Canada, passed in 1883, it was declared that all patents previously issued should be deemed to have been granted for a term of 15 years. Judge Simonton held that the Amendatory Act could not in any wise affect the date of the expiration of an American Patent, where a Canadian Patent had been taken out under the statute of 1872, and the American Patent issued before the Amendatory Act of 1883. Judge Simonton simply held that it was the term of the Canadian Patent expressed on the Canadian Patent at the date the United States Patent issued that governed the life of the United States Patent. In other words, that when the United States Patent issued under the provisions of Section 4887, it was limited by the then existing Canadian Patent, and under the reasoning which we have seen has governed the decisions of all these cases, the term must be something certain at the date of the United States Patent. Judge Simonton held that a subsequent Amendatory Act in Canada, although it may have given other rights to the Canadian patentee, could not change the duration of time that the United States Patent would exist, because the duration of the United States Patent was determined upon the issuance of the United States Patent, namely, that the United States Patent should expire with the

term of the existing Canadian Patent, and that the Canadian Patent in that case was granted for a term of five years. Of course, we have seen, under this and other decisions, that if a patentee in Canada took advantage of the laws and extended his patent for five or ten years, so that the term was continuous, our Courts have given him the benefit of the longer period.

But what are the facts of the case at bar, and what is the term for which the Suess-Canadian Patent, No. 41,901, of February 11, 1893, was granted? It is eighteen years. The grant reads (R. p. 156):

> "Now therefore the present patent grants to the said Emile Berliner, his executors, administrators, legal representatives and assigns, for the period of **eighteen years** from the date of these presents, the exclusive right, privilege and liberty of making, constructing and using, and vending to others to be used, in the Dominion of Canada, the said invention, subject nevertheless to adjudication before any Court of competent jurisdiction."

The term, then, of the Canadian patent in question is **eighteen years.** The term of the patent was not six years, as appellants contend, and capable of being extended for two more periods of six years, as it was (five-year periods) in the Canadian patent in the Bonsack case, but it was for a period of eighteen years.

The facts in the present case are similar to the facts in the case of the Diamond Match Co. *v.* Adirondack Match Co., *supra.* We have seen that in this last case the patent was granted for fifteen years, but only the partial fee for the first period of five years was paid, and the Canadian patent ceased at the end of that first five-year period; but the Court held that *it was only the* TERM *of the patent which could be considered as limiting the United States patent,* namely, the fifteen-year term for which it was granted. And so also, in the case at

the Canadian patent was granted for eighteen
:s, and although it ceased in six years, for failure to
another fee, yet, under the ruling in this Diamond
ch Co. case, and the other authorities cited, it is per-
ly clear that the only term to which we can look to
t the United States patent is the original term of the
adian patent.

The matter at the top of page 155 of defendant's
f accompanying the petition for *certiorari* is mis-
ling, if not inaccurate. If defendant's counsel had
concealed from this Court the real facts of the
nges in the Canadian laws, controlling respectively
Bonsack case and the case at bar, and had explained
is brief the fact that under the Act of 1872 the Cana-
n patents were granted for a term of five years; that
er the Amendatory Act of 1883 they were granted
a term of fifteen years, we would not have the neces-
of explaining away this misinterpretation which
endant's counsel has sought to give to this Bonsack
e, by his failure to explain to the Court this change
ne law.

At the top of page 155 of defendant's said brief the
rtion is made that, "although the duration of the
ns was changed at the time" the Berliner-Suess
adian patent was issued, the "substance of the pro-
ons is identical in each Act," and that thereby a
ure to pay a further fee and secure a further term
ses the *expiration of the term* of the Canadian pat-

It is true that under the Act of 1872, at the end
he five-year term of the Canadian patent, upon the
ure to pay another fee, there was an "expiration of
term" of such Canadian patent. And naturally, be-
se five years was the term of the patent, as stated in
grant forming the contract between the Canadian
ernment and the patentee. But this is not so under
Act as amended, nor in the present case, because the

grant in the patent, forming the contract between the Canadian govrnment and the patentee in the present case made the term of the patent **eighteen years.** Although the Suess Canadian patent ceased at the end of six years by reason of the failure to pay another fee, yet that cessation was not the "expiration of the term" of said patent.

None of the decisions have held that the *term* of a Canadian patent expired upon the failure to pay the fee for the second or third term, when the term of said patent was for fifteen or eighteen years; but that when the term of the Canadian patent was for five years only, capable of being prolonged, the failure to pay the fee to prolong said patent caused an "expiration of the term" of five years, and, naturally, for that is the expiration of the term for which it was granted.

And the same reasoning applies to the Italian patent referred to in Westinghouse Electric Co. *v.* Citizens' Tel. Co., 106 Fed. Rep. 215 (p. 161, defendant's said brief). The Italian patent in that case *was granted for a term of three years.* It could have been prolonged for fifteen years, but the grant in the Italian patent was for a term of three years.

So also in the Electric Accumulator Co. *v.* Brush, 52 Fed Rep. 130 (p. 162 defendant's said brief). In this case the Italian patent was issued for a term of three years, and the term for which it was issued, of course, controlled the United States patent. Said Italian patent never having been prolonged, renewed or extended, the termination of the three-year grant was undoubtedly "the expiration of its term."

In Edison Co. *v.* United Co., 52 Fed. Rep. 300 (defendant's said brief, 163), the Canadian patent was maintained for a continuous term of fifteen years; there was no cessation of this patent, and the case is not applicable to the case at bar. In Edison Co. *v.* United Co., the Court held that the Swedish patent did not

limit the Canadian patent, and that the term of the Canadian patent was for fifteen years, consequently, that case does not apply to the facts in the case at bar.

And in connection with the last paragraph on page 164 of defendant's said brief, we again have the fact that the Italian, Austrian and Bavarian patents were granted for terms of one, two and three years, and these "terms" were capable of being prolonged or renewed. Then, as in the Italian case, the terms of these patents expired at the termination of the term for which they are renewed or prolonged, and the Courts have so held uniformly, and such is the ruling in the Bonsack case, namely, that, although the Canadian patent was granted for a term of five years, yet if it was renewed and became a continuous term of ten or fifteen years, the longer term would control the expiration of the American patent.

In Gramme Electric Co. *v.* Arnoux, 17 Fed. Rep., 838, referred to on page 165 of defendant's said brief, we have the same condition as regards the Canadian patent granted for five years, but capable of being extended, or the Italian Patent granted for three years and capable of being extended. In this case it was an Austrian patent which, as Mr. Justice Blatchford states, on page 839, was granted "for the duration of one year." One year was the term for which the patent was granted, although it was capable of being prolonged. It was prolonged for ten years, but each prolongation was considered under the Austrian law as extending the continuous term for ten years, and under the same ruling, as made by Judge Simonton in the Bonsack case, the United States patent expired in ten years.

But in all of these cases we have this clear and unmistakable distinction: The Canadian patent in the Bonsack case; the Italian, Austrian and Bavarian patents were granted for terms of one, three or five years.

That was the term of the foreign patent as expressed in the grant upon the date that the United States patent issued, just as Judge Simonton said in the Bonsack case, namely:

> **"The grant of the United States patent looks to and is governed by the foreign patent, as it is at the time of the issue of the United States Patent."**

Or, as Mr. Justice Blatchford said in Pohl *et al. v.* Anchor Brewing Co., *supra:*

> "There is nothing in the statute which admits of the view that the duration of the United States patent is to be limited by anything but the duration of the legal term of the foreign patent in force at the time of the issuing of the United States patent."

Or, as Judge Wallace said of Paillard *v.* Bruno, 29 Fed. Rep. 864, and which he approved:

> "It was held in both cases, that the section in question (4887) should be construed to mean that the United States patent is to expire at the time of the original term of a foreign patent for the same invention. * * *
>
> "Upon any other construction, neither the Commissioner of Patents, nor the patentee, nor the public would know the duration of the grant."

Not one of the authorities referred to in defendant's said brief supports its contention that the United States patent in suit expired with the termination of the first six-year period of the Canadian-Suess patent, or, in other words, at the time when it ceased; in fact, they support complainants' contention to the contrary, and, as before said, if in defendant's said brief, it had been clearly explained that the term of the Berliner-Suess Canadian patent, that is to say, the term for which it was granted by the Canadian government was

eighteen years, and not six years, and that in this it differed from the Canadian patent in the Bonsack case in that said latter patent was granted for a term of five years, and not fifteen years, no misapprehension could have occurred. But, on the contrary, as we have shown, defendant's said brief seeks to create the impression that the conditions under which the Canadian patent in the Bonsack case, and the Canadian patent in this case were issued, were the same. This is not the fact, as we have shown.

Defendant's counsel contends under Point Eight, of said brief, sub-division d (p. 150), that under the Canadian Patent Act, a Canadian Patent "expires" within the meaning of section 4887, at the expiration of the term for which the fee to the government has been paid, and that the patent does not lapse, and is not forfeited, but that its term expires. No decisions are cited in support of this contention, at which we do not wonder, because there are no decisions to support it. All of the decisions, as we have shown, are to the effect that under the *old* Canadian patent law of 1872, when the term for which the Canadian patent was granted was five years, said patent did "expire" at the termination of its five-year period, unless another fee was paid. But, on the other hand, under the Canadian patent law *as amended,* and under which the Berliner-Suess Canadian patent was granted, the term for which the patent is granted is eighteen years, and this term of eighteen years, as Judge Wheeler decided in the Diamond Match Co., case, was the term to which we look in determining the duration of the United States patent. Although upon the issuance of the Berliner-Suess Canadian patent the fee for the first period of six years only was paid, yet that did not affect the term for which the patent was granted, and the failure to pay fees for the second and third terms of six years, did not change the term for which the Canadian patent was granted, but

simply had the effect of terminating the Canadian patent. In other words, the Canadian patent was terminated by the non-occurrence of something required by the Canadian law subsequent to its grant for the term of eighteen years.

It is manifest that by the failure to pay this fee for the second period the Canadian patent, although granted for eighteen years, lapsed or became forfeited, in exactly the same way that an English, French or German patent lapses or forfeits when the taxes or annuities are not paid at the periods stated in the laws of these countries. For instance, Great Britain grants a patent whose life is dependent upon the payment of another fee within four years after its date and then at certain stated periods thereafter. France and Germany grant patents and require, as a condition to keep them in force, for the term for which they are granted, the payment of taxes or annuities. And so in Canada, as in these foreign countries, the first fee paid upon the filing of the application carries the patent for a certain period of years. The failure to pay a second fee on the patent in Canada, Great Britain, France or Germany, causes the patent to cease and terminate at the date when such additional payment is required. It matters not what name we may call these additional fees, they have the same effect. These foreign countries say that they will grant you a patent for fourteen, fifteen or eighteen years upon the payment of a certain fee, but that if you do not pay another fee within a stated period, the patent will lapse or forfeit at that date. Canada requires a second fee within six years; Great Britain a second fee within four years, and France and Germany a second fee within one year. The Canadian law may use the term "fee," the other countries may use the term "tax" or "annuity," but that is simply terminology. It does not affect the law which grants the patent for a certain term of years; but the failure

to pay these fees, taxes or annuities has the same effect, namely, to cause the cessation, expiration, forfeiture, or lapsing of the patent, whatever it may be called. And these foreign countries also make other conditions, namely, as to working or importation, the occurrence or non-occurrence of which causes the patent to lapse, forfeit, expire, or cease. But none of these can change the grant nor specify the term for which the patent is granted, and which term existed at the date of issue of the United States patent. They are conditions subsequent which, as Judge Townsend said in Pohl *et al. v.* Heyman, *supra,* "the occurrence or non-occurrence" of which would require extraneous proof.

Therefore, the labored attempt in defendant's said brief, under Point Eight (p. 145), in the Brief attached to the Petition and noted as Point Sixth in its Petition, to make a distinction between a lapse or a forfeiture of a patent by failure to pay taxes, or annuities, or to work the same within a certain period, and the termination of the Canadian patent by the failure to pay the second fee or tax, is without reason, not only because in each of these foreign countries the patent is granted for a certain term which is not, under the decisions affected, so far as the limitation of the United States patent, under Section 4887 is concerned, but in view of the fact that under all of the authorities we have cited, it is the definite term contained in the grant of the previous foreign patent, existing at the date of the United States patent, which limits the duration of the United States patent.

POINT SEVEN.

Under this point in the petition for the writ of *certiorari* (page 30), defendant contends that the patent in suit, as to claims five and thirty-five, is anticipated by the British Patent, No. 1644, of 1878 to Edi-

son (R. p. 472), if those claims are to be broadly construed and not limited to the special form of reproducer shown in Figs. 6 and 7 of the patent in suit. We think it is conclusively shown that these claims five and thirty-five are not to be construed as limited to the form of reproducer shown in said Figs. 6 and 7, but are for Berliner's broad and basic invention, as decided by the U. S. Circuit Court of Appeals and the Circuit Court in the present and in the litigation in the Graphophone case. This contention which the defendant sets forth in Point Seven of the petition for writ of *certiorari* is discussed under Point Ten of the defendant's brief in the Circuit Court of Appeals, a copy of which is attached to said petition, and it is another illustration of the extreme length to which the defendant goes in the endeavor to defeat the patent in suit.

Re Edison British Patent, No. 1644, of 1878.

This Edison British Patent was fully before the United States Circuit Court of Appeals and the Circuit Court in the Graphophone case, and was fully considered by Judge Hazel (R. p. 65, Fol. 195) and affirmed by the Circuit Court of Appeals (R. p. 73), and there is absolutely nothing in the said British Patent to Edison which could be construed as an anticipation of the claims in suit.

The defendant's sole excuse for contending again that this patent is an anticipation of claims five and thirty-five of the patent in suit, is that perhaps the Circuit Court of Appeals and the Circuit Court in the Graphophone case considered only a portion of this patent and not all of it, and in support of this contention urged the opinion of one Harry T. Goss in the form of an affidavit (R. p. 297) regarding this patent, as against the opinion of the Circuit Court of Appeals

and the Circuit Court in the Graphophone case. A brief consideration of Mr. Goss' affidavit will suffice.

Mr. Goss, in his affidavit (p. 297) also considers this Edison British Patent as an anticipation, which was also before the Court of Appeals and the Circuit Court, in the suit against the American Graphophone Co. for infringement of the Berliner Patent in suit.

Mr. Goss, however, notwithstanding the fact that this Edison Patent was before the Court fully, thinks the Court has overlooked something in it.

Mr. Goss says, in substance, that Fig. 34 (R. p. 486) of this British Patent shows the feature of guiding the sound box by means of the sound record itself, and says that he has prepared a model marked "Exhibit, Model, Edison British Patent." Of course, it would be very easy, at this late date, in the light of what Mr. Berliner has done, and where the wish is father to the thought, for Mr. Goss, who says he is a mechanical engineer and expert, to build a model according to his own notions of what Fig. 34 ought to represent. He says that this Fig. 34 is described on page 8 of the specification as follows (R. p. 301, fol. 903):

> "Fig. 34 is a perspective view showing a double phonet, there being a spiral line of indentations on each side of the revolving disc *d*, one phonet coming into action as the other finishes; in this case the spirals should be in opposite directions, so that the disc continuing to revolve in the same direction moves one phonet from the center outwards, and then the other phonet is connected and moved back toward the center; this may be used as a toy."

Mr. Goss says that there is no mechanical feed in this figure, and nothing for guiding or propelling the sound box save the record groove, and that it is like the claims in suit.

Mr. Goss does not seem to take into consideration that Fig. 34 is practically a diagrammatic sketch and that the description quoted of this sketch is not complete, and neither is the sketch.

Fig. 34 itself shows no mechanism for operating the record tablet, nor does it show any mechanism which would move the one phonet after it has traversed the face of one of the records so that the other phonet would become engaged as the first one becomes disengaged. The device shown in the sketch certainly would not be operative, as it is illustrated there. These numerous sketches in this British Patent, 1644 of 1878, are mostly incomplete, and the attention of the Court is directed to this patent (R. p. 472, etc.), itself, and to these numerous sketches in the drawings. Edison shows some sixty-six different sketches embodying different thoughts and ideas in connection with the talking machine, most of which are diagrammatic and incomplete. The descriptions of the same contained in the specification are very brief and incomplete. The main invention shown in Figs. 1 and 2 is most fully described; the others are but fragmentary. The record which he assumes to use in these devices is apparently the tin foil upon soft wax, in which the record is made by an indenting point. This record was very easily "ironed out" and could not possibly propel of itself a stylus point, and required positive propelling mechanism so as to prevent the stylus point in reproducing from defacing or ironing out the record.

None of the numerous sketches showing proposed forms and variations are complete or contain the propelling mechanism, rather the propelling mechanism is omitted from most all of them, though, in order to operate, it must be supplied as well as other features of construction, to make the devices operate, if they would even operate then.

In the case of the American Graphophone Com-

pany *v.* Leeds, *et al.*, 87 Fed. Rep., 874, which was a suit for alleged infringement of the Bell & Tainter Patent, No. 341,214, this Edison Patent, No. 1644, of 1878, was very much in evidence. Judge Shipman's adjudication of this patent as a reference in that case, is quite to the point here, especially as he considers Fig. 34, to which Mr. Goss has attached so much importance. Judge Shipman says, in referring to this Edison British Patent:

> "This patent contained some of the suggestions and sketches of various sorts and kinds which Mr. Edison had thought of or had made during his experiments upon a subject novel, intricate and scientific, which required manifold and delicate experiments, and in which he took a great interest. Some of his surmises and beliefs in regard to what could be or might be done were thrown into this patent. The defendants' expert, with manifest consciousness of the difficulties in the text, translates the language of the descriptions of Figs. 27, 34 and 37 to mean that Edison had in his mind gravity reproducer, or to show that such a reproducer can be inferred from the language. **These descriptions are confessedly vague, and it is confessedly difficult to know the interpretation which the writer placed upon some of the words which he uses.**"

From the foregoing it is clear that Fig. 37 is in the same category with Fig. 34, and can carry no greater weight.

This entire patent was fully before the Court in the Graphophone Case. Judge Townsend said of this Edison British patent, in deciding this case in the Circuit Court: "The defence founded on the prior Edison patent will not be discussed because said patent was before the Court in the original suit" (R. p. 327).

POINT EIGHT.

The alleged defence relied upon under this point in the petition for *certiorari*, is that the patent in suit was anticipated by the Bell & Painter Patent, No. 341,214, of May 4, 1886 (R. p. 387). This is a defence not passed upon by the Circuit Court of Appeals or the Circuit Court, and not set forth as an error in the Assignment of Errors (R. p. 534) in this cause. It was, however, before the Circuit Court of Appeals and the Circuit Court in the Graphophone Case, and Judge Hazel discussed the same at some length (R. p. 63), and for the further reasons hereinafter set forth, it is submitted that this defence should not be considered by this Court as it was not passed upon nor urged in this litigation in the Circuit Court of Appeals or the Circuit Court. Defendant's counsel admits such to be the fact on page 39 of the petition for *certiorari* herein, where he states:

> "Under familiar practice defendant, the petitioner above-named, was not free to argue again, either in the Circuit Court or in the Circuit Court of Appeals, any of the grave and important questions of law decided in the prior suit."

The point as to whether this Bell & Tainter Patent anticipated the patent in suit was carefully considered and passed upon at length by Judge Hazel in the Graphophone Case and affirmed by the Court of Appeals, so that this is one of the points which defendant's counsel admits he was not free to argue in the courts below in this litigation, and which he now urges for the first time in this Honorable Court, and asks this Honorable Court to review the decision of the Appellate Court as to a point upon which it did not pass.

This Alleged Defense not Urged in the Circuit Court of Appeals, and not Assigned as an Error in the Circuit Court.

Although the Bell & Tainter Patent was introduced by the defendant, as a part of the prior art, in opposition to the motion for preliminary injunction before Judge Townsend, it was not argued nor relied upon as an anticipation of the patent in suit as the defendant has done under Point Eight, in the petition for *certiorari* herein. Defendant's affidavits in opposition to the motion for preliminary injunction do not set up this Bell & Tainter Patent as an anticipation of the patent in suit. This alleged defence is not referred to in the opinion of Judge Townsend granting the motion for preliminary injunction (R. p. 318). This alleged defence was not assigned as an error (R. p. 534) in connection with the appeal to the U. S. Circuit Court of Appeals, and was not urged nor relied upon in the defendant's brief before the Circuit Court of Appeals, a copy of which is attached to the petition for *certiorari* herein. It is manifest that not having been urged before the Circuit Court, nor referred to in the opinion of Judge Townsend nor assigned as an error, nor urged in defendant's brief before the Court of Appeals, this defence was not considered by the Court of Appeals, the decree of which Court of Appeals is now before this Honorable Court for review. Under Point Eight, page 31 of the petition for *certiorari* herein, this alleged defence is now apparently urged for the first time.

This was one of the main defences in the Graphophone Case and was treated at great length by Judge Hazel in the Circuit Court (R. p. 65, Fol. 195) and affirmed by the Court of Appeals.

We submit, therefore, in view of the authorities, that this contention or alleged defence on the part of the defendant should not receive the consideration of

this Court. A similar question was before this Honorable Court in U. S. *v.* American Bell Telephone Co., 167 U. S., 224, in which it was stated as follows:

> "The three remaining grounds of relief asserted by the government may be considered together. Defendants contend that as the last two, although urged in the circuit court, were not presented to the court of appeals (referring for this fact to the opinion of the latter court and also a notice which was contained in the brief of counsel for the government), we are precluded from noticing them, citing as authority Bell *v.* Bruen, 42 U. S., 1 How., 169 (11:89); Alviso *v.* United States, 75 U. S., 8 Wall., 337 (19:305); First Nat. Bank *v.* Kentucky, 76 U. S., 9 Wall., 353 (19:701); Rogers *v.* Ritter, 79 U. S., 12 Wall., 317 (20:417); Klein *v.* Russel, 86 U. S., 19 Wall., 433 (22:116); Wood County Supers. *v.* Lackawanna Iron & C. Co., 93 U. S., 619 (23:989); Wilson *v.* McNamee, 102 U. S., 572 (26:234); Wood *v.* Weimar, 104 U. S., 786 (26:779); Topliff *v.* Topliff, 145 U. S., 156 (36:658); McGahan *v.* National Bank of Rondout, 156 U. S., 218 (39:403), and Carr *v.* Fife, 156 U. S., 494 (39:508)—in which cases, with more or less particularity, the proposition is announced that this court will not consider questions not presented to and passed upon by the lower court."

While, therefore, it is respectfully submitted that this defence should not be considered by this Court, and while protesting against and objecting to the same, yet as the defendant has seen fit to dwell upon this point elaborately in Point Eight of his petition for *certiorari* (page 31), the complainants feel compelled to reiterate the position taken before the courts in the Graphophone Case, and to point out wherein this Bell & Tainter Patent, No. 324,214, is not an anticipation of the patent in suit, as was decided by the Court of Appeals and the Circuit Court in the Graphophone Case.

The Defense that Claims 5 and 35 are Anticipated by the Bell & Tainter Patent.

The defendant evidently relies considerably upon this patent as an alleged anticipation of claims five and thirty-five of the patent in suit. The Bell & Tainter Patent is No. 341,214 (R. p. 387), and was issued May 4, 1886, to Chichester A. Bell and Sumner Tainter, Washington, D. C., for improvement in recording and reproducing speech and other sounds. This patent was owned by the American Graphophone Company, the complainant in the Graphophone Case, and expired May 4, 1903. It was primarily for a sound record of the vertically undulating type, formed by means of a *cutting* or *engraving* style in *wax*, or *wax-like* material, in which a smooth cut was made by the recording stylus, which *removed the material from the groove*, and produced a smooth record of that character, as contradistinguished from the indented record of Edison, which preceded it. The specification states (p. 1, line 31, etc., Record, p. 391):

> * * * "the essential new feature of which (the present invention) is the removal of material to form the record by a cutting, gouging, or graving action of the vibrating style. Heretofore the vibrating style has, as in Edison's well-known phonograph, simply indented the recording material. * * * In this new or improved form of record not only may a larger number of words or sounds be recorded in a given surface than has been practicable with the indented records heretofore in use, but the recorded vibrations are also sharper and better defined. It is found that an indenting style smooths over the crests of the larger elevations, and also rubs out some of the finer ones."

The specification also specifies numerous additional features in which the invention is stated to consist. For a clear understanding of the construction

of the apparatus described in this patent the attention of the Court is particularly requested to the drawings and specification of the patent, which is contained in (Record, p. 387-398).

Fig. 1.

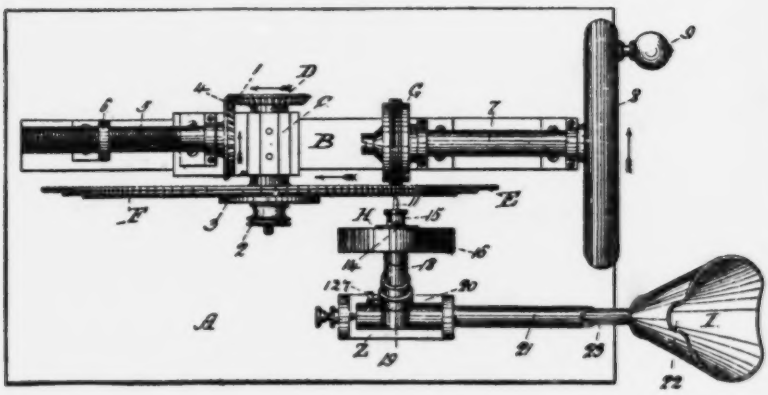
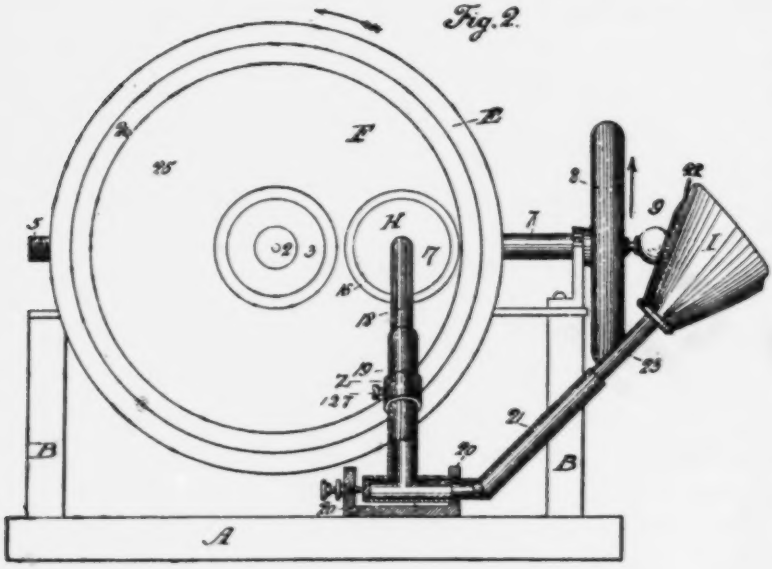


Fig. 2.



The machine described in this Bell & Tainter Patent is illustrated in the four sheets of drawings attached to the patent and particularly in Figs. 1 and 2. The patent shows, and the specification describes, a disc tablet of wax-like material, attached by a thumbscrew upon a disc or table, substantially vertically disposed upon the outer face of which wax tablet is engraved in helical form a vertically undulating sound record groove of *uneven* depth. This construction is shown particularly in Figs. 1, 2, 12, 13 and 14. A relatively fixed reproducer is shown in Figs. 1 and 2, which is mounted on the base of the machine in front of the perpendicular record, to one side of the centre on a pivoted joint, so that the stylus point will rest with yielding pressure, under the weight of the sound box, against the vertically undulating record groove. This joint allows of a back and forth movement of the sound box and stylus from and toward the face of the record, and is shown particularly in Fig. 2, the sound being carried through the hollow tubes 18 and 19, and thence through the tube 21 to the horn, or trumpet, "I." In this device, as the stylus point is not constructed to travel, or be traveled, across the face of the record tablet, means are provided for traveling the record tablet past the stylus point, which holds a relatively fixed position, as the helical groove in which the stylus point engages is rotated by the rotation given to the record tablet. These means in the construction shown in Figs. 1 and 2, comprise a horizontally disposed screw threaded rod, f, journaled on a sliding bearing, C, to which the record disc is also journaled. As the record disc, F, which is attached to the metal disc, E, is revolved through the medium of the friction wheel, "G," bearing against the rear of the metal disc, "E," carrying the wax record disc, motion is imparted to this screw-threaded shaft, 5, through the medium of beveled gears, 1 and 4. The screw-threaded shaft, 5,

intermediate in its length, passes through a fixed nut or screw-threaded bearing, 6. Consequently, as the record tablet is revolved and the screw-threaded shaft is turned, the sliding bearing in which the record is journaled is gradually traveled outward, or inward, as the case might be, thus creating a positive feed for keeping the stylus point of the reproducer in constant rubbing contact with the vertical record in the groove, as the helical groove revolves, presenting a new portion of the record groove to the stylus point constantly. In the construction shown in Figs. 12 and 13 the reproducing stylus holds a relatively fixed position, laterally considered, as in the other construction, and the revolving record tablet is traveled past the stylus point in substantially the same manner as shown in Figs. 1 and 2, though the gearing construction is of a different mcehanical mechanism, the details of which it is unnecessary to consider. It will be borne in mind that the reproducing stylus point must be in constant rubbing contact with the vertical undulations, or hills and valleys, of the record groove at all times in the construction illustrated, and that if the reproducing stylus point were absolutely rigid, without any provision to allow it to slightly yield to the right, or to the left, as the tablet was revolved, any slight irregularity in the pitch of the helix of the record groove, or in the pitch of the screw, f, of the positive feeding mechanism, for traveling the record grooves past the reproducing point, would cause the rubbing point to jump out of the record groove, or to skip over to the adjacent record groove, and perhaps to tear or mutilate the record. In a cut record groove of the vertically undulating type, such as shown in this Bell & Tainter Patent, with sloping side walls, it is essential that the stylus point must always be in intimate rubbing contact with the record in the base of the groove, and in adjusting the point to the vertical *record* in

the groove for the purpose of reproducing, if the stylus point should not strike immediately upon the centre of the *record* in the groove, which is of microscopic character, or if it should lodge upon the ridge, or field, between two grooves, it would remain on the field between the two grooves, and would not find its way to the bottom of the groove, if no provision was made to allow the stylus point to slightly yield. Nor would it slide down the sloping side walls of the record groove to the *record* proper in the base of the groove, if the stylus point was mounted perfectly rigidly. The wax-like character of the record also required that a slightly yielding adjustment should be present. Therefore, provision must be made to allow the point to follow the record proper to the base of the groove.

To provide for these difficulties, which must arise in a machine of this construction, where the record is *positively propelled by an auxiliary screw* past a relatively fixed stylus point, or *vice versa,* Bell & Tainter interposed a short section of rubber tube, 32 (shown in Fig. 8, of sheet 1), which is here reproduced. This short section of rubber tubing, 32, joined

Fig. 8.

the neck, 31, of the sound box proper to the metal tubing, 33, below it, and allowed of a slight yielding movement to the stylus point to the right, or to the left, to overcome the difficulties above noted, so that when the

stylus was placed into position in a record groove at the beginning of the record, for reproducing purposes, no great degree of care was required in doing it, and if it should happen to strike on the point between the two grooves, the stylus point would yield to the right, or to the left, slightly, as the tablet commenced to rotate, and would slide down the sloping walls to the base of the groove, or, as the patent expresses it, "*follow the record*" to the base of the groove. Or, if in operation any slight irregularity should occur in the helical form of the record groove, or any deviation exist relatively between the pitch of the helical groove and the pitch of the positive feeding screw which propelled the record, the rubber tube, 32, would slightly yield, and allow the stylus point to accommodate itself to that slight deviation, without becoming displaced from the record groove, or from defacing the record in the wax-like material, of which it was composed. This provision for a slight universal movement of this character was quite necessary to the successful operation of this machine.

The specification describing the rubber tube connection states (R. p. 394, lines 58, etc.):

> "The reproducer K when so placed is mounted upon a hollow standard composed of the tubes or tubing 31, 32, 33, and 19, and in consequence of the flexibility of the rubber tube 32 it is free to follow the record. No special care is necessary to insure its adjustment, for if the reproducer K is allowed to rest against the record with the style upon the engraved line, the style will of itself gravitate to the bottom of the groove.
>
> "There exists always a liability to disrangement in some part of the machine either in the recorder or the support therefor or the recording-tablet or its support, or if there be no disarrangement it will be difficult to insure that the reproducing-style should touch the record precisely at the proper point if the reproducer be held rigidly. Difficulties on these accounts are

> avoided by the loose or flexible mounting of the reproducer, the style automatically adjusting itself to the proper place on the record. It will be seen that the reproducer is mounted on a universal joint so that it can move in any direction. The movement parallel with the face of the tablet would, however, by itself allow the style to follow and adjust itself to the record to a useful extent."

That this required lateral movement of the stylus point to accommodate itself to these purposes was of a minute character, as far as any lateral movement was concerned, is evidenced by the fact that the specification describes another construction of reproducer which would allow of this slight lateral movement (R. p. 394, lines 117 to 123), where it refers to the construction illustrated in Fig. 10, sheet 1. It states:

> "The reproducer K' (shown in Figs. 9 and 10) has the style 26 attached to the outer of two light plates, 36 and 37, which are attached to a diaphragm, 38, of thin sheet rubber clamped at the edges between the ring 39 and the border of the back plate, 40. The tube 31 is fastened in the back plate."

We have here described a construction of rubber diaphragm which would allow the reproducing stylus, 26, to slightly yield to the right or to the left, to accommodate itself to the slight irregularities, such as referred to, and in this sense to "follow the record," or to allow it to slide down the sloping walls of the groove to the base of the groove.

It is clear from the construction illustrated in the drawings referred to, and in the description of the specification, that when the specification used the language in the portions quoted, "free to follow the record," and the words, "allow the style to follow and adjust itself to the record to a useful extent," it meant just what it says, that is, to provide against the liability to disarrangement in some parts of the machine, and further, that it could adjust itself to the *record*

proper when placed against the record tablet for reproducing purposes and find its way to the base of the nearest groove, without the exercise of special care; in other words, that the stylus point would always be in true rubbing contact with the *record,* that is, with the face of the vertically undulating portions of the groove which is the *record* proper, and which is designated in the specification as the *record,* as distinguished from the *tablet* itself upon which the record is engraved. The *record* proper is described and referred to in the specification, as the vertically undulating portions of the groove, and which contains a *record* of the sound vibrations. The *tablet* upon which the record is engraved, is referred to as the *tablet,* or the *engraved tablet.* Therefore, when the specification distinctly states that through the medium of the rubber tube section 32, the reproducer stylus is "free to follow the *record,*" or to "allow the style to follow and adjust itself to the *record* to a useful extent," it refers to the construction shown in the drawings, which has provision only to allow the stylus point to yield slightly to the right, or to the left, to keep it in rubbing contact with the *record* in the groove, and thus to follow the record, even though certain irregularities, or slight disarrangement in the parts might occur, as the helical record groove is being revolved with the disc tablet and as the record tablet is being simultaneously positively propelled laterally past the relatively fixed stylus point.

This understanding of the construction illustrated and described in the Bell & Tainter Patent is also further confirmed by the language of claims nineteen to twenty-three inclusive, which are referred to by Mr. Cameron, defendant's expert, in the Graphophone Case (a copy of the transcript of which case is submitted), in his contention that this Bell & Tainter Patent anticipates claims five and thirty-five of the Berliner Patent in suit.

The Little Joint 32 is Only Applicable to Machines which have an Auxiliary Feed Screw, where a Slight Variance May Occur Between the Pitch of the Feed Screw and the Pitch of the Record Groove.

It is understood that as this little attachment, or auxiliary rubber neck joint, 32, *located between the reproducer head and the free end of the carrying arm,* 19, can only be useful, and only have a function to perform, in a class of machines such as the graphophone, or phonograph, where the reproducer, or recorder, must have an auxiliary feed screw, or other mechanism, as a means for positively traveling the record past the reproducer, or *vice versa;* that, therefore, this auxiliary joint, or device, is *only applicable to this particular character of machine where a feed screw, or similar mechanism, must be employed for this purpose, and wherein a slight variance between the pitch of the record groove and the pitch of the feed screw might cause a perfectly rigid reproducer point to de-track, and become displaced from the grooves, especially where a groove of such extremely shallow depth and practical absence of side walls, such as complainants' groove, is used.*

The Small Auxiliary Joint 32 Could Have No Useful Purpose or Function, to Perform in Complainants' Machine.

It is equally clear, we submit, that such an intervening *auxiliary universal joint* between the reproducer head and the free end of the carrying arm, *could have no useful purpose to serve, and no function to perform, in a machine of complainants' construction, where the gramophone record groove becomes at once the feed spiral and the vibrating medium for reproducing the sound, combined in one and the same groove.*

In other words, where the feed spiral is separate

and distinct from the record groove, it may be useful to interpose between the end of the carrier arm and the reproducing head a universal joint, such as 32 of the patent, or to have a diaphragm sufficiently flexible to allow the stylus to yield laterally, especially where defendant's records are used, so that any difference between the pitch of the record groove and the pitch of the feed screw, or any slight irregularity in the record groove may be compensated for. *But where, as in complainants' machine, the propelling spiral and the record groove are combined in one and are one and the same thing, there can be no such difference between the pitch of the two, and no such irregularity or "drunkenness" of record can possibly exist.*

Material Difference in the Action of the Stylus of the Berliner and the Bell & Tainter Machines.

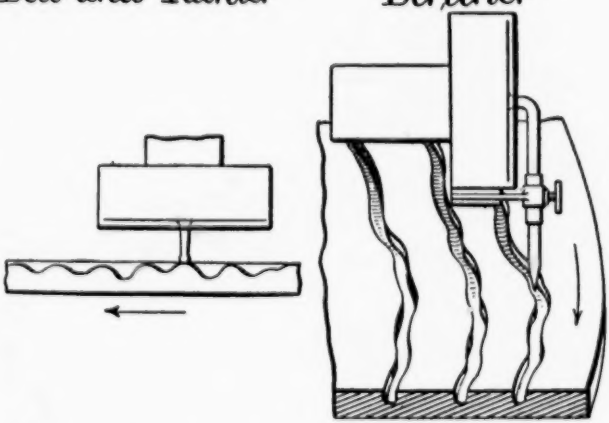
It will be borne in mind that in this Bell & Tainter construction of engraved *vertically* undulating record formed of microscopic hills and valleys, the stylus point is vibrated in the direction of its length, or up and down, as it were, and must be *held in constant rubbing contact* with the surface of the hills and valleys by the weight of the sound box, as illustrated in Figs. 1 and 2, of the Bell & Tainter Patent, No. 341,241 (Record, p. 387), or, for instance, as in the construction illustrated in the Tainter Patent, No. 341,288, particularly in Fig. 4. (See Record, p. 402.)

On the other hand, in the Berliner *laterally undulating record of even depth,* having the sound waves recorded in opposite sides of the side walls of the groove, the stylus point is vibrated laterally, instead of in the direction of its length, by the sound undulations in the side walls of the groove, operating as a *double cam,* which gives it a positive back and forth motion. This is illustrated in the following sketch, in which Fig. 1 represents the Bell & Tainter construc-

tion and operation of stylus, and Fig. 2 represents the Berliner construction and operation of stylus. The Bell & Tainter *vertically* undulating record operates as a *single cam* which forces the stylus upward, as an elevation occurs in the record groove, in its travels past the stylus point, and relies for the downward, or return motion, either upon the weight of the sound box, and the springlike tendency of the diaphragm to return to its normal position. Or, should the sound box be fixed, as illustrated in the construction shown in Figs. 18 and 19, of the Bell & Tainter Patent (Record, p. 390), it relies solely upon the spring of the diaphragm, and its tendency to return to normal. The Bell & Tainter stylus in connection with the diaphragm of the sound box, operates like a piston of a vertical engine, or like an up and down plunger. The Berliner stylus operates sidewise like a suspended tuning fork.

Fig. 1.
Bell and Tainter

Fig. 2.
Berliner



Diagrammatic views illustrating difference in the action of the stylus in the Bell and Tainter and Berliner machines.

In the Bell & Tainter construction, as well as in the Edison, the weight of the sound box is carried by the *record* in the groove, as the stylus bears directly upon the vertically undulating record groove. The weight of the sound box is also upon the centre of the diaphragm where the stylus point connects with it. The diaphragm, therefore, is normally under pressure, or tension, according to the weight of the sound box.

In the Berliner construction, the stylus is fulcrumed upon the sound box casing by a spring, or bar, attached to the sound box casing, and to the stylus bar, which spring, or bar, carries the weight of the sound box. In the Berliner construction, as the *record* proper is in the side walls of the groove, and as the stylus point may rest upon the base of the groove the weight is not carried, necessarily, upon the record proper.

Nowhere in the Bell & Tainter Patent is it intimated that the invention which Mr. Berliner made in November, 1887, and which is specified in claims five and thirty-five, was in the mind of Bell & Tainter, or existed at that time. The Bell & Tainter Patent is strong evidence of complainants' contention that it was not known at that time that it was possible to successfully reproduce sound by simultaneously propelling the stylus point over the face of the record tablet through the medium of the record groove itself while the stylus point was being simultaneously vibrated by the undulations in the record groove. The Berliner laterally undulating record groove of even depth, best adapted to this purpose, had not then been invented, and was not invented until over two years after the date of the filing of this Bell & Tainter application. Bell & Tainter filed on June 27, 1885, while Berliner's invention was not until about November, 1887. Bell & Tainter certainly would not have cumbered their application and their patent with superfluous auxiliary

mechanism for propelling the record past the stylus point, or *vice versa,* had they known at the time what Mr. Berliner, by careful experiment and investigation afterward taught the public, that the stylus point of a sound reproducing machine could be propelled by the record groove at the same time that it was being pulsated phonetically, without destroying, or impairing, the true vibrations, nor had they conceived, nor disclosed an apparatus for carrying out this method. The fact that they deemed it necessary to have this additional cumbrous mechanism for reproducing sound is strong evidence against the defendant's contention. Further, had they at that time conceived it, they certainly would have disclosed it.

Mr. Cameron's Contention.

Without reviewing in detail that portion of Mr. Cameron's deposition, defendant's expert in the Graphophone Case, which contains his argument on behalf of the contention that this rubber neck, 32, in the Bell & Tainter Patent, disclosed the Berliner invention, we will merely call the Court's attention to Mr. Cameron's deposition, p. 250 to 256 of the Graphophone transcript submitted.

We submit that his arguments are unsound, and that they consist largely in an attempt to twist and contort certain language of the Bell & Tainter Patent to mean something which the specification and the drawings clearly show it does not mean, such as the words, "Free to follow the record," the words, "universal joint," and the words "allow the style to follow and adjust itself to the record to a useful extent." What these words mean has been hereinbefore considered, and a careful examination of the specification in connection with the drawings of the patent will show that they cannot be given the interpretation which Mr.

Cameron claims for them, and that the construction illustrated and described in the Bell & Tainter Patent is radically different from the method, and apparatus, subsequently invented by Mr. Berliner, and which invention to-day had largely superseded the old form of Bell & Tainter machines and records.

Re Claims 19 to 23 of Bell & Tainter Patent.

Mr. Cameron also attempts to show that claims nineteen to twenty-three, of the Bell & Tainter Patent, called for constructions similar to the Berliner invention, but as hereinbefore pointed out, a careful reading will show that the language of these claims, which was carefully selected, referred only to the slight lateral movement of the stylus point to allow it to adjust itself to the *record* proper, which word is advisedly used in all the claims as contradistinguished from the record *tablet*.

Claim nineteen refers to the style itself, which is free to move laterally, and thereby adjust itself automatically to the sound *record*, which could be answered by the construction shown in Fig. 10, in which the style is mounted upon a rubber diaphragm, which would allow it to yield laterally sufficiently for the purpose of adjusting itself automatically to the record in the groove. The rubber neck construction would also allow of this.

Claim twenty would more properly refer to the rubber neck construction shown in Fig. 8, where the rubber neck mounting of the reproducer would allow the style a slight lateral movement to adjust itself on the *record* proper.

This is true also of claim twenty-one, as the rubber neck construction shown in Fig. 8 is also referred to as "a universal joint."

Claim twenty-two would also refer to the rubber

neck shown in Fig. 8, so that the rubbing style would be loosely mounted, and free to move laterally to adjust itself to the *groove*.

Claim twenty-three would also refer to the rubber neck construction shown in Fig. 8, which would allow the style of the reproducer, rubbing over the sound *record*, having sloping walls, to adjust itself to the base of the record groove by sliding down the *sloping side walls*.

Mr. Cameron realized that this lateral movement provided for in the Bell & Tainter Patent is of a most limited character, but his argument is, that if the reference shows the *slightest lateral movement* it meets the invention of claims five and thirty-five, disregarding the broad and widely different principles of operation and construction set forth in the two patents. Mr. Cameron says (p. 255 of the Graphophone transcript):

"However, this difference in the extent of lateral movement across the face of the record is not material. If the stylus of the Bell & Tainter Patent travel across the face of the record TO THE EXTENT OF BUT A SINGLE SPIRAL it is apparent that it would be 'free to be vibrated and to be propelled' by the record groove, since the spiral form of the groove constitutes it one that at every instant of the operation is not only vibrating the stylus but moving it to the extent of the pitch of the spiral across the face of the tablet."

We think that this statement explains the position of Mr. Cameron, and of the defendant, in which they *ignore the widely different principles of operation*, and of construction, of the two inventions, and are *simply playing with terms and with words*.

Bell & Tainter's invention was for a particular class of machine, and particular character of a vertically undulating record.

Re **American Graphophone Company** *v.* **Leeds.**

Mr. Cameron has referred in his deposition (Graphophone Transcript, pp. 261 to 263), to a decision of Judge Shipman in 87 Fed. Rep., 873, in the case of the American Graphophone Company *v.* Leeds. He states that in this case the defendant's machine was constructed in accordance with the Amet Patent, No. 562,694, of June 23, 1896 (Graphophone Transcript, p. 411). This Amet machine was constructed to reproduce sound from cylindrical wax-like records, having vertically undulating grooves of *uneven* depth, through the medium of a glass arm, or tube, pivoted at its inner end upon a crude frame, or standard, and having at its outer end a small glass nib turned down, which operated as a stylus point, rubbing over the vertical undulations in the record groove of the wax-like cylinder as it rotated on a mandrel,—the glass nib being held in contact with the record groove by a spiral spring. It had no diaphragm, or sound box, and was essentially a toy machine. Mr. Cameron says that this construction, operating as thus defined, was held in the Leeds case, by Judge Shipman, to infringe claims 19, 20, 21, 22 and 23 of the Bell & Tainter Patent, No. 341,214.

The attention of the Court is particularly called to this decision, where it will be seen that Judge Shipman in a portion of his decision, which Mr. Cameron does not quote, holds that the invention of these claims of the Bell & Tainter Patent was a dual invention. He states:

> "The material of the record and the reproducer are each necessary parts of the invention. Either part without the other would be ineffectual, but in combination both tend to make an operative and successful instrument."

Judge Shipman says that one of the essential features of this invention was the *vertically undulat-*

ing record cut or engraved in wax or wax-like material. He said, "It was found necessary that the material should be cut, or engraved, at the point of the blade, and that it should be capable of being readily removed in chips or shavings,"—and then refers to the operation in which the reproducing stylus "followed all the elevations and depressions in the groove." He further states:

> "This peculiarity of the dual invention of the material for an engraved record and the reproducer, and the fact that the latter was brought into being to make the former of practical value, is of much importance in the proper construction of the quoted claims of the patent if it should be held that the producer alone, though novel, is not patentable."

He states further:

> "The two improvements of importance with respect to claims 19 and 24, inclusive, are the new material for a sound record upon walls were engraved by a cutting style; and the reproducer which rested upon these grooves by gravity, and moving along them, 'imparted to a second diaphragm the vibrations incident to the elevations and depressions of the bottoms of the groove.'"

It is thus clear that in the Leeds case referred to (87 Fed. Rep., 873), a large portion of the decision is devoted to a consideration of a vertically undulating cut, or engraved, groove in wax, or wax-like material, which was adopted and used by the defendant on the Amet machine referred to.

In the case of the American Graphophone Company *v.* The National Gramophone Company, 92 Fed. Rep., 365, where it was sought to enjoin by preliminary injunction the Berliner machines, on the basis of the Leeds case, for infringement of claims 19, 20 and

21, Judge Shipman, who had decided the Leeds case, sitting in the Circuit Court of Appeals, for the Second Circuit, reversing a decision by Judge Lacombe, said:

> "The adjudication in the Leeds case was not an adequate basis for an order for an injunction *pendente lite* against the Berliner device, for it relates to the infringement of claim twenty-one by the use of the dual improvements of Bell & Tainter, and was not intended to go further and decide the status of a device which did not contain a tablet of their new material for a sound record. The order of the Circuit Court is reversed with costs."

Claim twenty-one, referred to by Judge Shipman, reads as follows:

> "21. The reproducer mounted on a universal joint and held against the record by yielding pressure, substantially as described."

It is fair to assume that as Judge Shipman held that this Berliner machine did not infringe this claim, under the construction given to it by the Court, that the converse is true that the Bell & Tainter construction, which is specified in claim twenty-one, did not anticipate the Berliner machine.

Conclusion re Bell & Tainter.

The attention of the Court in this connection, regarding the alleged anticipation by the Bell & Tainter Patent, is called to the deposition of Mr. Hunter, complainants' expert, given in rebuttal (Graphophone Transcript, pp. 83 to 99). In considering Mr. Cameron's deposition, Mr. Hunter states (p. 83):

> "After carefully examining Mr. Cameron's testimony, I am forced to the conclusion that his statements regarding this Bell & Tainter Patent, are misleading, and preclude a fair comparison of the Bell & Tainter Patent, and the claims in suit

> of the complainants' patent, if consideration were left to the language employed by Mr. Cameron. * * * In my opinion, therefore, he has given to the words quoted different meanings from those intended by the patent, and consequently, the basis of his opinion is unsound, as I shall endeavor to show."

The language of the Bell & Tainter Patent referred to by Mr. Hunter, which Mr. Cameron, as we contend, has misconstrued and misread, is that which has heretofore been referred to, and considered in this brief in reviewing the Bell & Tainter specification.

Mr. Hunter further states, after reviewing the points made by Mr. Cameron, in connection with the Bell & Tainter Patent (Graphophone Transcript, p. 96):

> "I do not agree with this statement (Mr. Cameron's statement quoted by Mr. Hunter), because the Bell & Tainter structure does not embody 'all of the functions and capability of action' of the machine of the complainants' patent. Furthermore, it does not have means 'whereby the reproducer style may move laterally over the face of the record,' unless such lateral motion be limited to the extent of one groove for adjustment solely to that groove, in which case that adjustment is not feeding or propelling, as called for by claims five and thirty-five of complainants' patent in suit. Furthermore, such a feeding or propelling action necessary to complainants' structure, would be inconsistent with the employment of 'means whereby the record tablet itself may travel past the reproducer stylus,' mentioned by Mr. Cameron in connection with the Bell & Tainter apparatus."

Mr. Hunter further states (Graphophone Transcript, p. 97):

> "The invention of claims five and thirty-five requires that the feeding or *propelling action shall*

take place over the entire length of the record groove of the tablet, and shall begin with the beginning of the groove and end only with the ending of the groove, and that it was not limited to any total length of groove. It must, however, be for the total length, whatever that length may be on any one tablet. With this understanding, *it is quite evident that the minute lateral capacity for adjustment of the stylus in the Bell and Tainter device, which is only intended to have a capacity of about* 1-100 *part of an inch, so as to centralize the stylus in the groove, would not enable that stylus to be fed or propelled throughout the length of the record groove, which is formed as a spiral in the record tablet,* and because of its incapacity for feeding or propelling of the stylus the additional mechanical feeding mechanism for moving the record tablet bodily across the relatively stationary reproducer are required. The Bell & Tainter Patent does not, in my opinion, disclose the invention either as to method or apparatus, called for by claims five and thirty-five of the complainants' patent in suit, nor does it disclose the method of operation or the means embodied in the propelled stylus across the record tablet, whereby it is propelled throughout the entire length of the record groove, as well as being vibrated by the groove, which is embodied in the machines of the complainants and defendant, entered as exhibits in this case."

BERLINER'S RADICAL DEPARTURE.

The positive incapacity of the sound reproducing apparatus, illustrated and described in the Bell & Tainter patent, to feed the stylus point across the entire area of the record grooves, contained on the face of the record tablet, from the start to the finish without the aid of the positive auxiliary feeding mechanism, is conclusive, we submit that the Bell & Tainter patent cannot anticipate the claims in this suit.

The conditions present in the Bell & Tainter Patent, and which had to be dealt with from the light of the talking machine art as developed at that day, are radically different from the conditions present, and shown to exist in the invention in suit of Mr. Berliner over a year and a half later. His invention created a radical departure from the methods and apparatus previously known, and adopted, in the talking machine art.

Bell & Tainter improved upon Edison, but Berliner departed from both their methods and apparatus, and struck out on radically different lines.

Bell & Tainter and Edison, from the conditions present at the date of their respective inventions (at which time they had to deal with not only the records of the vertically undulating type, but also formed in wax-like material), had quite a different proposition from that which Berliner had to deal with in November, 1887, when he developed his new method, and consequently his apparatus was constructed on radically different lines. That this is true is clearly evidenced by the Bell & Tainter Patent, and by the Edison Patents in evidence. In the Edison British Patent, No. 1644, of 1878 (Record, p. 472), the form of Edison reproducing machine shown on sheet 1 of this British Patent (p. 484 of Record), shows that he regarded the positive propelling auxiliary screw provided on the centre of the revolving disc holder, as absolutely essential, which it undoubtedly was, either in that form, or in the modified forms of positively propelling mechanism, shown in the other figures of this sheet. This was one of Edison's tin foil machines, in which the record was of the most delicately formed character, and would not allow of any other pressure of the record surface upon the stylus point than that necessary to phonetically vibrate it; otherwise, the stylus point would "iron out" the indented record formed on the

tin foil surface, or on the wax-like surface, should it be used in lieu of tin foil.

Edison, and Bell & Tainter, were clearly operating on similar lines. Bell & Tainter's radical departure from the Edison invention was essentially in *cutting,* or *engraving,* the vertically undulating lines, representing the sound record in the base of the record groove, by a gouging action in the wax-like material, which *removed the material in the form of a shaving* and left a smooth, clean-cut vertically undulating record, as contradistinguished from the Edison *indented* record, which was, more or less, indefinite, and indistinct, and over which the stylus point would frequently ride, without truly reproducing the sound recorded thereon. This was the main distinction between Bell & Tainter and Edison, and it was the main thing which made the Bell & Tainter Graphophone more successful. This, however, did not require any marked difference in the construction of the reproducing apparatus between Bell & Tainter and Edison, save only that Bell & Tainter, as hereinbefore pointed out, found that it was an advantage to so mount the stylus point that it would be susceptible of a slight lateral movement, practically within the purview of the groove, to allow it to yield, to a minimum extent, to the right, or to the left, to properly track, but Bell & Tainter's vertically undulating engraved groove in wax-like material still required, as in Edison's previous machines, positive auxiliary feeding mechanism for traveling the record tablet past the relatively fixed stylus point, or for traveling the stylus point over the entire area of the grooved surface on the wax tablet, or cylinder.

On the other hand, however, Berliner, who, as the testimony shows, had been a careful student of the talking machine art from the time of Edison's first machine, dispensed entirely with the vertically undulating grooves, either indented or cut, and dispensed

with a record formed in wax-like material, and invented the laterally undulating record of even depth in hard resisting material, which should vibrate the stylus point phonetically, back and forth, positively, by a double cam motion, as distinguished from the up and down single cam motion of Edison and Bell & Tainter, which double cam motion, as experience proves, yielded vastly superior results, and naturally.

Mr. Berliner made his laterally undulating records in *hard, indestructible material,* as distinguished from the wax-like records of Edison and of Bell & Tainter, and Berliner's assignees and licensees, these complainants and their predecessors in business, *were the first to place upon the market commercial records formed in hard, indestructible material,* which to-day are clearly vastly superior. *Up to the date of Mr. Berliner's invention, in suit, and until they were placed upon the market by his assignees and licensees, no hard, indestructible record had ever been upon the market.*

It is, therefore, evident that, from the conditions existing at the time of the Edison and Bell & Tainter inventions, they each found it necessary from the character of the record, and the material of which they were formed, to provide a construction wherein the only pressure brought to bear by the stylus point upon the record, or the record upon the stylus point, would be that which was necessary to properly acoustically vibrate the stylus point by means of the record in the groove. To travel the grooved area of the record tablet from start to finish past the relatively fixed stylus point, it was essential, in both the Edison and the Bell & Tainter devices, to provide positive auxiliary feeding means, the mechanical adjustment of which should be such that the stylus point would always be maintained centrally in rubbing contact upon the record in the groove, as the helical groove on the disc tablet, or

the spiral groove on the cylinder, rotated. To accomplish this required a very nice adjustment.

All this Mr. Berliner dispensed with by reason of the new conditions which he created, after his years of careful study of the subject, and from what he had learned in his long telephone experience. He found that the finest adjustment, to the greatest degree of nicety, was to be obtained in his method, whereby the stylus point could be traveled through the medium of the record groove itself across the face of the record, while it was simultaneously being phonetically vibrated by the undulations in the record groove, which, of course, maintained the stylus point in a positive vibrating contact with the record formed in the groove, *throughout the whole length of the spiral*, without any chance of deviation. This invention, while simple, as regarded in the light of the present day, was one of the greatest advances in the talking machine art. Mr. Berliner also found that by his method and apparatus, used in carrying it out, the pressure of the record on the stylus point for propelling purposes, in no way interfered with, or impaired, the acoustic vibrations imparted to the stylus point by the record in the groove, but that on the contrary by his new method and apparatus, materially superior results in the reproduction were achieved.

So vastly superior was the Berliner method, and apparatus, of the patent in suit, that to-day the Berliner talking machine and record of hard, indestructible material, have largely superseded the Bell & Tainter, and the Edison type of machine, and record, and are sold in all parts of the civilized world, and may be heard in the "islands of the sea." Most of these have been manufactured by the complainant, the Victor Talking Machine Company, but many of them by the defendant, in infringement of the complainants' patent in suit.

RE POINT NINE.

This point made by defendant is numbered Point Nine in its Petition, and is relative to the contention that claims five and thirty-five of the patent in suit are not valid as being claims for the function of a machine.

While this question was not argued by the defendant in the Court of Appeals, doubtless for the reason that it had been previously fully argued and decided in the American Graphophone case, the defendant had assigned it as an error in assignments 30 and 31. The defendant, however, has admitted that any of the questions decided in the American Graphophone suit were not argued in the Circuit Court or Circuit Court of Appeals. He states, on page 39 of his petition for *certiorari*, in referring to the prior decision in the American Graphophone case:

> "Under familiar practice, defendant, the petitioner above named, was not free to argue again, either in the Circuit Court or in the Circuit Court of Appeals, any of the grave and important questions of law decided in the prior suit."

The questions raised under Point Nine, as well as numerous other points in Defendant's Petition and present brief, were fully argued and decided in the American Graphophone case, and *as defendant's counsel admits they were not argued in the Circuit Court or Circuit Court of Appeals*, in these present cases, it is submitted that under the well settled decisions of this Court, *such questions as were not argued* before the Court of Appeals *should not be considered here* in the Supreme Court of the United States on appeal.

As intimated by defendant's counsel, Judge Wallace, in his dissenting opinion in the appeal on the Contempt Proceedings (Contempt Record p. 94) did in that case intimate that he thought that claim five might be considered as covering merely the function of a machine, and that it was doubtful whether it was not void

on its face; Judge Wallace, however, in that opinion, further stated that it must be assumed to be valid, saying, referring to claim five:

> "But assuming it to be valid, as must be done for present purposes,—"

Later on, he states:

> "This clearly appears by the opinion in the suit in which the validity of the patent was established. Victor Talking Machine Co. *v.* American Graphophone Co. (140 F. R. 860)."

It will be noted that Judge Wallace, on behalf of the United States Circuit Court of Appeals, in affirming the decision of the Circuit Court in this present suit, and in the suit against the Talk-O-Phone Company (a copy of which is printed on pages 41 to 46 of Defendant's Petition for *Certiorari*); said:

> "Mr. Pettit, we can shorten your labors in this case. The Court has examined the record and the briefs of counsel, and has reached a conclusion favorable to the appellee upon *all* questions, save, perhaps, one—."

As thereinafter appears, the one question referred to was that relative to the defense which rested upon the proposition that by the expiration of the Suess French Patent the Canadian Patent expired. Any doubt of the court regarding this proposition was, however, immediately relieved, as shown by the said printed remarks of the Court (Defendant's Petition, pp. 41-46) after further hearing.

It is clear, therefore, that the patentability of these claims five and thirty-five was fully affirmed and sustained by the Court of Appeals in the decision from which this appeal is taken.

We will, however, consider this alleged defense, that the claims are invalid as involving the mere function of a machine, considering each claim separately.

Claim Five Involves Clearly a Patentable Process.

In order to intelligibly discuss the question of patentable method we should consider in this connection, at the expense of some repetition, the method, and its merit.

Claim 5 reads as follows:

"The method of reproducing sounds from a record of the same which consists in vibrating a stylus and propelling the same along the record by and in accordance with the said record, substantially as described."

Mr. Berliner was the first to discover, after his long course of training in acoustics, in which science he was one of the best known in the land, that the stylus point of a sound reproducing machine which was being vibrated under the fine, sensitive impulses of the microscopic vibrations recorded in record groove, could, at the same time, be traveled across the face of the record tablet, as the helical groove rotated, by impinging the side wall of the record groove against the vibrating stylus point without impairing in the reproduction the sound to be reproduced through the medium of vibrations of the point. In other words, that the stylus point could be operated upon by the side wall of the record groove pressing against it, to travel the stylus point across the record tablet while it was being phonetically vibrated, without impairing the sound vibrations which were being simultaneously imparted to the stylus point through the medium of the sound record recorded in the groove.

Why it was that nobody ever had previously made this discovery, or devised a method for carrying it out, such as claimed in claim five, makes little difference. The fact remains that it never was done before, as far as the record in this case shows, nor was it ever de-

scribed before, nor were any means shown in the prior art by which it could be accomplished.

Mr. Berliner's article in the "Electrical World," of November 12th, 1887, discloses the fact, though in a modest way, that he had conceived and invented this method at that time. (See Record page 243, etc.) He states, at the bottom of page 256 of the "Electrical World" (Record, page 244):

> "There are various means for making audible and enlarging the vibrations of the reproducing stylus. A simple plan is to hold a sharply pointed bamboo stick, or even a toothpick, between the teeth, close both ears with small pieces of chamois leather or wadding, and press the point lightly into the rotating groove. Or a mounted diaphragm having connected to its centre a flat stylus similar in form to the recording one, but of shorter leverage—as shown lying on the table in the engraving (see Fig. 1 on page 357 of Record)—is so placed above the groove that the bent point of the flat spring also presses lightly into the groove. Or a large wooden resonant box is connected to the groove by a stick having an ivory or box wood point.
>
> "Another way is to mount the phonautogram on a circular, wooden, resonant box, which simply rotates without progressive motion, and to press an ivory point into the groove. In this case the hand which holds the ivory easily follows the groove, and the point is led along the volute of the record, and vibrates the sound box by undulatory shocks."

Mr. Berliner then, in this same article in the "Electrical World," refers to an apparatus to carry out the method. His deposition (Record, pages 239-242) shows that about the time of the filing of his application for U. S. Patent No. 564,586, which was November 7th, 1887, he made and operated a machine similar to that shown in Fig. 10 of said patent, No. 564,586, of which he produced a model marked "Complainants' Exhibit,

Berliner Model." The construction shown in this model, and in Fig. 10, of said patent, 564,586 comes within claim thirty-five of the patent in suit and is one of the means for carrying out the method claimed in claim five.

The attention of the Court is also called in this connection to Mr. Berliner's cross-examination in Record, pages 235-238 (the defendant also having called him as a witness). In answer to XQ. 36 (Record, page 238), Mr. Berliner, in referring to the construction shown in Fig. 10 of patent 564,586 and to the model produced by him, states:

> "The record groove, being in hard resisting material, presses against the stylus 29 which is firmly attached to the diaphragm-box 31 which again is connected to truck 55, and as the record groove is a spiral, in rotating the same the truck 55, is moved across the record disc. This is facilitated by the two wheels of the truck, which enable the latter to freely roll on the wire 56 when pressed by the record groove acting against the point of the stylus."

This, it may be stated, parenthetically, clearly carries Mr. Berliner's date of invention of claims five and thirty-five of the patent in suit, No. 534,543, back to at least November 7, 1887, the date of the filing of his application for patent No. 564,586, which did, however, not issue until July 28 1896.

It is true that while the commercial form of reproducing machine, principally adopted both by the complainants and defendant, has had the pivoted swinging arm, such as illustrated in Fig. 3 of the patent in suit, No. 534,543, the construction as made and operated by Mr. Berliner in November, 1887, illustrated in Fig. 10 of the Patent No. 564,586, is another practical form of the same apparatus. Other forms could also be suggested within the terms of claim thirty-five.

As to the question of the patentability of the method claim (as well as of claim thirty-five), the attention of the Court is directed to the deposition of complainants' expert, Mr. Joseph Lyons (Graphophone Record, pages 18 to 43), who was Mr. Berliner's patent solicitor in the prosecution of the application for the patent in suit in the Patent Office, and who is most familiar with the device, and who states, *inter alia*, page 36:

> "When the gramophone came into existence, and I may say that I was at its cradle, and helped it nursing, I learned at once that it was a groove that undulated laterally. The name 'gramophone' was selected to make the public understand that it was not a record of varying depth such as the graphophone record."

The creation of the method or process of operation was necessarily first conceived, and the particular means for carrying out this process or method was secondary, or the result of the preconceived method. It is quite possible to conceive the method of operation which has been outlined and which constitutes the method of claim five of complainants' patent in suit, without having in mind particular specific forms of apparatus for carrying out the method, and it is evident from the evidence in this case that there is more than one type of apparatus which may be employed in carrying out the method. As a general proposition, where a variety of different apparatus are each adapted to carry out the same mode or method in securing a primary result, it is proper to assume that the method is something more than the function of any one of the machines.

In chemical processes, and in nearly every department of science where a method is involved, it is almost always necessary to employ machines or apparatus of some kind to enable the process or method to be carried

into operation, and the said method or process is always carried out by the similar and proper operations of the apparatus. Invariably chemical processes are created before the particular apparatus is designed to enable them to be operated commercially, and there can be no material difference in this situation from that which exists in the matter of claim five of the complainants' patent in suit. This is borne out by the prior art in talking machines, because in every case prior to the date of the complainants' patent in suit, as far as I am aware, no one had conceived of the possibility of relying upon a properly formed record groove in its coaction with the stylus or point of the reproducer, as the sole means for transferring the reproducer and stylus across the record so that it is made to traverse the entire record groove of the tablet without introducing any external and mechanical feeding devices. In all cases either the record tablet was mechanically fed across the reproducing style, or the reproducer and its style was mechanically fed across the record tablet, so that as the tablet revolved the stylus was properly presented to the record groove to correspond to the shifting position of its operative portion.

The fact that it is impossible to disassociate from the apparatus the method in the particular apparatus of the patent in suit, is only what should result from the creation of the invention, and means for carrying it into effect. The machine was designed for that purpose, and it is proper that it should always perform it if it is to have any utility.

In all machines prior to the invention of this method and apparatus by Mr. Berliner, there was always mechanical mechanism for positively feeding the stylus over the record tablet, or for feeding the record tablet transversely across the stylus, and it is quite evident that if Mr. Berliner had not invented the meth-

od and means for securing the same results without having recourse to these mechanical feeding means which were a necessity to the machines of Edison and Bell & Tainter, forming the prior art, he would have embodied in the patent in suit mechanical feeding means for locating the stylus in a progressive manner across the revolving record tablet, just as all these prior inventors have done. Mr. Berliner, however, had conceived a method of operation which would dispense with this mechanical feeding mechanism, and invented a form of record tablet, which would enable him to put his method of operation into effect, and produce articulate sounds more satisfactorily and by simpler mechanism than had heretofore been thought possible. He, therefore, made a great advance in the invention of talking machines, and this advance had as its foundation the methods specified in the fifth claim of the complainants' patent in suit. The method specified in the fifth claim of complainants' patent in suit is a proper method claim which involved the exercise of the inventive faculties in its creation, and preceded the invention of the mechanism for carrying it into practical operation and was not the mere function of the machine.

Whether it is essential, or not, in order to determine the question of patentability of a method, that it was invented *before* the apparatus by which it may be carried out, it appears to be clear from a reading of the article in the "Electrical World," of November 12th, 1887, entitled "Berliner's Gramophone," that Mr. Berliner conceived the method of claim five *before he constructed the device for carrying it out*, one form of which is illustrated in Fig. 10 of Berliner Patent 564,586, the application for which was filed November 7th, 1887.

We, therefore, respectfully submit that when a clear understanding is had of the character of Mr. Berliner's method claimed in claim five, and of the

knowledge of acoustics which his invention required, and the problems which had to be dealt with in producing the invention, that it is clear that it does involve, without question, a patentable method, under the well settled authorities.

The fact that it had not been disclosed in the prior art, and that it subsequently in recent years has almost superseded the old style of talking machines with positive auxiliary mechanism for feeding the record tablet past the reproducer point, or *vice versa*, such as shown in the Edison prior patents, and the Bell & Tainter patent is strong corroborative evidence of the fact that *it did require invention to produce the method claimed.*

In support of this position we cite a few authorities:

Authorities re Patentability of Method.

Claim five reads as follows:—

> "5. The method of reproducing sounds from a record of the same which consists in vibrating a stylus and propelling the same along the record by and in accordance with the said record, substantially as described."

We have here the mode or method of producing something, the producing, or rather the *reproducing* of sound. This is entirely distinct from the apparatus which may be used for the purposes of carrying out this method, or mode, of reproducing sound, which apparatus may be constructed in several different ways.

The method consists in phonetically vibrating the stylus by the record undulations, and at the same time, by the same means, advancing, or propelling, the phonetically vibrating stylus across the record tablet throughout the entire length of the sound record to be reproduced.

The term "method" here is not used subjectively,

or passively, as applied to the machinery operated on, but *actively*, as a method, or mode, of producing, or rather reproducing, something, to wit, sound.

As hereinbefore pointed out, it remained for Mr. Berliner to discover, in November, 1887, that a phonetically vibrating stylus, vibrated by and in accordance with a sound record could be simultaneously advanced, or propelled, throughout the entire record, by using the side walls of a helical groove as the propelling means simultaneously with the communication of the phonetic vibrations, without destroying, or impairing, the phonetic vibrations of the stylus point, and consequently without interfering with the true reproduction of the sound recorded upon the record.

This new method was the result of this discovery.

The method, or art, of carrying out an invention, or discovery does not necessarily involve any particular means for employing, or using, that method.

Re the Telephone Cases.

Perhaps the most pertinent and applicable cases upon the subject are the Telephone cases (126 U. S., 1). Those cases, like the present case, involved the transmission of sound. The claim in controversy in that case was the fifth claim of the Bell patent, which read as follows:

> "5. The method of, and apparatus for, transmitting vocal or other sounds telegraphically, as herein described, by causing electrical undulations, similar in form to the vibrations of the air accompanying the said vocal or other sounds, substantially as set forth."

In other words, this claim was for transmitting sound telegraphically *by causing electrical undulations*, which undulations were similar in form to the vibration of the air accompanying the sound. Electrical undula-

tions were caused, or produced, by the voice, or otherwise, and transmitted telegraphically on a wire to a distance. Mr. Berliner reproduced recorded sound by causing the phonetically vibrating stylus, vibrated by the record groove, to travel through the entire length of the record groove solely by the impingement of the side walls of the record groove, without destroying, or impairing, the vibrations of the stylus representing the sound waves, and thereby securing the best results by automaticaly maintaining *the stylus point in absolutely proper co-relation with the record in the record groove, as it traveled throughout the entire length of the record groove,* or as the entire length of the record groove traveled past the stylus point.

The fact that Bell employed electricity in the Tele phone case, for causing the sound undulations, in no manner affects the applicability of the decision in that case to the facts of this case, as electricity for transmitting messages was old, the novelty consisting in Mr. Bell's method of using, or training, the electricity to his purposes.

Mr. Chief Justice Waite, in delivering the opinion in this case, commented upon the case of O'Reilly *v.* Morse, 56 U. S., 15 How., 62, said:

> "In the present case the claim is not for the use of a current of electricity in its natural state as it comes from the battery, but for putting a continuous current in a closed circuit into a certain specified condition suited to the transmission of vocal and other sounds, and using it in that condition for that purpose. We see nothing in Morse's case to defeat Bell's claim; on the contrary, it is in all respects sustained by that authority. It may be that electricity cannot be used at all for the transmission of speech except in the way Bell has discovered, and that, therefore, practically his patent gives him its exclusive use for that pur-

pose, but that does not make his claim one for the use of electricity distinct from the particular process with which it is connected in his patent."

See also American Bell Telephone Company *v.* Dolbear, 15 Fed. Rep. 448.

We do not dispute the proposition that a valid patent cannot be obtained for a process which involves nothing more than the mere operation or function of a piece of mechanism. Any number of cases can be cited by the defendant to this effect.

As said by Mr. Justice Greer, in the case of Corning *v.* Burden, 56 U. S., 15 How. 250:

"It is when the term 'process' is used to represent the means or method of producing a result that it is patentable, and it will include all methods or means which are not affected by mechanism or mechanical combinations. But the term 'process' is often used in a more vague sense, in which it cannot be the subject of a patent. Thus we say that a board is undergoing the process of being planed, grain of being ground, iron of being hammered or rolled. Here the term is used subjectively or passively as applied to the machinery operated on, and not the method or mode of producing that operation, which is by mechanical means, and the use of a machine ,as distinguished from a process. In this use of the term it represents the function of a machine, or the effect produced by it on the materials subjected to the action of the machine. But it is well settled that a man cannot have a patent for the function or abstract effect of a machine, but only for the machine which produces it."

This, we think, clearly distinguishes the difference between a patentable method, which actively produces something, and the mere function of a machine, as such.

This present question in this case involves, not so much the citation of authorities as to what is a patentable process as it does the application of the well-de-

fined decisions of the Supreme Court of the United States, and of the United States Circuit Court of Appeals for the different Circuits, to the method before us.

It is, of course, not essential to the patentability of a process that the process should effect a *chemical* change in substances operated upon.

Melvin *v.* Potter, 91 Fed. Rep., 151.

No test which can be definitely applied to all cases to determine whether or not a process of manufacture is patentable, as such has been authoritatively established.

Melvin *v.* Potter, *supra.*

In all cases where a Supreme Court of the United States, and the United States Circuit Court of Appeals, have denied the patentability of a process, as such, the invention claimed was, when analyzed, seen to be something which is subjectively, or passively, operated upon by the function of a machine, or by manual manipulation. Such a case is the celebrated case of Corning *v.* Burden, 56 U. S., 15 How., 252; also the effort to claim a principle is not patentable such as the principle and use of an element for a particular purpose, such as Morse's claim for the electric telegraph in O'Reilly *v.* Morse, 56 U. S., 15 How., 62.

In an improvement in a sewing machine by which the soles and uppers of boots and shoes could be sewed together by a particular kind of stitches, without any welt, the method was held not to be patentable.

McKay *v.* Jackson, 12 Fed. Rep., 615.

Again, a process for stiffening the heels of boots and shoes was not patentable.

Hatch *v.* Moffit, 15 Fed. Rep., 253.

So, also, the process of centering a pulley and

grinding the ends of the arms, concentrically with the axis, and boring the center, and securing the rim to the spider, and grinding the face of the rim concentric with the axis of the pulley, and then grinding, or centering the edges of the rim, was held not to be a patentable process, in an exhaustive opinion by Mr. Justice Brown, Risdon Iron & Locomotive Works *v.* Medart, 158 U. S., 65.

The attention of the Court is called to this last mentioned case, in which the authorities are reviewed. The process in Locomotive Works *v.* Medart was unquestionably, under the authorities, not a patentable process and is clearly differentiated from the method of claim five, of the patent in suit.

We would call the attention of the Court to a number of the leading authorities, where the processes claimed were held to be patentable.

In the case of Tilghman *v.* Proctor, 102 U. S., 708, the claim was for the manufacturing of fat acids, and glycerine, from fatty bodies, by the action of water at a high temperature and pressure.

In Mowry *v.* Whitney, 81 U. S., 14 Wall. 620, the patent was sustained for an improved process for manufacturing cast iron railway wheels, by retarding their cooling by a second application of heat, until all the parts of the wheel were raised to the same temperature, and permitting a gradual cooling.

In Cochran *v.* Deener, 94 U. S., 780, the process consisted in manufacturing flour by passing the ground meal through a series of bolting reels clothed with cloth of progressively finer meshes, and, at the same time, subjecting the meal to blasts, or currents, of air. This separated the finer flour from the impurities, so that the finer flour could be reground and rebolted.

In this latter case Mr. Justice Bradley defined the process as:

"A process is a mode of treatment of certain materials to produce a given result. It is an act, or series of acts, performed upon the subject matter to be transformed and reduced to a different state or thing. * * * The machinery pointed out as suitable to perform the process may or may not be new or patentable; whilst the process itself may be altogether new, and produce an entirely new result. The process requires that certain things should be done with certain substances, and in a certain order; but the tools to be used in doing this may be of secondary consequence."

In the case of Melvin *v.* Potter, 91 Fed. Rep., 151, the process claimed was that of manufacturing linoleum floor cloth, which consists in forming a granulated linoleum composition into sheets of spongy texture, then cutting the sheets into shapes, arranging the shapes on a flexible back, and pressing them into the foundation.

Judge Dallas in deciding this case said, *inter alia:*

"The question is not whether the mode of operation described and claimed by Melvin is chemical or is mechanical, but whether it is in fact a process, or is merely an aggregation of mechanical functions. I find no warrant in the authorities for the assumption that, unless a chemical change be effected by a process, no patentable invention or discovery can be involved in it. It is true that in both Corning *v.* Burden and Locomotive Works *v.* Medart processes involving chemical reaction were contrasted with methods which comprise nothing but successive mechanical steps to produce a merely mechanical change in the substances operated upon. In doing this, however, the Courts were illustrating, not defining, the difference between a patentable and a unpatentable process."

In the case of American Fibre Chamois Co. *v.* Buckskin Fibre Co., 72 Fed. Rep., 508, Judge Taft sustained the patentability of the process of rendering wood fibre paper soft and pliable, by moistening it with

a thin water solution of gelatine, and then crumbling and pounding it, and finally drying and smoothing it; holding that it was not a mere mechanical process, or aggregation of functions within the doctrine of Locomotive Works *v.* Medart, *supra;* or within Cochran *v.* Deener, *supra.*

In case of Hake *v.* Brown, 37 Fed. Rep., 783, the patent was sustained for the process of making beveled edge cards in an opinion by Judge Wheeler (Southern District of New York). The method consisted in ornamenting the edges by piling them obliquely, first so that the slope of the pack will correspond with the desired bevel, compressing them, to hold them in that position, beveling, ornamenting and finishing the whole pack on the sloping edge, which will bevel, ornament and finish the edge of each separate card by each operation, and of successively treating the other sides, and ends of the pack in the same manner, by which means the whole pack was treated as readily as one card.

The first claim was for this *method* of treating cards, and the second for a *card* so treated.

Judge Wheeler, in deciding the case, said, *inter alia:*

> "According to the evidence, bevel-edged cards were not new at the date of the orator's invention; neither was beveling in packs new; but arranging cards in oblique packs, and treating one side or end till all the cards were complete on that side or end, as if they were one card, and treating the other side and ends successively in the same manner, does not appear by the requisite measure of proof to have been known before. By this process the packs can be grooved or embossed and ornamented in a manner to present beveled designs upon the edges of such cards which could not be produced by treating cards separately, and the making of bevel-edged cards of any design is greatly facilitated. This method seems to be ingenious and useful. Such an

arrangement of mechanical operations, that produces a new and useful result, or an old result in an easier or better manner, is understood to be patentable. Cochrane *v.* Deener, 94 U. S., 789; Telephone cases, 126 U. S. 1, 8 Sup. Ct. Rep., 778. The first claim of the patent, therefore, appears to be good and valid for the method described.

"There is nothing new about the bevel-edged cards produced by this process, except that they are made in this way. They do not differ from those made in any other way, unless they do in design. The process does not inhere to the product, so that it differs from any like product made in any other way, as was the case with Cumming's invention of rubber plates and teeth, in Smith *v.* Vulcanite Co., 93 U. S., 486; or the driven well, in Eames *v.* Andrews, 122 U. S., 40, 7 Sup. Ct. Rep. 1073. The product itself here is old in the sense of the patent law, and there can be no patent for it, although produced in this new way. McCloskey *v.* DuBois, 8 Fed. Rep., 710, 9 Fed. Rep., 38; McCloskey *v.* Hamill, 15 Fed. Rep., 750. The second claim of this patent, therefore, appears to be invalid."

In the case of Kirchberger *v.* American Acetylene Burner Co., 124 Fed. Rep., 764 (Northern District of New York), the Court held that the Dolan process of burning acetylene gas was patentable, which consisted in surrounding a jet of gas with an envelope of air at the discharge orifice of the burner, for the purpose of preventing its combustion in immediate contact with the burner, and until it had been projected some distance therefrom, and also for a burner tip adapted to carry out such process.

The Court held, in an opinion by Judge Ray, *inter alia*, that:

"An art or operation or process is an act or series of acts performed by some physical agent upon some physical object, and producing on such object some change either of character or of condi-

261

tion. It is said to be so far abstract that it is capable of contemplation by the mind apart from any one of the specific instruments by which it is performed. It is so far concrete that it consists in the application of physical force through physical agents to physical objects, and can thus become apparent to the senses only in connection with some tangible instrument and object. I Rob. on Patents, Sec. 159."

The Court held that *the process did not consist in the operation of the machine, or of the burner, and therefore it was not the function of the burner.*

The Court further stated:

"The application of a known force to known objects in a new manner is a new art. Foote *v.* Silsby, 1 Blatchf., 445, Fed. Cas. No. 4916; Higgs *v.* Goodwin, E. B. & E., 529. An art may be either a force applied, a mode of application, or the specific treatment of a specific object, and the art must produce physical effects; but it is, of course, distinct from the instrument which it employs, but any available instrument may be employed."

In the case of Chisolm, *et al. v.* Johnson, 106 Fed. Rep., 191, the following process was held to be patentable, as such, and that it was not the mere function, or result, of a machine:

"The improvement in the art of hulling green peas, which consists in carrying the filled pods to an elevated position, and impacting the filled pods while falling, so as to sever the connections of the two half shells of the pod and [of] the peas with the pods at one operation:

"The process of gathering and hulling green peas, consisting in removing the vines from the ground with the green peas attached subjecting the vines and attached peas while green to impact, of the character described and separating the hulled green peas from the refuse."

So also Chisholm *v.* Randolph Canning Co., and Chisholm, *et al. v.* Canastota Canning Co., 135 Fed. Rep., 815-816.

In Eames *v.* Andrews, 122 U. S., 40, the Supreme Court of the United States sustained the Green driven well patent which covered a process which consisted in the driving of a tube tightly into the earth, without removing the earth upwards, to serve as a well pit, and attaching thereto a pump, thereby putting into practical use the new principle of forcing the water in the water bearing strata of the earth into a well pit, by the use of artificial power to create a vacuum.

In the case of Dayton Fan & Motor Co. *v.* Westinghouse Electric & Mfg. Co., 118 Fed. Rep., 562, it was held that a patent for a process is not invalidated by reason of the fact that such process was disclosed in the prior patent for an apparatus, where there has been no dedication of the invention to the public.

It is respectfully submitted that citation of further authorities is unnecessary, and that the method claimed in claim five, of the patent in suit, under the authorities cited, is clearly a patentable method.

Claim thirty-five clearly covers a patentable apparatus comprising mechanical elements essentially necessary to make up the complete patented mechanical combination.

It is difficult to conceive how the defendant can consistently argue that this claim is for a function of a machine; any extended argument to the contrary seems a work of supererogation.

The claim reads as follows:

> "35. In a sound reproducing apparatus consisting of a traveling tablet having a sound record formed thereon and a reproducing stylus shaped

for engagement with said record, and free to be vibrated and propelled by the same, substantially as described."

While the word "In" at the beginning of the claim might have been omitted, as the words "consisting of" are also used in lines 1 and 2; or the words "consisting of" might have been omitted, yet the claim is perfectly clear and intelligible, as hereinafter more particularly noted.

This claim, which has been so often passed upon by the Courts, and held valid, is for

"A sound reproducing apparatus."

The claim then recites the mechanical elements clearly, and concisely, going to make up and form the essential mechanical features of this reproducing apparatus, viz.:

(a) A traveling tablet having a sound record formed thereon;

(b) A reproducing stylus, which reproducing stylus is shaped for engagement with the said record.

It is also required that the construction shall be such that this said reproducing stylus shall be *so mounted* in the reproducing apparatus that it will be free to be vibrated and propelled by the record.

It is difficult to conceive how a mechanical combination comprising more than one mechanical element could be more fully, clearly, concisely and intelligibly claimed.

To say that this claim is for nothing more than the function of a machine is, it is respectfully submitted, without any foundation whatsoever, and merely introduced, as numerous other of the defences, for the purpose of discussion, without any hope or expectation of the defence being seriously considered.

RE POINT TEN.

This point made by defendant is numbered 10 in its petition, and is, in substance, that claim thirty-five is indefinite, meaningless and claiming nothing, and is void.

The substance of this point has been briefly referred to under the consideration of Point Nine. It is in substance, merely that the word "In" at the beginning of the claim thirty-five, is superfluous, and should have been left out. It is probably true that the word "In" was placed in the beginning of the claim through an oversight, in view of the fact that the claim contains also in lines 1 and 2, the words, "consisting of." If either the word "In," or the words, "consisting of," had been omitted, the claim would still mean exactly the same thing as it does as it stands, and it is respectfully submitted that there can be no substantial dispute as to what this claim covers. This is fully pointed out in the preceding page.

It is respectfully submitted that the claim as it stands is clear, concise and thoroughly intelligible, specifying particularly and minutely the elements going to make up the reproducing apparatus claimed, and it is believed that this Honorable Court will coincide with the decisions of the lower Courts heretofore given regarding this question.

POINT ELEVEN.

Defendant contends under Point Eleven in the petition for *Certiorari,* that the defendants' machines do not infringe claims five and thirty-five of the patent in suit, if they are to be construed as limited with reference to the Suess-Canadian Patent. Just what this means is rather difficult to appreciate.

There is nothing tangible shown as to how, or why, these claims should be so restricted, and no plausible foundation laid for such a construction.

This question has been heretofore fully considered.

The defendant does not deny that its machines and records are made in accordance with the construction, and method of operation, of claims five and thirty-five, as construed by the Court in the Graphophone Suit.

The affidavit of H. C. Kennedy (R., p. 54, fol. 180, etc.), shows that the defendant's machines and records are identically the same except as to some ornamentation, as complainants' commercial machines and records, and as the defendants' machines and records in the Graphophone Case.

The attention of this Honorable Court is called to the erroneous statement by defendant's counsel under Point Eleven in the petition for *certiorari*. Defendant's counsel states that Berliner asserted *under oath* in connection with the Suess Canadian Patent, that the invention of claims five and thirty-five of the patent in suit was broadly the invention of Suess. This is a glaring mis-statement, as there was no oath filed by Berliner in connection with the Canadian Patent. This Canadian Patent is printed in the record, pages 155 to 175, and nowhere does there appear an affidavit by Berliner in connection therewith and in fact, the practice of the Canadian Patent Office does not provide for such an oath to be filed by an assignee.

POINT TWELVE.

Under this point in the petition for *certiorari*, defendant's counsel relies upon the case of Harriman *v.* Northern Securities Co., 197 U. S. 284, to support his contention that this Court should consider this case on its merits, and dismiss the bill of complaint if any one or more of the defences relied upon is a valid defence. While this Court has approved of such a doctrine under certain circumstances, yet it is respectfully submitted

that it does not apply to the present case. This Court stated in Mast F. & Co. *v.* Stover Mfg. Co., 177 U. S. 495, that as to whether this doctrine applied in a case where a temporary injunction was granted *pendente lite* upon affidavits and immediately upon the filing of a bill:

> "must be determined from the circumstances of the particular case."

In this case, this Honorable Court pointed out various circumstances, among others, which might arise, which would make this doctrine inapplicable for instance, it was stated:

> "If the showing made by the plaintiff be incomplete; if the order for injunction be reversed, because the injunction was not the proper remedy, or because under the particular circumstances of a case, it should not have been granted; or if other relief be possible, notwithstanding the injunction be refused, then, clearly, the case should be remanded for a full hearing upon pleadings and proofs * * *. Ordinarily, if the case involve a question of fact, as of anticipation or infringement, we think the parties are entitled to put in their evidence in the manner prescribed by the rules of this Court for taking testimony in equity causes."

It is submitted that the circumstances of this case are such that this doctrine which defendant's counsel seeks to apply under Point Twelve in the petition for *certiorari* is not applicable.

Defendant's Proofs of Foreign Patents Incomplete.

For instance, objection has been made that the French and German patents upon which defendant relies to curtail the term of the patent in suit are not proven. This objection is stated on page 122 of this brief, and manifestly if this Court should decide that defendant's contention based upon these French and German patents should be a valid one, there would not be sufficient evidence in this case and in

this record upon which to dismiss the bill of complaint. In other words, the defendant's record does not present the whole case to this Court, for in this particular instance, as an illustration, the complainants' contention that these French and German patents are not proven, is well founded. Complainants' objection to these patents in this regard is that the foreign patent itself is not exhibited in the record. All that appears to be in the record are alleged certified copies of the specifications and drawings, and such was held in Rassau *v.* Brown, 21 Appeal Cases, District of Columbia, p. 73, not to be sufficient to put the patent in evidence, so that in this instance, among others, this case presents circumstances and facts which can only be satisfactorily decided upon full pleadings and proofs at final hearing.

Another reason why this doctrine does not seem applicable to this case is that by reason of the familiar practice in the matter of motions for preliminary injunctions in the U. S. Circuit Court for the Southern District of New York, affidavits in rebuttal by the complainants to defendant's affidavit opposing the motion for preliminary injunction were not permitted. Under this familiar practice in motions for preliminary injunction, there is no evidence in reply to the defendant's affidavits in opposition to the motion, and manifestly the complainants should be entitled to proceed with the taking of proofs in the usual way, and this case should be remanded to the lower Court for procedure in the usual manner prescribed by the rules.

POINTS THIRTEEN AND FOURTEEN.

Under Point Thirteen, defendant's counsel has inserted in the petition for the writ of *certiorari* what purports to be the oral decision of the Circuit Court of Appeals in this cause, affirming the decree of the Circuit

Court, and under Point Fourteen, states that the question of the expiration of the Berliner-Suess Canadian Patent by reason of the lapsing of the Suess French Patent is **not available in this petition** to this Honorable Court. This alleged defence is not, therefore, brought here upon the writ of *certiorari,* so that further reference thereto is unnecessary, although we submit, as in the Circuit Court of Appeals, that there is nothing in this defence, and this was pointed out conclusively under Point Nine in complainant's brief before the Circuit Court of Appeals, page 164, a copy of which accompanies the complainant's brief in opposition to the petition for the writ of *certiorari.*

The foregoing discusses all the points referred to in defendant's petition for the writ of *certiorari,* but in the courts below, the defendant put forward a large number of other reasons and contentions and argued the same at some length, and presuming, that as they were so elaborately set forth in the Court below, an attempt will be made to repeat the same in this Honorable Court, although not set out in the petition, it is deemed advisable to refer to these alleged defences, and to show wherein they are not valid.

Defendant Contends that the Patent in Suit was not Fairly in Controversy in the Graphophone Case.

The defendant's contention is that the complainants and the American Graphophone Company, by a certain contract of December 8, 1903 (R., p. 224), agreed that the American Graphophone Company should have a license under certain patents, among others the patent in suit, in the event that the suit should be decided favorably to the complainants, and that the American Graphophone Company should pay a certain royalty. The defendant contends that, there-

fore, the suit on Patent No. 534,543 was not fairly in controversy.

This question was fully argued before the Court of Appeals, and the Circuit Court, in the Graphophone Case, and definitely, and finally decided. Judge Hazel held, affirmed on Appeal by this Court, that:

"A prior agreement, by which the interested parties mutually agreed upon terms of settlement on condition that the patent in controversy is sustained by the Court, cannot, upon principle and authority, deprive a Court of its inherent power and jurisdiction," citing a number of authorities (R., p. 65, Fol. 193), viz.:

McMillin *v.* St. Louis & Miss. Valley Transp. Co., 18 Fed., 260;
Guaranty Co. *v.* Green Cove Rd. Co., 129 U. S., 137;
Doyle *v.* Continental Ins. Co., 94 U. S. 535;
Insurance Co. *v.* Morse, 20 Wall. 445.

This agreement was, therefore, fully before the Court in the Graphophone Case, and all questions regarding it. This decision is comprehensive enough to cover all questions which might arise regarding the effect of this agreement upon the relation of the parties, and no other questions relative to this subject can here arise which the decision in the Graphophone Case did not consider.

This defence was vigorously urged in the Circuit Court upon the motions for preliminary injunction herein, and was considered and decided by Judge Townsend in the opinion granting the motion for preliminary injunction in the following language (R. p. 327, Fol. 979):

> "The contention that by reason of a certain contract between the parties 'the prior suit was not * * * a suit in which the Berliner Patent in suit * * * was fairly in controversy' is not

deserving of notice. The contract and the relations of the parties were fully before the Court, and the record and briefs in said case are a sufficient answer to any such contention."

It is respectfully submitted that in this agreement of December 8, 1903 (R., p. 224), to which the attention of this Honorable Court is called, that there is absolutely nothing which could savor of collusion, or unfairness. One of the main objects of the agreement was to bring the cause to an early hearing upon its merits, and to avoid long delays so frequently occurring through the medium of technical pleadings, and other means, tending to delay a meritorious cause in coming squarely and fairly expeditiously before the courts upon its merits. (See Clause 1 of the Agreement, R., p. 225.) Each of the parties owned certain U. S. patents, and, among other things, the agreement provided that if any of the Victor Company's patents should be sustained relating to talking machine, or records, the American Graphophone Co. should pay a royalty upon a certain basis, and, on the other hand, it provided that if a certain Jones patent, owned by the American Graphophone Co., should be sustained as to records, that a certain royalty should be paid by the Victor Co., both under certain conditions. (See R., p. 226, clauses 2 and 5 of the agreement.)

It is respectfully submitted, that not only is there nothing in this agreement which savors of unfairness, or irregularity, but further that the record in the Graphophone case, a copy of which is submitted to this Court, clearly shows the full and complete defense which was urged by the defendant in that case. The records of the Court show that the case was fought with great pertinacity, and, in fact, with considerably more acrimony than in ordinary patent suits. The decisions of Judge Townsend, and of the Court of Appeals in this present suit, show that the alleged new defenses in this

case were unsubstantial and without foundation, which emphasizes the fact that defendant's counsel in the Graphophone case in failing to put in such unsubstantial and unfounded defenses, could not be charged with any *laches*, or neglect, in omitting the same, as it may have been manifest to him, as was decided by the Courts in this case, that these defenses would not constitute a substantial defense. However this may have been, the defense in the Graphophone case was full and complete, as defendant's counsel in that case believed it to be, and there was no one better skilled in the talking machine art, from the legal side of the situation, than defendant's counsel in that case.

Defendant's counsel in the suit of these complainants against Hoschke (158 F. R., 309), also urged this alleged defense, but Judge Hough, in deciding the case, entirely ignored any such contention.

We, therefore, submit that there is no force in this contention.

Defendant's Contention That the Sale of Records is not Infringement.

Defendant in the Courts below contended that sound records having lateral undulations existed before the date of the Berliner invention in suit, and were patented by Berliner in several forms in different patents, which have expired.

The defendant also contended that such records are capable of use "with machines of various constructions" and that the making and selling of such sound records cannot be an infringement of the claims of the patent in suit.

It is submitted that it is clear that the defendant, the Leeds & Catlin Company, is shown to have infringed the claims of the patent in suit by making and selling disc sound records and reproducing means, the subject-

matter of claim thirty-five, operated in accordance with claim five of the patent in suit.

The making and selling of both the records and machines by the defendant is not disputed.

There is, therefore, clear proof of infringement.

It is true that the defendant manufactures disc records having lateral undulations of even depth, in hard resisting material, adapted and designed for use solely in connection and combination with a sound reproducing machine containing the reproducing apparatus forming with the record the combination specified in claim thirty-five, to be operated in accordance with claim five.

The proof is also clear that these sound records manufactured by defendant are the same as complainants' records and the sound records in the Graphophone Case, and constructed and sold to be used with the same reproducing apparatus.

It is also clear, from the proofs, that the reproducing apparatus of the defendant in this suit, is the same in construction and operation as the complainants' and as defendant's reproducing apparatus in the Graphophone suit, and constructed and sold to be used with the same construction of records as the complainants' and as the defendant's records in the Graphophone suit. (Record, Kennedy affidavit, p. 59, etc.)

As stated by Mr. Kennedy (R. p. 61, Fol. 182):

> "This Defendant's Sound Record in the present suit is adapted, as in other devices (defendant's devices of the Graphophone suit), to be carried and rotated by the turntable, and the stylus of the sound box, engaging the spiral groove therein, causes lateral vibrations of the diaphragm, and these vibrations in the diaphragm set up the sound waves in the sound box and amplifying horn, while at the same time the sound box and stylus are automatically propelled across the surface of the record, by reason of the record groove itself, and independently of any other means of mechanism."

It is also shown by Mr. Kennedy's affidavit (R. p. 62, Fol. 185):

> "The Complainants' Exhibit, Defendant's Machine and Defendant's Sound Record are manufactured for use in connection with each other, and are so used, and in my opinion are incapable of use in any other connection in a practical manner."

It is shown by the affidavit of A. C. Middleton, Secretary of the Victor Talking Machine Company (R. p. 52):

> "Furthermore, the operation is the same and both in Complainants' and Defendant's machines and records the machine is only capable of use in connection with the record of this description, and the record is only capable of use in connection with a machine of this description——"

The defendant strenuously contends that it has what they call a "mechanical feed" machine, which does not infringe claims five and thirty-five of the patent in suit.

Re Talk-O-Phone With Alleged Mechanical Feed.

Mr. Hicks, in his affidavit (R. p. 96), refers to a Talk-O-Phone with so-called "mechanical feed," which he says was "first suggested by me."

This so-called "mechanical feed" Talk-O-Phone is not proven to have been on the market, and was also brought forward in the Contempt Proceedings, and was briefly and very properly, it is submitted, dismissed from consideration in said Contempt Proceedings by the Circuit Court of Appeals (Contempt Record, p. 92, fol. 140) with the remark that:

> "We regard the feed-device machine either as a curiosity or a pretence."

We would call attention to this so-called "mechan-

ical feed" device, of which an exhibit, marked "Exhibit A", is said to be produced, as we submit it is clear evidence of weakness on the part of the defendants.

Defendants contend that this "mechanical feed" device is not an infringement of claims five and thirty-five.

It has only been advertised since Judge Hazel's decision of the Court below in the Graphophone Case, and the application for the patent referred to in Mr. Hicks' affidavit (R. p. 96, Fol. 287), evidently has been filed since that date, as he states that the first action of the Patent Office thereon was dated March 8, 1906. He also shows that only claims 8, 9, 10 and 16 have so far been allowed.

This is manifestly the *great and most valuable patent,* which is advertised in the defendants' sensational advertisements. It is here admitted, by Mr. Hicks, that the patent has not been formally allowed, but that no objection has, as yet, been made to claims 8, 9, 10 and 16 covering the alleged "mechanical feed" device.

These claims cannot be very valuable, if Mr. Hicks' contention is true that this alleged mechanical feed device "was based essentially upon English Patent No. 1644, of 1878, to Edison, and especially on Figures 1-10 thereof and upon other earlier letters patent herewith offered in evidence showing the positive feeding mechanism for reproducing stylus or other like instrument across the face of the record. * * * "

Manifestly, this alleged "mechanical feed" device, however, is nothing but an attempt at evasion of claims five and thirty-five of complainants' patent in suit, and the mechanical feed has no useful function to perform. The device will operate better without it than with it.

The mere fact that the defendants have evidently gone to so much trouble and expense in devising the so-called "mechanical feed" machine, is strong evidence of their weakness in the defense of the machines in

the present motions. If they had substantial belief in the defences which they now present upon these motions, they would have no need of resorting to such means as devising a way out through the assistance of the so-called "mechanical feed" machine.

It is obvious that the object of the getting up of this Talk-O-Phone machine was to get away itself from the infringement of claims five and thirty-five of the patent in suit, which it manifestly believed were valid, and also to furnish an excuse to record manufacturers, such as defendant, for making disc records, so that the defendant could argue that their records were intended for use on the so-called "mechanical feed" machine, and, therefore, did not infringe the patent either by contributory infringement, or otherwise.

This plan of marketing the Talk-O-Phone machine, which has not materialized, as none of these "mechanical feed" machines have been placed upon the market, is an obvious one, and, we submit, should be signally discountenanced by this Honorable Court.

The fact is, as shown by complainants' proofs before referred to, that outside of the complainants' machine, there is no talking machine upon the market with which such records as manufactured by the Leeds & Catlin Company could be used, except the infringing machines.

Defendant's Attempt to have "Mechanical Feed" Machine Adjudicated.

This so-called "mechanical feed" machine has not been offered in this case as alleged infringing machines, and is not an issue now in these suits. It is manifest, however, that the object of the defendant in introducing these so-called "mechanical feed" machines into these cases by the affidavits and Exhibits A and B is to have the Court express some opinion as to whether or not

these so-called "mechanical feed" machines infringe claims five and thirty-five of the patent in suit.

As this involves a somewhat different discussion from that raised by the infringing machines in evidence in these cases, complainants have refrained from elaborating this argument with a full discussion of these machines with the so-called "mechanical feed," and presume that the Court does not desire, without the benefit of a full discussion, to say whether these so-called "mechanical feed" machines are, or are not, mere attempted evasions of claims five and thirty-five of the patent in suit.

It is obvious that this so-called "mechanical feed" machine is conceived for the purpose of evading the claims of the patent in suit.

The Courts below very properly refused to consider the exhibit, as it was not one of defendant's machines purchased by the complainants, or charged with infringement in this case. *As before pointed out, the said machines are not on the market.*

The obvious attempt of the defendant is to have these machines adjudicated in this case.

The Record is an Element of the Combination of Claim Thirty-five, and the Reproducing Apparatus is Another Element.

It should require no argument to convince that a patentee is entitled, under the statute, to the monopoly of manufacturing and selling the whole combination going to make up his patented device.

If the defendant's contention were true, the patentee would be only entitled to the monopoly of making and selling parts which constitute half, or a fraction, of the patented structure.

Again, which half of the patented structure would

the patentee have the monopoly on, if not upon the whole?

If a party, not the patentee, has a right, without license, to make one-half of the patented structure, which half, or portion, is he entitled to make?

If a party, not the patentee, is entitled to make one half of the patented structure, why would not some other party, not the patentee, be entitled to make the other half of the patented structure?

The contention of the defendant is practically reduced to this proposition, for if defendant's counsel's argument be good, the Leeds & Catlin Company would be entitled, without liability, to make the sound record forming one element of claim thirty-five, and another company, by the same course of reasoning, could not be precluded from making the other part, viz., the reproducing apparatus, with the stylus shaped for engagement with the record, mounted to be used in connection with the traveling tablet having a sound recording stylus shaped for engagement with the record, and free to be vibrated and propelled by it.

If the one proposition be true, the other proposition should be true, and between the two defendants the patentee would have nothing.

They could also thus use the method of claim five.

Authorities.

While it is hardly necessary to cite authorities in support of complainants' contention on this point, but a few are referred to.

Thomson-Houston Electric Co. v. Ohio Brass Co., 80 Fed. Rep. 712.

This was a decision of the Circuit Court of Appeals of the Sixth Circuit, wherein it was held:

"It is well settled that where one makes and sells one element of a combination covered by a patent with the intention and for the purpose of bringing about its use in such a combination he is guilty of contributory infringement and is equally liable to the patentee with him who in fact organizes the complete combination. The leading case on the subject is Wallace *v.* Holmes, 9 Blatchf. 65, 29 Fed. Cas. 79. It was cited with approval in Tie Co. *v.* Simmons, 106 U. S. 89, 1 Sup. Ct. 52, and the same doctrine was applied and extended by this Court in Heaton-Peninsular Button-Fastener Co. *v.* Eureka Speciality Co., 77 Fed. 288, to a case where the articles sold was not even an element of the patented combination, but was an article the use of which in connection with patented combination was a violation of the conditions of a license and destroyed the protection the license would otherwise have afforded. The cases in the Circuit Courts where the same general principle has been applied are legion. We cite a few of them: Bowker *v.* Daws, 3 Fed. Cas. 1070; Richardson *v.* Noyes, 20 Fed. Cas. 723; Travers *v.* Beyer, 26 Fed. 450; Willis *v.* McCullen, 29 Fed. 641; Alabastine Co. *v.* Payne, 27 Fed. 559; Celluloid Manuf'g Co. *v.* American Zylonite Co., 30 Fed. 437."

The Court also stated, in this connection, that many of the most valuable patents have the combination of non-patentable elements, and that the only effective mode of preventing infringement is by suits against those who, by furnishing the parts which distinguish the combination, make it possible for others to assemble and use the combination, and who, by advertisement of the sale of such parts, and otherwise, intentionally solicit, and promote such invasions of the patentee's rights.

The Court also held that one who makes articles which are only adapted to be used in the patented combination, and offers them for sale to the public, will be presumed to **intend the natural consequence of his acts,**

and will, therefore, be held to intend that they should be used in the combination of the patent, and that an injunction will be granted.

The attention of the Court is also called to the following cases:

Wallace *v.* Holmes, 29 Fed. Cas. 79;
Red Jacket Mfg. Co. *v.* Davis, 82 Fed. Rep. 432;
Thomson-Houston Electric Co. *v.* Kelsey Co., 75 Fed. Rep. 1005;
Tubular Rivet & Stud Co. *v.* O'Brien, 93 Fed. Rep. 200;
Stearns *v.* Phillips, 43 Fed. 792;
New York Filter Co. *v.* Jackson, 91 Fed. Rep. 422;
Westinghouse Elec. Mfg. Co. *v.* Dayton Fan & Motor Co., 106 Fed. Rep. 724;
Bement *v.* National Harrow Co., 186 U. S. 90.

In the case of American Graphophone Co. *v.* Amet. 74 Fed. Rep. 789, Judge Grosscup held that the sale of records infringes the combination claim of the rest of the machine of which the record forms a part. The Court further held that the sale of records on the open market does not "release this element of the combination from the monopoly of the patent."

In the case of American Graphophone Co. *v.* Leeds, 87 Fed. Rep. 873, Judge Shipman held that the making and selling of the reproducer of the patented talking machine alone, with the intent that it was to be used with sound records made and sold under a patent covering a combination of the record and reproducer, is an infringement.

In the case of American Graphophone Co. *v.* Hawthorne, *et al.*, 92 Fed. Rep. 516, Judge Dallas held that the sale of a machine, which was useful only in making

patented records, infringed the Bell & Tainter patent for such records.

This question also is very fully considered in the Contempt Proceedings to be argued with this case.

It is submitted that it is unnecessary to cite further authorities in support of complainants' contention.

RE DEFENDANT'S AFFIDAVITS.

Affidavit of Harry Ensign.

The affidavit of Harry Ensign (Record, p. 98, etc.), on behalf of the defendants, is mainly to support the contentions made in Mr. Hicks' affidavit, and a portion of it is a substantial copy of Hicks' affidavit. One or two other points, not touched on by Mr. Hicks, are referred to by Mr. Ensign. Mr. Ensign is the superintendent of the Talk-O-Phone Company, and states that the capital stock was $500,000, then recently increased to $1,000,000. He does not state how much cash has been paid for this stock—only the broad statement that several hundred thousand dollars have been invested by the Talk-O-Phone Company in its factory and plant. (This Company has since gone into the hands of a Receiver.)

As hereinbefore pointed out, the delay in this suit has been mainly due to the demurrer filed by the defendant, on grounds which have been proven by the decision of Judge Holt to be absolutely unfounded, which occupied practically a year. One of the grounds demurred to was that the patent in suit was void on its face for want of patentability, and another that the complainants did not show legal title in the United States Gramophone Company, which question has been clearly adjudicated in another suit by Judge Platt in the Connecticut Circuit. (118 Fed. Rep. 50.)

Mr. Ensign also attempts to reverse the decision of the Court of Appeals (R., p. 73) regarding Fig. 10 of the Berliner Patent, No. 564,586, on the alleged ground that it is inoperative (Rec., p. 106, fol. 318).

We would here state, with all deference to Mr. Ensign, that a model of this Fig. 10 was produced by Mr. Berliner in evidence in the Graphophone Case, and operated in the Court of Appeals at the hearing. Further, Mr. Berliner's evidence, which has been passed on by the Court in the Graphophone Case, shows that Mr. Berliner made one of these devices similar to Fig. 10 and operated it in about 1887.

The Court of Appeals has decided that this Fig. 10, and description thereof, in the U. S. Berliner Patent, No. 564,586, is sufficient to carry the date of invention of claims five and thirty-five of the Patent, No. 534,543, in suit, back to the filing of the first mentioned application, in November, 1887. (R. p. 73.) Mr. Ensign also differs from the Court of Appeals, and the Circuit Court, in regard to the showing of Mr. Berliner's invention in claims five and thirty-five in the "Electrical World" of November 12, 1887.

While Mr. Ensign also refers to the Talk-O-Phone so-called "mechanical feed" machine, Exhibits A and B, nowhere does he state, nor is it stated in any of the defendant's affidavits, that this machine has ever been sold or placed upon the market.

Re Defendant's Affidavit of Albert T. Irish.

Mr. Irish is the president and treasurer of the Talk-O-Phone Company. (R. p. 309.)

Mr. Irish complains of the damage done to the Talk-O-Phone business by circulars of the Victor Talking Machine Company. These circulars were merely legitimate notices of infringement to the Talk-O-Phone

Company of the Victor Company's patents, and particularly of the patent in suit.

Both the Talk-O-Phone Company and the Leeds & Catlin Company are pirates of complainants' inventions and have copied the complainants' machines and records, protected by the claims of the patent in suit, almost identically, without any license or right whatsoever, and in defiance of complainants' rights, after the complainant, by the expenditure of hundreds of thousands of dollars, has established a large business throughout the world.

Such pirating concerns deserve no consideration from this Court.

Mr. Irish states that the records in suit are capable of use with machines of different descriptions; for instance, with the Talk-O-Phone provided with the so-called "mechanical feed," and with talking machines manufactured according to the patents prior to the patent in suit, which he says have been upon the market for many years.

There is no evidence of the allegation made by Mr. Irish that talking machines manufactured in accordance with certain patents prior to the patent in suit have been upon the market for many years, and such is not the case, as there are no machines upon the market, and never have been, other than those manufactured in accordance with the Berliner patents, to which the records in suit were adapted, for sound-reproducing purposes. The defendant may produce one or two in Court from their laboratory or factory, but this is no evidence that they are or have been upon the market, and every one of defendant's affidavits referring to the so-called "mechanical feed" are *guardedly worded, to avoid saying they are upon the market.* They have advertised this device, but *never sold it.* It is true that records similar to those in evidence have been used on other machines than the complainants', and can be re-

produced on other machines than complainants', but these are infringing machines, such as the defendant's machines, built and operated in infringement of claims five and thirty-five of the patent in suit. There is nothing in the Edison Patent, No. 1644, of 1878, or in the Bell & Tainter patents, both of which were before the Court of Appeals in the Graphophone Case, which shows a construction of machine similar to claim thirty-five in suit, or any method similar to claim five.

The records similar to those in suit are an essential part of claims five and thirty-five of the patent in suit, as is evidenced by a reading of the same.

All the records sold by the defendant similar to the exhibits in suit were sold for the purpose of reproducing sound in connection, and in combination, with the structure of machines in suit, and for no other purpose, and *vice versa.*

The record, such as defendant's records in suit is unquestionably an essential part of the apparatus claimed in claim thirty-five, and of the method claimed in claim five.

The machines which Mr. Irish refers to are probably toy machines, such as the "Amet" machine in evidence in the Graphophone Case, with the vertically undulating record, and which, at best, does not represent the prior, but the *subsequent art,* and which could not reproduce sound from the records, similar to defendants' records in suit.

Mr. Irish states that Mr. Hicks, as counsel, advised the Talk-O-Phone Company that the patent in suit expired before the organization of the company, by reason of the expiration of the Berliner foreign patents, and that they have invested hundreds of thousands of dollars in their plant and business, relying upon this fact.

While this advice may be unfortunate, the infringement still remains.

Defendant's Affidavit of Edward F. Leeds (No. 1).

This affidavit of Mr. Leeds (R. p. 115) is for the purpose of corroborating Mr. Hicks' and Mr. Ensign's affidavits relative to some of the statements made therein regarding the foreign patents referred to in discussing Hicks' affidavit.

He also differs with the Court of Appeals in the Graphophone Case, regarding the practicability of Fig. 10 of the Berliner Patent, No. 564,586, and states that he has made certain experiments regarding the operation of the same.

We do not dispute the proposition that it might be possible to make one of these devices so that it would not work.

As hereinbefore pointed out, however, any matter of any relevancy in this case regarding Fig. 10 has been already adjudicated by the Court of Appeals.

Defendant's Affidavit of Edward F. Leeds (No. 2).

Mr. Leeds, in this affidavit (R. p. 292), is evidently attempting to confirm some of the propositions set forth in Mr. Irish's affidavit hereinbefore considered.

He differs with the Court of Appeals regarding the Edison British Patent, No. 1644, of 1878, manifestly from the statements in Mr. Irish's affidavits regarding the same. The same criticisms as to the facts set forth in Mr. Irish's affidavit, apply also to Mr. Leed's affidavit No. 2 in many particulars.

While Mr. Leeds, in affidavit No. 2, seems to desire to convey the idea that the so-called "mechanical feed" machine of the Talk-O-Phone is upon the market, he nowhere, in his affidavit, makes that direct statement.

We admit that they are extensively advertised, and it may be that a few have been exhibited, but we deny that they are upon the market, or have been sold to the trade or to the public, as yet.

Mr. Leeds also pleads, as an excuse for their infringing acts, that the defendants thought that the claims of the patent in suit had expired.

Re Defendant's Affidavit of Harry T. Goss.

The affidavit of Mr. Harry T. Goss (R. p. 297), refers to the suit of these complainants against the American Graphophone Company, and to the Bell & Tainter Patent, No. 341,214, and Edison British Patent, No. 1644, of 1878. Mr. Goss discusses the Bell & Tainter Patent, No. 341,214, and thinks that the Appeal Court in the Graphophone Case, has misunderstood the Bell & Tainter Patent, and refers to the deposition of Chichester A. Bell, one of the joint inventors of Bell and Tainter, in the suit of the American Graphophone Company *v.* The National Gramophone Co., in October, 1900, copy of which is said to be annexed and marked Schedule A. Mr. Goss also refers to a paper deposited by Messrs. Alexander Graham Bell, Sumner Tainter, and Chichester A. Bell in the Smithsonian Institute, in October, 1881, forming part of the record in the American Graphophone Co. *v.* American Record Co. in United States Circuit Court for the Southern District of New York. This latter paper is referred to as the "Volta Laboratory Description." There is nothing, however, in the portion quoted by Mr. Goss in his affidavit in this matter which has any bearing upon the claims five and thirty-five of the patent in suit, the Volta Laboratory description having merely *suggested* the recording of "a wavey or zig-zag line of uniform depth." This was one of the experiments in wax of these gentlemen. Mr. Goss seems to think that as they had a horse shoe, they must have had a horse; in other words, as they thought of a zig-zag record in wax, they also must have thought of a machine of the construction of the claims in the patent for reproducing therefrom. Mr. Goss also fur-

ther discusses the Bell and Tainter patent, which was before the Court of Appeals and held not to anticipate, and seems to think that the Court of Appeals may have taken a wrong view of this Bell and Tainter patent. Mr. Goss then refers to Schedule A (R. p. 304), before referred to. He says that Dr. Bell shows the work done by Mr. Tainter and himself, and contends, from certain selected quotations from that deposition, that they must have anticipated the claims in suit.

RE "SCHEDULE A" (R., p. 304).

A careful reading of this deposition, referred to as Schedule A in the Goss affidavit, will show that what is hinted, or suggested, in his deposition, was *nothing more than an experiment* by Messrs. Bell and Tainter, and he refers, in this deposition to what they did, as **"experiments."** (See answer to Q. 8.)

Q. 8. (R. p. 306) inquired of the witness whether, prior to the application for the patent, No. 341,214, he was aware of the capacity of the record groove *"in various forms of records"* made by you to feed the reproducing stylus laterally across the record. No reproducing mechanism was referred to, and no particular form of record was referred to in the question or answer. His answer also shows that his experiments were with records in *wax*. His answer to Q. 9, quoted in Mr. Goss's affidavit, is very indefinite, as he does not state what "arrangement" he refers to by "that arrangement," but the arrangement mentioned in Q. 9 was a "mechanical form of apparatus." Dr. Bell also shows, by answer to Q. 9, that they found that "some *'feed mechanism'* should be added to the instrument, so as to make the reproducer roughly follow the motion of the record." He shows by answer to Q. 10 that you could not rely on a short lever to remain in the groove.

On cross-examination, he says in answer to XQ. 13, etc., as follows (R. p. 307):

"XQ. 13. Were your experiments with the laterally undulating records made at an earlier or a later date?

A. *I don't like to speak positively* on that point for the simple reason that I myself have not made many *experiments* of that kind, but my impression is that *experiments* of that kind were made very shortly afterward by Mr. Tainter.

XQ. 14. What was the object of making experiments on laterally undulating records, at a time when the vertically undulating cut wax record had been decided upon by you to have been a success and to be the record which you proposed to push?

A. Of course we had to make experiments to find out the best form and to make perfectly certain on that point, and that could only be done by experiments; in fact, we tried everything we could think of whether it seemed promising or not. Our specification does not include anything like the number of experiments we made.

XQ. 15. Is it not a fact that you obtained very much better results with your vertically undulating cut wax record than with any laterally undulating etched record you ever experimented with?

A. My recollection is that it was very hard to distinguish one from the other as far as results went, but the vertically undulating record was found in every way to be the most convenient, and that's why we adhered to it."

It appears by XQ. 13, and XQ. 16, that Dr. Bell, the witness, has not made many of the experiments of the kind himself, as the experiments were made by Mr. Tainter; that this was not his department, but that it was Mr. Tainter's department.

It is clear from this deposition of Dr. Bell, referred to in Mr. Goss's affidavit:

(1) That he nowhere describes any construction of apparatus alleged by Mr. Goss's affidavit to have been previously used by Bell and Tainter, prior to the Bell and Tainter Patent, No. 341,214 (R. p. 387), or prior to the invention in suit, similar to claims five and thirty-five.

(2) He nowhere states that Dr. Bell or Mr. Tainter ever *made or used* such an apparatus, or method.

(3) He states, in answer to Q. 8 that he was aware of the capacity of the "*various forms* of records" in which the groove was cut in *wax* to carry the reproducing style across the record.

(4) He shows by Q. 9 "such feed mechanism was added to the instrument so as to make the reproducer follow the movement of the record."

(5) It is evident from Q. 10 that their experiments were *unsuccessful,* and did not give satisfactory results, except where they used the positive screw feed mechanism, such as shown in the Bell and Tainter Patent, No. 341,214.

(6) He shows by XQ. 13 that at the time his deposition was given (October, 1900,) he did not like to speak positively regarding the dates of the experiments on laterally undulating records in wax, and that "I, myself, did not make many experiments of that kind, but my *impression* is that *experiments* of that kind were made very shortly after that time by Mr. Tainter."

(7) That their experiments were of a general character, is evidenced by the statement in answer to XQ. 14, "*In fact, we tried everything we could think of whether it seemed promising or not.*"

(8) XQ. 15 shows that Bell and Tainter, after their

various experiments, adhered to the *vertically* undulating record.

(9) XQ. 16 shows that Mr. Bell does not desire to speak positively regarding the method of making the laterally undulating record, which they experimented with.

(10) XQ. 16. As before stated, he shows that this was not his department and that "This section of the work was done chiefly by Mr. Tainter."

(11) XQ. 17 shows that Mr. Tainter was still alive. *Mr. Tainter, however, though manifestly the most important witness, if this evidence was important at all, was not called."*

This evidence of Dr. Bell was within the knowledge of Mr. Mauro, counsel for the defendant in the recent suit of the Victor Talking Machine Company, *et al. v.* American Graphophone Company, as he was counsel for the American Graphophone Company when Dr. Bell's deposition was taken in 1900, and examined the witness, and if this testimony had been of any value, Mr. Mauro most certainly would have put it in evidence in the case of these complainants against the American Graphophone Company for infringement of this patent. He knew, however, that all of Dr. Bell's and Mr. Tainter's work on the lines referred to in the deposition were purely experimental; that they never accomplished material results, or built a tangible apparatus similar to the invention in suit, and that what few *experiments* they did make determined them to *abandon* this line of work before their application for the Bell and Tainter Patent, No. 341,214, and to adopt as they did the *vertically* undulating record of uneven depth in wax-like material for reproducing sound through the medium of positively mechanical fed talking machines,

illustrated and described in the Bell and Tainter Patent, No. 341,214, which was so thoroughly considered and reviewed in the Court of Appeals in the Graphophone Case, in the suit on this Berliner Patent.

Re Joseph Lyons' Testimony.

Nor is this matter entirely new to the record in the case of these complainants against the Graphophone Company. We would call attention to the evidence of Mr. Joseph Lyons, one of complainants' witnesses, who was well acquainted with Dr. Bell and Mr. Tainter, the parties referred to. Mr. Lyons was asked in cross-examination (XQ. 22), Graphophone Record, page 37, a copy of which is submitted:

> "XQ. 22. I take it that you are ignorant of the following facts which are within my knowledge, namely, first, that the very first sound record made by Bell and Tainter and to which they gave the name graphophone were of the laterally undulating type; and, second, that specimens of sound records of this kind and of an instrument for making them, together with a written description wherein the word graphophone was disclosed thereon were deposited by those inventors in the Smithsonian Institution in the year 1883, and are still on deposit there?
>
> (Objected to as incompetent.)
>
> A. I have heard rumors to this effect, or substantially this effect. I was informed at an early time of Mr. Berliner's work that Bell and Tainter had experimented in the direction of making a laterally undulating sound record in the surface of a tablet that was covered with beeswax, or some composition into which beeswax entered. At the same time and by the same informant I was also told that the thing was a total failure. This information came to me, I think, from Mr. Tainter. Possibly, however, it was Mr. Bell who spoke to me about it. I can, if it is desired, ascertain, if time is given to me, which of these two inventors have given me

this information. The occasion for this information was a conversation which I had either with Mr. Bell or with Mr. Tainter about Mr. Berliner's gramophone. My informant expressed himself as delighted at the success achieved by Mr. Berliner, and at the same time told me that he, in conjunction with his co-worker, attempted the same thing, but did not succeed; and at the same time he told me that he can now see why they failed."

It is, therefore, clear that both the matter of Dr. Bell's testimony, and of the Volta Laboratory description, deposited in the Smithsonian Institution was referred to by Mr. Lyons, in his deposition in the case of Victor Talking Machine Co. *v.* The American Graphophone Co., on the suit on this patent and before the Court of Appeals.

Mr. Lyon shows that Dr. Bell or Mr. Tainter told him that they, Bell and Tainter, had *attempted* the same thing as Mr. Berliner, but did not succeed, and that they could then see, since Berliner's invention why they failed and expressed himself as "*delighted at the success achieved by Mr. Berliner.*"

RE TITLE.

It is respectfully submitted that the title of the complainants has not been attacked, either in the Circuit Court on motion for preliminary injunction, or in the Circuit Court of Appeals, and that, therefore, this question, not being before either of these Courts on the motion for preliminary injunction, should not be the subject of review in this Honorable Court. See U. S. *v.* Bell Telephone Co., 167 U. S., p. 224, and cases therein cited upon this subject, and hereinbefore referred to in this brief. As the defendant, however, has suggested such a defense in one of his assignments of error, we take the precaution of briefly considering the subject here.

The defendant attacked the title of the complainants in this case on demurrer, in the U. S. Circuit Court, which was fully argued before Judge Holt. On October 31, 1905, an opinion was filed (F. R.). Judge Holt said, *inter alia:*

> "In my opinion, therefore, the United States Gramophone Co. is the owner of the patents, and the Victor Talking Machine Co. is the sole licensee under the patents, and under the authorities they are the proper complainants."

The demurrers were overruled. The defendant's counsel, Mr. Hicks, in his affidavit in this case (R., pp. 76-77, fols. 228-229), refers to these demurrers.

The defendant never put in any evidence in this case attacking the complainants' title to the patent in suit.

The attention of the Court is also called to the decision of Judge Platt, in the suit of these complainants against the American Graphophone Co., District of Connecticut, October, 1902, 118 Fed. Rep. 50), where the title of these complainants to the patent in suit was sustained on demurrer, the Court there holding that the Berliner Gramophone Co., which had also been made a party complainant, in conjunction with these complainants, was an unnecessary party (the demurrer was sustained as to the Berliner Gramophone Co.).

In the subsequent proceedings in the motion for preliminary injunction in the present suit, the defendant made no attack upon or defence as to complainants' title, by reason probably of the fact that the question of title had been previously decided by Judge Holt on demurrer; and again perhaps by reason of the fact that the question of title had been fully adjudicated in the Graphophone Case, which record is before this Court. Therefore, it is respectfully submitted that this question should not be considered by this Court, on review in these motions for preliminary injunction.

The Granting of a Preliminary Injunction is within the DISCRETION of the Circuit Court. If Discretion not Improvidently Exercised, Injunction should Stand.

It is hardly necessary to cite authorities in support of this proposition. If the *discretion* of Judge Townsend in granting the injunction in this case, in the Circuit Court, was not improvidently exercised under the facts and circumstances of the case, the U. S. Circuit Court of Appeals for the Second Circuit, upon so finding, and it did so find, would not reverse the Court below under the well established authorities.

As this appeal before this Honorable Court is an appeal from the decree of the U. S. Circuit Court of Appeals, this Court in reviewing this case, is in the same position as the U. S. Circuit Court of Appeals, and it is submitted would be guided by the same authorities. If, therefore, this Court under the facts presented, should find that the *discretion* exercised by the Circuit Court in granting the preliminary injunction was not improvidently, or erroneously, exercised, the decision of this Court should, therefore, be the same as that of the Court of Appeals, and the decree of the Circuit Court should be affirmed.

We take the liberty of citing a few authorities of the lower Federal Courts supporting this proposition that the decree of the Circuit Court granting the preliminary injunction should not be reversed unless there was an abuse and an improvident exercise of the judicial discretion.

Duplex Printing Press Co. v. Campbell Printing Press & Manufacturing Co., 69 Fed. Rep. 250.

This is the case in the Circuit Court of Appeals for the Sixth Circuit, referred to in the preceding quota-

tion. The opinion was written by Judge Taft, and the following from page 252 thereof is in point:

> "The motion for a preliminary injunction necessarily involved the exercise by him of a sound judicial discretion in granting or withholding it. * * * We are to consider the correctness of the order from the same standpoint as that occupied by the Court granting it, and if we find, after consideration of the grounds presented to that Court for its action, that its legal discretion to grant or withhold the order was not improvidently exercised, we should not disturb its action."

Ritter v. Ulman, et al., 78 Fed. Rep. 222.

Judge Simonton, speaking for the Circuit Court of Appeals of the Fourth Circuit, stated on page 224:

> "The granting or the refusal of an injunction rests in the sound discretion of the Court. Poor *v.* Carleton, Fed. Cas. No. 11,272. It is a power requiring great caution, deliberation, and sound discretion, and involves responsibility. The right set up must be clear, the injury must be impending, and so threatened that it can be averted only by the preventive process of the Court. The judge who granted this injunction has had great and unusual experience. He was possessed of all the facts of the case, and of the peculiar circumstances surrounding it. His exercise of his discretion, no doubt, was the result of calm deliberation. It could only be set aside for manifest error in the conclusion he reached."

Garrett, et al., v. T. H. Garrett & Co., 78 Fed. Rep., 472.

This was a case in the Circuit Court of Appeals for the Sixth Circuit, and Judge Sage, writing for the Court, said on page 477:

> "The rule of this Court not to disturb the action of the Court below, unless the discretion of

the Judge was improvidently exercised, was recognized by the Circuit Court of Appeals of this circuit in Duplex Printing Press Co. *v.* Campbell Printing Press & Manuf'g Co., 16 C. C. A., 220, 69 Fed. 252. The granting and withholding of a preliminary injunction is largely within the discretion of the Judge who passes upon the application for it, and there are many considerations which may be even controlling without reference to the merits of the question at issue."

Blount v. Societe Anonyme Du Filtre Chamberland Systeme Pasteur, et al., 53 Fed. Rep. 98.

This was another case in the Circuit Court of Appeals for the Sixth Circuit, the opinion being written by Judge Jackson, who stated on page 100:

"The single question presented for our determination on said appeal is whether the order of the lower Court awarding the injunction was erroneous or improvident, under the facts and circumstances of the case, as disclosed by the motion papers on which its action was based."

Paris Medicine Co. v. W. H. Hill Co., et al., 102 Fed. Rep. 148.

In the opinion of this case, Judge Lurton says on page 153:

"In Proctor & Gamble Co. *v.* Globe Refining Co., 34 C. C. A. 405, 406, 92 Fed. 357, this Court refused to reverse the action of the Court below in denying a temporary injunction, upon the ground that it was not so plainly apparent that the Court below had made a mistake as to justify a reversal of its action in a matter in which much must be left to the discretion of the Court below. The trial of the question, upon appeal from an order granting or denying a preliminary injunction, especially when the action of the Court below was based

in large part upon conflicting affidavits, is not as if the appeal was from a final decree upon the merits. In the case cited above, this Court, speaking by Judge Severens, said:

> 'This being an appeal from an order denying a preliminary injunction, the question to be determined is whether the discretion of the Court below was improvidently exercised, and not whether, upon the final hearing, upon full view of all the facts in the case, this Court would, upon the evidence before it, reach the same conclusion as that of the Court below. Duplex Printing Press Co. *v.* Campbell Printing Press & Mfg. Co., 16 C. C. A. 220, 69 Fed. 252; Garrett *v.* T. H. Garrett & Co., 24 C. C. A. 173, 78 Fed. 472. To justify this Court in reversing an order of this kind, it must be quite clearly apparent that a mistake was committed by the Court below. Ritter *v.* Ulman, 42 U. S. App. 263, 24 C. C. A. 71, 78 Fed. 222.'

"The ruling of Judge Swan, who heard this case in the Court below, was based upon certain conclusions of fact, already stated, drawn from conflicting *ex parte* affidavits. In this situation of the case, we are not so clearly convinced that there has been such a plain error as to justify a reversal. The decree will therefore be affirmed."

THE DEFENDANT'S ACTS.

It is respectfully submitted that the acts and attitude of the defendant in this cause have been throughout the whole proceedings such as tend to show **a want of good faith** on its part, and that from the very incipiency of the infringement, its attempt has been not only to use and enjoy without license or right complainants' invention patented by the patent in suit, and without the payment of any royalty (for which patent, together with the other Berliner patents, the Victor Talking

Machine Company paid $800,000), but the defendant from the very beginning **copied complainants' said patented commercial machines and records almost identically as to shape, size, form and general appearance,** so that it was difficult even for the trade to distinguish between the complainants' and defendant's commercial records and machines, to say nothing of the deception practiced upon the public. A comparison of the complainants' and defendant's machines and records in evidence only is necessary to prove this fact.

Further, the preliminary injunction in this case, sustained by the Court of Appeals, had hardly been granted before this defendant, the Leeds & Catlin Company, continued the manufacture and sale of the infringing records for use with the reproducing apparatus, comprising the structure of claim thirty-five, to be operated in accordance with claim five, in direct violation of the injunction writ served upon the defendant in conformity with the decree of the Court. For this, **contempt proceedings** were at once instituted, and the defendant held in contempt, the Court imposing a fine. This decision of the lower Court by Judge Lacombe was duly affirmed upon appeal, by the U. S. Circuit Court of Appeals for the Second Circuit. These contempt proceedings are now before this Honorable Court at this time upon writ of error, and are considered in a separate brief.

The security entered by the defendant in the Circuit Court pending appeal to the Circuit Court of Appeals may be inadequate to cover the damages and profits which might arise during the period of appeal to the U. S. Circuit Court of Appeals, and is utterly inadequate to protect the complainants during the pendency of this appeal in this Honorable Court.

It is respectfully submitted, as before submitted, that the defendant has not only pirated the complainants' invention, after they had made a world-wide suc-

cess for the Victor talking machines and records, but has so closely copied the complainants' machines and records as to mislead the public into the belief that the defendant's machines and records were the celebrated Victor talking machines and records.

CONCLUSION.

It is respectfully submitted, as hereinbefore shown, that the discretion of the Circuit Court was providently and wisely exercised in accordance with the law and the facts; that the decision of the Circuit Court of Appeals for the Second Circuit affirming the decree of the Court below was without error and in conformity with the law and the facts in the exercise of equity jurisdiction, and that the complainants are entitled to the preliminary injunction prayed for in the bill of complaint, and that the decree of the Circuit Court of Appeals for the Second Circuit should be affirmed with costs to the complainants.

All of which is most respectfully submitted.

HORACE PETTIT,
Counsel for Complainants.

December 12th, 1908.

Reported 140 Fed. Rep., p. 860.

UNITED STATES CIRCUIT COURT, SOUTHERN DISTRICT OF NEW YORK.

IN EQUITY.

Victor Talking Machine Company and United States Gramophone Company,

Complainants,

v.

American Graphophone Company,

Defendant.

HORACE PETTIT, of counsel for complainants.

ELISHA K. CAMP, for defendant.

PHILIP MAURO, C. A. L. MASSIE, of counsel.

HAZEL, *District Judge:*

The bill is in equity and relates to the infringement of Letters Patent No. 534,543, issued February 19, 1895, to Emile Berliner, assignor to complainants, on application filed March 30, 1892, for improvements in a talking machine commonly known as the "gramophone." The apparatus to which the improvements relate, is constructed to record and reproduce vocal sounds. The patent has thirty-five claims, of which claim five, for the process and thirty-five for construction of the recording and reproducing apparatus, alone are involved. Such claims read as follows:

> "5. The method of reproducing sounds from a record of the same, which consists in vibrating a stylus and propelling the same along the record by and in accordance with the said record, substantially as described.

"35. In a sound reproducing apparatus consisting of a traveling tablet having a sound record formed thereon and a reproducing stylus shaped for engagement with said record, and free to be vibrated and propelled by the same, substantially as described."

At the date of the invention in suit it was not new to record sound and articulated words and reproduce the same by suitable mechanical agencies. Numerous defences are interposed in the answer, viz: anticipation, prior use, abandonment, and non-patentability. The objection is also urged that the Court is without jurisdiction, on the ground that complainants before the suit was instituted, agreed in writing to release the defendant from the payment of damages and to grant to it a license to use, sell and manufacture the patented machine provided the patent in suit was held valid by the Court. Such objection, however, which is erroneously sought to be sustained upon the authority of Root *v.* Railroad Co., 105 U. S., 189, is without merit. The principle is unassailable that where mere damages are sought to be recovered in an action for infringement of a patent, a court of equity will not interfere. But where the bill alleging infringement of an unexpired patent, demands damages and permanent injunction, equitable relief in a proper case will not be refused. A prior agreement by which the interested parties mutually agree upon terms of settlement on condition that the patent in controversy is sustained by the Court, cannot upon principle and authority deprive a Court of its inherent power and jurisdiction. McMillin *v.* St. Louis and Miss. Valley Transp. Co. (C. C.), 18 Fed. 260; Guaranty Co. *v.* Green Cove Rd. Co., 139 U. S., 137; to the same effect see Doyle *v.* Continental Ins. Co., 94 U. S. 535, Insurance Co. *v.* Morse, 20 Wall 445. It is insisted on the part of the defendant that the evidence

conclusively shows that there was a public use of the invention for more than two years prior to the application for the patent; that the inventor abandoned his right to the claims in suit by a postponement of them, and that in an earlier application for a patent, he described such claims in his specifications without, however claiming them. The complainants contend that the alleged prior public use was for the purpose of experiment, and that there was no abandonment in fact. To properly understand the defences, it is necessary to consider the state of the art and to briefly indicate the principles of the various talking machines commonly known and mentioned in the record. The references relied upon to anticipate the involved claims are, first, the Franklin Institute lecture by the patentee, on May 16, 1888; second, a publication by him in the Electrical World, on November 12, 1887, and third, the patents to Bell & Tainter, No. 341,214 dated May 4, 1886, and to W. Suess assignor to Emile Berliner, No. 427,279, issued May 6, 1890. In the British patent to Edison, No. 1644, dated April 24, 1878, for recording and reproducing vocal sounds, the air vibrations were recorded by a system of indentations upon a pliable or yielding material, as for instance, a thin sheet of metal or tin foil. The foil was ordinarily placed over a grooved substance and received impressions of the voice through the instrumentality of a movable, inelastic diaphragm, having at its end an indenting point or stylus. In order to effectuate the reproduction of sound vibrations, the point of the stylus was essentially kept in constant contact with the revolving record, cylinder or disc. This was accomplished by a mechanical device which propelled the stylus across the surface of the record. In the graphophone patent, issued to Bell & Tainter, the record was engraved or cut in wax-like or amorphous material. The form of cutting or engraving was in the

spiral groove of varying depth, the side of the walls sloping toward the bottom. The stylus, which curved in a downward direction, was kept in the groove by gravity and as the record rotated it was vibrated vertically, "in the direction of its length." It is shown by the evidence that the graphophone in one form, which is illustrated in the drawings attached to the patent, required mechanical means to propel the record past the reproducer diaphragm and stationary stylus. In another form a movable stylus attached to the diaphragm was propelled by an auxiliary device across the record so as to retain the stylus point in constant contact with the vertical undulations. These different forms of talking machines are disclosed by the patents of prior date. The common form of style being adapted to record and reproduce vocal sounds at the instance of the user, and the other to merely reproduce sound vibrations as had previously been recorded in accordance with the process of the patentee:

In the patent to Emile Berliner, No. 564,586, issued on July 28, 1896, application filed November 7, 1887, the process of recording and reproducing sound vibrations differs essentially from the method used in the phonograph and the graphophone. The specification described a process by which the sounds were inscribed upon a layer of non-resisting material, which was afterwards copied in a non-yielding material, from which the sounds were reproduced. The specification says:

> "The original record, as well as the copy of the same, is thus obtained as an undulatory line of even depth, as distinguished from the line of varying depth obtained by the ordinary phonograph and graphophone."

It is not disputed that such mode or process was a new and meritorious invention and that it was not merely a patent for the functional effect of the machine

in connection with which it was used. The earlier specification does not claim the method nor the details of construction of the claims in controversy; hence it is contended by the defendant, as will presently appear, that there was a surrender or waiver thereof. In the patent in suit two features of the invention are mentioned, one concerning the process or mode of recording sound upon a record tablet, the other as to the construction of the apparatus. Complainants contend, and the proofs show, that the stylus attached to the diaphragm is arranged so as to permit the same to vibrate laterally, and that owing to lateral undulations in the walls of the record groove, a desirable swaying motion is imparted to the reproducer diaphragm. Concededly, the lateral undulations in the record automatically guide or propel the stylus and diaphragm in its course over the disc from the outer circumference toward the center, and the stylus travels in an apparently direct radial path while at the same instant of time it is pulsated or incited by the sound waves.

The principle of operation in the Berliner machine is thought to be essentially different from that of the machine of Bell & Tainter. In the latter, an auxiliary joint or feed screw was necessary, as already stated, to effectuate the required passage of the record over the point of the stylus, or to cause the stylus and reproducer diaphragm to travel across the surface of the record. In complainants' patent, on the other hand, it is shown that the lateral vibrations of the stylus point and the propelling of the same over the face of the record without mechanical assistance and through the means of the groove alone was the primary object of the inventor. In the Suess patent is contained a description corresponding to the features of claim thirty-five in suit. The primary object of Suess, an employee of Berliner, however, was

merely to construct a suitable pivotal support for the diaphragm and stylus, so as to assist such device in its passage across the record. It is expressly stated in the specification of the Suess patent that the invention relates to improvements in the reproducing apparatus of Berliner, and that the construction and mounting of the stylus form no part of the invention. The improvement of Suess, therefore, is not an anticipation. Defendant insists that the Bell & Tainter specification fully described the Berliner process and specific combination. Such specification says:

> "The invention consists, fourthly, in loosely mounting the reproducing style, so that it is free to follow the record." And, further: "Preferably the reproducing style, or rather what may be called the 'head' of the reproducing instrument is mounted on an universal joint, and the style is pressed against the record by the yielding pressure of a spring or weight."

Stress is placed upon the language quoted; but from what has already been said regarding the Bell & Tainter patent, it is manifest that the principle of Berliner's invention rests upon the practicability of propelling the stylus in the groove across the surface of the record without a feed screw or other mechanism. By such adaption to what is known in the art as a zigzag record (complainants' record), certain imperfections in the talking machine were overcome, and sound, when reproduced, was rendered more intelligible. There was, I think, patentable novelty in the method which accomplished the results stated. The broad claims in suit in my judgment cannot be restricted to a record of even depth, such as described in the specification. The essence of such claims would seem to include a sound record, which, when in juxtaposition with a diaphragm and stylus propelled in the manner de-

scribed, is thereby enabled to successfully accomplish the primal object and purpose of the invention.

The next defences, prior use and abandonment, may be considered together. The proofs show that the patentee used his machine and gratuitously delivered a lecture in relation thereto in the City of Philadelphia, on May 16, 1888, to an audience of about two hundred persons, more than two years before the application in suit, and that prior thereto in the year 1887, he published an article in a periodical, the "Electrical World," relating to his said discovery. He expressly stated in his lecture that the exhibit machine was the hasty result of a new mechanism and the accomplishment should be measured by its future possibilities and not wholly by the demonstration. It is not claimed that there were any sales of the instrument at the time of the exhibition and lecture; indeed, it is conceded that the apparatus was not sold nor used by other persons until about six years later, when the patent in suit was issued. The mere exhibition of the machine to an assembled audience to hear an explanation of one's invention was not fatal to the patent under the authorities. Shaw *v.* Cooper, 32 U. S., 292; Egbert *v.* Lippman, 104 U. S., 333, Elizabeth *v.* Pavement Co., 97 U. S., 126; Eastman *v.* Mayor, etc., of the City of New York, 134 Fed. 844. That a complete disclosure was made of the described plan of mounting the reproducer diaphragm and stylus in the specification attached to the application filed November 7, 1887, is freely admitted. Such disclosures consisted of a machine constructed in accordance with the drawing (Fig. 10) of the earlier application. The diaphragm and stylus were mounted or suspended upon a conveyor arrangement having rollers. The inventor did not allow his invention, with his consent, to be embodied by other persons in a completed machine, and no profit or gain

until the patent was granted, was realized as a result of the invention. Moreover, the evidence and circumstances justify the assumption that the exhibition of the apparatus was purely experimental and in no sense a public use within the meaning of the statute. In Elizabeth *v.* Pavement Co., *supra*, the Supreme Court considered the meaning and application of the words public use. In the opinion it is stated:

> "But if the inventor allows his machine to be used by other persons generally, either with or without compensation, or if it is with his consent, put on sale for such use, then it will be in public use and on public sale, within the meaning of the law—Nicholson did not sell it, nor allow others to use it or sell it. He did not let it go beyond his control. He did nothing that indicated any intent to do so. He kept it under his own eyes, and never for a moment abandoned the intent to obtain a patent for it. In this connection, it is proper to make another remark. It is not a public knowledge of his invention that precludes the inventor from obtaining a patent for it, but a public use or sale of it."

This doctrine undoubtedly has application to the facts here. As already appears, the patent in suit was issued upon a later application than patent No. 564,586. Why the broad claims of the former were not made a part of the earlier application and specification does not appear. Defendant broadly contends that the fact of the omission by the patentee to claim the invention in the earlier application, considered in connection with the above mentioned publication in the "Electrical World" and public exhibition, was an abandonment and forfeiture thereof. It is true that the Revised Statutes (S. 4888) require the inventor to point out and distinctly claim the improvement or combination which he claims in his invention or discovery. If

he omits so to do, such improvement or combination being apparent on the face thereof, he is presumed to have abandoned the same and to have dedicated to the public that which is not claimed. Miller *v.* Brass Co., 104 U. S. 350; James *v.* Campbell, 104 U. S. 356; Sirrat *v.* Excelsior Mfg. Co., 61 Fed. 980; McBride *v.* Kingman, 97 Fed. 217. But it may be stated as a general rule that "a patent is never invalidated by the fact that the invention claimed in it was described but not claimed in a patent granted subsequently to the making of the application for the patent secondly issued, but before it was granted." This principle as enunciated by Judge Blatchford in Singer *v.* Braunsdorf, 7 Blatch., 521, is thought to apply. See also Thomson-Houston Elec. Co. *v.* Elmira & Horseheads Ry. Co., 69 Fed. 257. In any event it cannot justly be claimed, from the facts, that Berliner had done anything to indicate an intention to waive or surrender his discovery. To merely withhold a patent from the public has never been considered an abandonment, and the adjudged cases uniformly held that an inventor may have a patent for an invention described but not claimed by him, in a prior patent to himself. Graham *v.* McCormick, 11 Fed. 859; Vermont Farm Machine Co. *v.* Marble, 19 Fed. 307; Eastern Paper Bag Co. *v.* Standard Paper Bag Co., 30 Fed. 63. In the latter case the language of the Supreme Court in Miller *v.* Brass Co., James *v.* Campbell *supra,* was interpreted as applying to re-issue under the statute. It was broadly held that the description of another invention in a prior patent by the same inventor does not forfeit his right to afterward take out a patent for such invention. In this case the patent on the earlier application, as has been stated, was issued subsequntly to the patent in suit. I am unable to perceive how the patentee's failure to claim the invention described in

his earlier application can be construed as an abandonment thereof. It is true an abandonment of an invention by a patentee to the public is a question of fact and may be established by the patentee's intention to abandon, or by inferences consistent therewith. Rifle & Cartridge Co. *v.* Arms Co., 118 U. S. 22; Planing Machine Co. *v.* Keith, 101 U. S. 479. The burden, however, is upon the defendant to show that the invention was abandoned. Wyeth *v.* Stone, Fed. Cases No. 18,107. Nor indeed should evidence of abandonment rest upon doubtful or controverted inferences. The publication in the "Electrical World" is not entitled to the probative weight claimed by the defendant. The rule is that the prior publication, in order to anticipate, must fully and clearly describe the invention so as to enable the skilled in the art to completely understand it and reproduce the apparatus without assistance from the patentee, Badisch Ainlin & Soda Fabrik *v.* Kalle, 94 Fed. 163; Cohn *v.* Corset Co., 93 U. S. 366. The prior publication, based upon the article mentioned, is not within the rule stated. The elicited facts are thought to be foreign to sustaining the asserted defences, and hence infringement not being controverted, complainants are entitled to a decree adjudging the validity of the patent and its infringement and for an injunction against the use of the machines or devices made in violation of claims five and thirty-five of the patent in suit with costs.

Reported 145 Fed. Rep., p. 351.

IN THE UNITED STATES CIRCUIT COURT OF APPEALS, SECOND CIRCUIT.

Before LACOMBE, TOWNSEND and COXE, *Circuit Judges.*

Victor Talking Machine Company and Another,
Complainants-Appellees,

v.

American Graphophone Company,
Defendant-Appellant.

HORACE PETTIT, of Counsel for Complainants-Appellees;

PHILIP MAURO, of Counsel for Defendant-Appellant.

This cause comes here upon appeal from a decree of the Circuit Court, Southern District of New York, sustaining the validity (and finding infringement) of U. S. Letters Patent, 534,543, granted February 19, 1895, to Emile Berliner, for the "Gramophone." The opinion in the Circuit Court is reported in 140 Fed. 860, *per curiam.*

In affirming this decree we do not find it necessary to add anything to the careful and exhaustive discussion of the issues which will be found in Judge Hazel's opinion, with one single exception. In disposing of the defence of prior public use based upon the lecture and exhibition before the Franklin Institute, the Circuit Court apparently relied mainly upon the proposi-

tion that what took place there was not a public use, but rather an experimental one. Without discussing the questions thus raised or expressing any definite opinion either way, we prefer to dispose of the alleged prior public use by means of the application of Berliner which was filed six months prior to the Franklin Institute lecture, and which eventuated in Patent 564,586, issued subsequent to the patent in suit. The specifications in that application (for 564,586) were full enough to warrant the making of the claims here in controversy (five and thirty-five) at any time the application might have been amended by adding such claims, and in our opinion it is immaterial that instead of thus amending it, he took the broader claims on another application filed while the first was pending. The second may fairly be considered a continuation of the first, and thus Berliner's application antedates the public use, and the facts will not sustain the contention that he abandoned his invention here in suit.

The decree is affirmed.

Reported 146 Fed. Rep., p. 534.

UNITED STATES CIRCUIT COURT, SOUTHERN DISTRICT OF NEW YORK.

Victor Talking Machine Company, et al.,

v.

Talk-O-Phone Company.

The Same

v.

Leeds & Catlin Company.

ON MOTION FOR PRELIMINARY INJUNCTIONS.

TOWNSEND, *C. J.*:

The bills allege infringement of claims five and thirty-five of the Berliner Patent No. 534,543. The Circuit Court for the Southern District of New York in the suit of this complainant against the American Graphophone Company, after an exhaustive discussion of the issues presented sustained said claims and its decree was affirmed by the Circuit Court of Appeals on March 1, 1906, after elaborate argument by able counsel and upon voluminous briefs in which apparently every material defence was presented and discussed.

The case on this motion is presented by some five hundrd pages of affidavits and briefs: "Defendants' Exhibits Letters Patent" is a book of some 135 pages.

It appears that the machines of these defendants are practically identical with those found to infringe in the former suit. These defendants, however, have set up twelve defences claimed either to consist of new matter not before the Court on the former hearing, or to relate to matters, which while in the record at the former hearing were not considered or discussed. The Court is urged to dispose of these questions at the earliest possible moment in view of the great financial interest involved of the advertisements and circulars issued by the respective parties relating to the patent in suit and the machines claimed to infringe, and of the serious damage involved whether a preliminary injunction be granted or denied.

The new defences are founded *inter alia* on the contentions that the patent in suit has expired by reason of the expiration of prior Berliner German, French and English patents and a Berliner-Suess Canadian patent; by reason of Berliner's abandonment of his invention in view of said Berliner-Suess patent; that Berliner was anticipated by an Edison patent; that in the former suit the Berliner patent was not fairly in controversy; that complainant has been guilty of laches, and that defendants do not infringe in view of the prior art and especially of certain prior Berliner patents.

The first and second defences rest upon prior Berliner German Patent No. 53,622 and French Patent No. 207,090. It is claimed that the Berliner patent in suit covers improvements in details of construction upon the Gramophone described and claimed in earlier patents, because his broad invention had been disclosed therein and especially in 372,786 not before the Court in the original suit, and that those details were covered by said prior foreign patents; that the inventions in suit are identical with those of the foreign patents, and

that as they expired prior to the commencement of this suit, the patent in suit expired at the same time under the settled rule.

Bate Refrig. Co. *v.* Sulzberger, 157 U. S. I.;
Sieman *v.* Sellers, 123 U. S. 276.

It is claimed that the language of the specification of the patent in suit supports this view where the patentee says that "one feature of my invention has reference to the method of recording sound," &c., and "the other features of my invention have reference to the construction of the details of both the recorder and the reproducer of the Gramophone," and that while he illustrated his reproducing apparatus as a whole he does not state that it is his invention.

It is claimed further that unless the claims in suit are limited to certain improvements in details they are anticipated by Edison & Suess.

It is argued that the patent in suit expired prior to the commencement of this suit by reason of the expiration of said prior Berliner German and French patents. The drawings of the German patent are substantially identical with Figures 6 and 7 of the patent in suit, and the specifications describe and the claims cover these constructions. The same is true, (barring the claims which are immaterial) of said French patent.

The German patent being a patent of addition to prior Patent No. 45,048, expired with the expiration thereof on November 7, 1902. The French patent expired July 19, 1905.

The French patent and the claims of the German patent cover improvements in details of the construction of Berliner's recorder and reproducer.

It is claimed by complainant that these details differ in construction and operation from those shown

in the patent in suit and covered by claims not in issue, but this question can only be determined by expert testimony, and this point does not appear to be material in the determination of the issue herein.

The issues here presented, assuming the details to be substantially identical, is whether the prior patenting in a foreign country of a minor part of a broad or basic invention, such as that covered by the claims in suit, so effects the whole that the expiration of the foreign patent terminates the whole of a United States patent which includes both the minor parts and the broad main invention. The Circuit Court and the Circuit Court of Appeals in the original suit held that the claims in suit covered the broad invention.

The claims in sujt are as follows:

> "5. The method of reproducing sounds from a record of the same which consists in vibrating a stylus and propelling the same along the record by and in accordance with the said record substantially as described.
>
> "35. In a sound reproducing apparatus consisting of a traveling tablet having a sound record formed thereon and a reproducing stylus shaped for engagement with said record and free to be vibrated and propelled by the same, substantially as described."

The statutes provided as follows:

> "Sec. 4887. No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country, unless the same has been introduced into public use in the United States for more than two years prior to the application. But every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the

same time with the foreign patent, or if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years."

The test in each case under the statutes, is whether the inventions are identical, as is said by the Supreme Court in Commercial Mfg. Co. *v.* Fairbanks Co., 135 U. S. 176-194.

> "A fair test of the question as to whether the American patent is anticipated by the foreign patents, or is included in them, we think would be, were a person in this country, after the issue of the present American patent, to commence the manufacture of oleomargarine by the precise process described in the Bavarian or Austrian patents, supposing that process had not been patented abroad, would the Courts refuse an injunction to restrain the use of the process on the ground that it infringed that covered by the American patent? We can hardly deem it possible that any intelligent Court would deny an injunction if applied for under such circumstances; and we think this fairly illustrates the relation of the foreign to the American patent."

The cases cited do not satisfactorily settle this question or at most do not seem to support defendants' contention. Thus in Siemans *v.* Sellers, 123 U. S. 276, the Supreme Court held that the American patent expired with the foreign patent, saying that "the principal invention is in both, and if the American patent contains improvements this fact cannot save the patent from the operation of the law which is invoked."

In Western Electric Co. *v.* Citizens' Tel. Co., 106 Fed. 215, the Court said as follows:

> "But what is more directly to the point, the essence of the patent in suit contained in the first claim thereof, namely, the cutting out of the an-

> nunciator from the circuit employed for conversation, is embodied in the description of the invention in the foreign patents. The construction given in the specification necessarily involves it. The case is, therefore, brought under the operation of the rule laid down in Siemans, Adm'r. *v.* Sellers, 123 U. S. 276, 8 Sup. Ct. 117, 31 L. Ed. 153, even though it be conceded that there are differences in some details between the foreign and the home patents upon which independent claims might be based."

I fail to find in the numerous cases cited by counsel any authority for the proposition advanced by defendant that if any article made according to the description of the prior foreign patent would infringe any claim of the American patent no matter how insignificant, then the two patents are for the same invention, and the American patent expires *in toto* with the prior foreign patent. In fact, the interpretation placed by the Courts upon the decision of the Supreme Court in Siemans *v.* Sellers, *supra*, seems to be that the test is whether the principal invention of the domestic patent is found in the prior foreign patent.

I think from such brief examination as I have been able to give the authorities cited that the rule contended for by the defendant does not apply to cases where the foreign patents which have expired do not cover the broad claims for the basic invention.

It is next contended that the patent in suit expired at the same time with certain other Berliner German and French patents and an English patent, because these patents cover the invention of Berliner's United States Patent No. 564,586. But an examination of the drawings of the prior British patent shows that there is omitted therefrom the Figure 10 of the United States Patent No. 564,586, which was the only figure illustrating the form of device covered by the claims here in suit.

There is nothing either in the specifications or drawings of the said British patent which describes, illustrates or shows the method or apparatus of the claims here in suit. These considerations apply equally to said earlier German and French patents.

The fourth, fifth and sixth defences are founded upon a Canadian patent (No. 41,901) to Berliner as assignee of Suess, upon which defendant lays great stress. This patent discloses and broadly claims the invention covered by the claims here in suit. It is contended that thereby Berliner admitted that Suess was the inventor of the reproducing apparatus in suit; that by Berliner's application as assignee of Suess he abanboned the broad claims in suit, and that as the said Canadian patent covered said broad invention and expired in 1899, the patent in suit expired with it.

The evidence introduced in the original suit showed and the Court found on the Suess patent 427,279, that Suess was merely an improver of a particular form of swinging arm device and some of the language used in the specifications of this Suess Canadian patent, which however, was not before the Court, in the original suit, seems to indicate that its structure is merely an improvement on the broad Berliner invention, and Berliner himself afterwards applied for and obtained a Canadian patent for the broad invention covered by the claims here in suit.

But the Canadian patent in terms describes and claims the broad generic invention of Berliner covered by the claims here in suit, as will be seen from the following claims:

> "5. In an apparatus for reproducing sounds from a record tablet, the combination with a reproducer mechanism consisting of a sound conveying tube and a diaphragm and stylus mounted at one end of the tube, of a freely swinging supporting frame for the said reproducer mechanism, substantially as described.

"7. In an apparatus for reproducing sounds from a record tablet, the combination with a reproducer mechanism consisting of a sound conveyor, and a diaphragm and stylus mounted at one end thereof of a supporting frame for the said reproducer, loosely pivoted to swing freely both laterally and vertically, substantially as described.

"11. In an apparatus for reproducing sounds from a rotating record tablet, a reproducing stylus mounted to have a free movement over the surface of the record tablet, substantially as described."

I think, therefore, that if this patent expired as claimed in 1899 the patent in suit expired at the same time, upon the authority of the decisions cited above.

It is contended by complainant, however, that the Canadian patent did not then expire because it was granted for a term of eighteen years from its date, namely, from February 11, 1893. The grant of the patent is for "The period of eighteen years from the date * * * subject to the conditions in the Acts" of Canada. The patent grant further provides as follows:

"The partial fee required for the term of six years having been paid to the Commissioner of Patents, this patent shall cease at the end of six years from date unless at or before the expiration of the said term the holder thereof pay the fee required for the further term or terms as provided by law."

The rule in such cases as I understand it is that the duration of the United States patent is limited by the duration of the legal term of the foreign patent and that it is not limited by any lapse or forfeiture of any portion of said term by means of any condition subsequent.

Pohl *v.* Brewing Co., 134 U. S. 385.

In Bate Refrig Co. *v.* Sulzberger, 157 U. S. 508, the Supreme Court says as follows:

> "But the American patent will be granted upon the conditions that, if you obtain the foreign patent first, your invention shall be free to the American people whenever, by reason of the expiration of the foreign patent, it becomes free to the people abroad."

In Bonsack Mach. Co. *v.* Smith, 70 F. R. 383, the Court construing the decisions held that the question in every case was when does the foreign patent expire looking to its language when issued. Applying this test here I conclude with some hesitation that as the term fixed in the grant was for eighteen years, at the time when the United States patent in suit was issued, the latter does not lapse at the end of six years because of the failure of the patentee after the United States patent had issued to pay the fee for a further term of six years. This conclusion seems to accord with that reached by the Circuit Court of Appeals for this Circuit in Welsbach *v.* Apollo, 96 F. R. 332. In any event, for reasons hereinafter stated, I have concluded to resolve the doubt raised on this point in favor of the complainant.

The defence founded on the prior Edison patent will not be discussed because said patent was before the Court in the original suit. The contention that by reason of a certain contract between the parties "the prior suit was not * * * a suit in which the Berliner patent in suit * * * was fairly in controversy" is not deserving of notice. The contract and the relations of the parties were fully before the Court and the record and briefs in said case are a sufficient answer to any such contention.

The other defences of laches and non-infringement need not be considered.

I have given all of my time available during the past ten days to the examination of the various questions presented on this motion and have reached the conclusion that, except as to the Suess Canadian Patent No. 41,901, the defendants have failed to introduce any new matter which would in my judgment have lead the Courts to reach a different conclusion if it had been before them in the original suit. But even if I am mistaken in this view, and if the expiration of the Suess Canadian patent is a complete defence or if a decision of the questions raised as to the character and scope of the various patents now introduced for the first time should be postponed until final hearing, yet I am constrained to grant the injunction in order to permit an appeal and a determination of the questions at the earliest possible moment.

The motion for a preliminary injunction is granted with leave to defendants to move for a stay pending the decision of these questions by the Circuit Court of Appeals.

The oral opinion of the U.S. Court of Appeals in this case is printed in the Petition for Writ of Certiorari in this Injunction Case, at page 41.

Reported 150 Fed. Rep., p. 147.

UNITED STATES CIRCUIT COURT, SOUTHERN DISTRICT OF NEW YORK.

Victor Talking Machine Company, et al.,
Complainants,

v.

Leeds & Catlin Company,
Defendant.

LACOMBE, *C. J.*:

Aside from any other questions arising upon this motion as to disobedience of injunction order I am entirely satisfied from the proofs that defendants, not only in the instance set forth in complainant's moving papers, but in very many other instances have manufactured and sold the records of claim thirty-five with the intent that they should be used in combination with the other elements of that claim in machines other than "Mechanical-feed." Indeed, it is difficult to escape the conviction that the larger part of defendants' sales were contrived by them to enable the owners of reproducers purchased from complainant or its licensees to produce such musical pieces as such owners might desire to hear, through the co-operation in combination with such reproducers of records made by defendant instead of records made by complainant. No effort to restrict the use to which defendant's discs should be put by notice on their face or otherwise was made until after motion, and the affidavits are not as satisfying as they might be that such notice has since been affixed; and such notice might fairly go further and advise the purchasers that to use it on one of complainant's ma-

chines would make the user an infringer. This seems to be a case of contributory infringement—an entirely voluntary and intentional one, not in any wise excused by the circumstances that complainant had theretofore sold reproducers combined with other records to such owners. Am. Graph. Co. *v.* Leeds, 87 F. R. 873. Nor is the substitution of these new records, bought more frequently in order to increase the repertory of tunes than as substitutes for worn-out discs and wholly unlike the toilet paper in Morgan Envelope case (which was destroyed by a single use) in any legitimate sense "repairs." See Davis Electrical Works *v.* El. Light Co., 60 F. R. 276. Nor is the advice of counsel a sufficient excuse, although where it has been honestly relied upon a heavy penalty will not usually be imposed, but only a sum sufficient to reimburse the moving party and act as a deterrent from future infringing actions.

Defendant is found in contempt and fine imposed of $1000, one-half to United States, one-half to complainant. Collection will be suspended pending appeal.

January 5, 1907.

Reported 154 Fed. Rep., p. 58.

UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

The Leeds N *Catlin Company,*
Plaintiff in Error,

v.

The Victor Talking Machine Company and the United States Gramophone Company,
Defendants in Error.

ON WRIT OF ERROR TO THE CIRCUIT COURT OF THE UNITED STATES FOR THE SOUTHERN DISTRICT OF NEW YORK.

LOUIS HICKS, ESQ., for plaintiff in error (deft. below);

HORACE PETTIT, ESQ., for defendants in error.

HOUGH, *D. J.:*

Defendants in error having brought suit against the plaintiff in error alleging infringement of the Berliner gramophone patent (No. 534,543), procured an injunction restraining the manufacture, use or sale of sound reproducing apparatus or devices embodying the subject matter specified in claims five and thirty-five of said patent, and also the use or employment in any way of the method set forth in claim five thereof (reported 146 Fed. Rep. 534, affirmed by this Court, 148 Fed. Rep., 1022). The claims protected by such adjudications are

"a sound reproducing apparatus consisting of

> (1) a traveling tablet having a sound record formed thereon and (2) a reproducing stylus shaped for engagement with said record and free to be vibrated and propelled by the same, substantially as described." (No. 35.)

and the

> "Method of reproducing sounds from a record of the same consisting in (1) vibrating a stylus and (2) propelling the same along the record by and in accordance with the said record substantially as described." (No. 5.)

(the "record" being identical with the "traveling tablet" above mentioned.)

In other words the invention under consideration is the Victor Talking Machine, and the feature thereof here important is that its reproduction of sound depends upon the record groove cut in the traveling tablet (or disc record) *compelling* the movement of the stylus across the face of the record by the horizontal revolution of the record itself.

The reproducer of which the stylus is an integral part is covered by claims of the Berliner patent not now in question, but of the combination protected by claims five and thirty-five thereof the stylus alone (or rather the machine of which it forms a part) is itself patented, while the traveling tablet sound record or disc record, is an unpatented article.

The Leeds & Catlin Company is a manufacturer of disc records, and since the decision of this Court above referred to asserts that it has become a dealer in another talking machine known as the "feed-device machine," which for the purposes of this cause may be regarded as not infringing any of the rights of the Victor Company under the Berliner patent. The Leeds & Catlin disc records are equally suitable for the feed-device machine and for that of the defendant in error.

Plaintiff in error was found to have sold disc records forming an essenial part of the sound reproducing apparatus and devices covered by the above mentioned claims of the Berliner patent, and was fined for such violation of injunction. This writ of error is to review the order imposing said fine.

On ample evidence the Court below found; that most of the sales of Leeds & Catlin records were knowingly made by the plaintiff in error to enable the owners of Victor Talking machines to reproduce such musical pieces as they wished, by the combination of the Leeds & Catlin record with said machines that the Leeds & Catlin Company made no effort to restrict the use to which their records might be put until after motion to punish for contempt had been made; that the only effort at such restrictions ever made was to insert upon the face of the records a notice to the effect that such record was intended and sold for use with the "feed-device machine;" that the records sold by plaintiff in error were far more frequently bought to increase the repertoire of the purchaser's Victor machine than to replace worn-out or broken records.

In our opinion it is also established by the evidence that the "feed-device machine" above referred to, was not at or before the time of beginning this proceeding a practically or commercially known reproducer of musical or spoken sound, whereas the Victor machine, embodying the claims of the Berliner patent here under consideration, was at such times widely known and generally used, and the plaintiff in error knew, and sold its records with the knowledge, that if its output was to be used at all by the public, it would be used with the Victor machine, and in the combination protected by the claims of the Berliner patent above referred to.

Upon these facts it is clear that the Leeds & Catlin Company have made and sold a single element of the

claims of the Berliner patent, with the intent that it should be united to the other element and complete the combination—and this is infringement (Heaton Peninsular, etc. Co. *v.* Eureka Specialty Co., 77 F. R. at 297; adopted by this Court, Cortelyou *v.* Lowe, 111 F. R. 1005).

The facts above recited are scarcely controverted, nor is it denied that the above inference should ordinarily be drawn; but plaintiff in error seeks to avoid that result by asserting that the records under consideration are but temporary perishable and unpatented parts of the patented combination; and therefore under Morgan Envelope Co. *v.* Albany Paper Co., 152 U. S., 425, free to be manufactured and sold by anyone.

This contention is not supported by the evidence. Disc records are fragile, i. e., brittle and easily broken; but are not perishable, i. e., subject to decay by their inherent qualities or consumed by few uses or a single one. Neither are they temporary, i. e., not intended to endure; on the contrary we find them capable of remaining usful for an indefinite period, and believe that they usually last as long as does the vogue of the sounds they record.

A rifle bullet, lost by a single discharge, is a perishable and temporary part of the combination of rifle and ammunition; and probably a cartridge shell, though capable of re-loading and use several times, may also be so regarded; but the missle of a toy gun, picked up and used again and again on its original form, is in no proper sense of the words either "perishable" or "temporary," though it may by repeated use wear out sooner than does the gun with which it is repeatedly combined.

Again, it is urged inasmuch as disc records are unpatented articles of commerce, which may be used upon the feed-device machine or lawfully exported to foreign countries, that no infringement can be alleged against the maker and seller thereof, because his prod-

uct may be or is in fact used by purchasers as one element of a patented combination. This argument disregards the facts established herein. It is true that the doctrine of contributory infringement has never been applied to a case where the thing contributed is one of general use, or suitable to a variety of other uses; especially where there is no definite purpose that the thing sold shall be employed with others to infringe a patent right (Rumford Chemical Works *v.* Hygienic Chemical Co., 148, F. R. at 866, and cases cited). But this plaintiff in error is shown to have manufactured and sold records for the express purpose of supplying the users of Victor machines; nor are such records staple articles of commerce (Cortelyou *v.* Johnson, 145 F. R., at 935); on the contrary, they can not be practically used within the United States except with the Victor reproducer; for we regard the feed-device machine either as a curiosity or a pretence, while the foreign trade of the plaintiff in error is not interferred with by the injunction nor affected by the order under review.

It is further contended that those who purchase the patented combination in question without restriction, have lawful right to provide themselves with unpatented records made by any person whatever—by way of replacement and repair. We perceive no substantial difference in the meaning of these words. To return to use something injured or lost, or to substitute for something defaced or destroyed another thing substantially identical, is to repair. The right of general repairing has not been questioned; but what plaintiff in error has done is not to mend or better broken or other records, nor even to furnish new records identical with those originally offered by the Victor Company—but to place upon new discs such other sound records as are thought to command a market, and to induce users of the patented machine not to replace,

but to increase their stock of recorded words and music.

The right of repair is measured by the right of the owner of the patented article, and such owner when doing what is above outlined is no more repairing his machine than is one repairing a stereopticon—by changing the pictures therein to suit the whim of the person gazing through it.

The final contention against the order below, admits that the record actuating the stylus is a vital part of the combination claims of the patent in question, but declares that any purchaser of the patented article may immediately *substitute* for even an essential element therein, any other element which he conceives better suited to his purpose; and, of course, if this be true such preferred elements may be freely manufactured and sold.

We think this contention disposed of by Thomson Houston, etc., Co. *v.* Kelsey, etc., Co., 75 F. R., 1005; for the right of substitution there recognized was specifically restricted so as to refuse "authority to reconstruct or rebuild a combination which has been sold by the complainant"; and whenever a Leeds & Catlin record is placed in a Victor machine the patented combination is instantly reconstructed.

The right of substitution rests upon the right to improve, pointed out by Clifford, J., in Chaffee *v.* Belting Co., 22 How., at p. 223, and is different from the right to repair. But there is here no true substitution, and improvement is scarcely pretended. From a legal standpoint the discs of both parties are identical because the grooving capable of actuating the reproducer is the same; what is substituted is but music or words, and what is improved, either price, or novelty is sound. These are but accidents, and no more important than the color of the disc. The true inquiry is whether the owner of a patented combination, the elements of which are durable, unbroken and in good repair, may buy

from the patentee one specimen of a single element, from an outsider an indefinite number of identical specimens of the same element, and keep and use them all, under cover of the word "substitution"; it further appearing that the element so procured and used is useful and commercially known only in respect of the said combination.

We think this cannot lawfully be done, and affirm the order below.

WALLACE, *Circuit Judge* (dissenting):

In considering the question of infringement, claim five may be laid out of view, as it covers merely the function of the machine or combination of claim thirty-five. It is more than doubtful whether the claim is not void upon its face, but assuming it to be valid, as must be done for present purposes, it is not infringed except by using the combination or machine of claim thirty-five. A sound record is one of the parts enumerated in claim thirty-five. It is however, only a subsidiary part of the machine. Its relation to the machine proper is analogous to that of a sheet of paper in a typewriting machine or the stalks of corn in a corn cutter. It is the thing which is to be operated on by the machine proper. The invention of the claim consisted in substituting a universal joint, or swinging arm, in lieu of a feed-screw device, and thereby producing a new form of reproducing stylus for engaging with the record; and everything else in the machine was old. This clearly appears by the opinion in the suit in which the validity of the patent was established Victor Talking Machine Co. *v.* American Graphophone Co. (140 F. R., 860).

It is not questioned and cannot be, that the plaintiffs in error were at complete liberty to make and sell such sound records as they did, provided they did not sell them to purchasers who had no right to use them in combination with the other devices enumerated in claim thirty-five. They have been adjudged guilty of

contempt because they have sold them, or threatened to sell them, to users of the so-called "Victor" machine which embodies the combination, and who purchased their machines from the Victor Talking Machine Company, the owner of the patent. If these purchasers were at liberty to remove a sound record which originally accompanied the machine, and substitute for it a sound record sold by the plaintiffs in error, they were not infringers, and plainly the plaintiffs in error could not be infringers by assisting the purchasers to do that which they had a right to do. The real question in the case, therefore, is whether the purchasers of the Victor machines infringe the patent by using in their machines the sound records manufactured by the plaintiffs in error.

The purchaser of a patented machine from the owner of the patent acquires the right to do what he may choose with the particular machine, or any of its parts, as freely as he could if it, or none of its parts, had ever been patented. Undoubtedly he cannot, after his machine has practically ceased to exist for any useful purpose, reconstruct it by reparation, nor can he then reconstruct it by disorganizing it and substituting as new parts the dominating and vital features of the patented invention. But no question of this kind is involved in the present controversy. The only question is whether he can discard a part he does not care to use and substitute another. When such a part is not the fundamental invention in the patented machine, I cannot doubt he is at liberty to do so. This was so decided by this Court in the "trolley stand" case (Thomson-Houston Co. v. Kelsey Co., 75 F. R., 1005), and is not an open question in this Court unless it is proposed to reconsider and overrule that decision. He is not under any implied promise to maintain the machine as an entity and may do whatever he chooses with any of its parts, as fully as if there had not been a patent.

Let us consider from a practical standpoint what

any other rule would lead to in a case like the present. The purchaser here has bought with his machine a sound record, or half a dozen sound records, each having the necessary grooves cut in it to enable him to reproduce for his own pleasure a particular piece of music. The record is a fragile thing which is to be inserted into the machine by the user, and must be adjusted accurately to the vibrating parts, and is to be removed when he wants to reproduce a different piece of music. Any slip of the hand will destroy it. Not only is this so, but its sound producing qualities are lost by the contact of the needle which is vibrated in its grooves long before the machine proper is worn out, and generally early in its normal life. Whenever either of these things happens, a machine, which costs at least seventeen dollars, is disabled unless a record like one which has been sold with it at the price of thirty-five cents, and which anybody and everybody has a right to make, may be replaced in the machine in lieu of the useless one. If the owner of the patent stops manufacturing records, or no longer has in the market a record grooved like the one which has been destroyed, what is the purchaser to do if he has not the right to replace a record without the permission of the patent owner? The purchasers of the Victor machine cannot require the Victor Talking Machine Company to supply them with records, and can only procure them from it on such terms as it pleases to exact. If they are not at liberty to procure them elsewhere, the company can dictate how long they are to enjoy the use of their machine.

Such a rule of infringement as is adopted by the majority opinion, not only extends the monopoly of the patent owner to an unprecedented extent, but is subversive of the right of a purchaser of the patented thing to realize its fair measure of usefulness by making necessary reparations or changes by way of improvement.

Reported 158 Fed. Rep., p. 309.

UNITED STATES CIRCUIT COURT, SOUTHERN DISTRICT OF NEW YORK.

Victor Talking Machine Co., et al.,

v.

William H. Hoschke, Individually, &c.

ON MOTION FOR PRELIMINARY INJUNCTION.

HORACE PETTIT, for complainant;

WALDO G. MORSE, for defendant.

HOUGH, *D. J.*:

The patent in suit is No. 534,543, granted to Berliner; and the infringement asserted is of claims five and thirty-five; so frequently before the Courts of this Circuit. (140 Fed. Rep., 860; 145 Fed. Rep., 350; 146 Fed. Rep., 534; 148 Fed. Rep., 1022; 150 Fed. Rep., 147; 154 Fed. Rep., 58.)

The rulings which are the foundation of the decision in Victor Talking Machine Co. *v.* Leeds & Catlin Co. (146 Fed. Rep., 534), and the contempt proceeding following affirmance of that decree, are about to be reviewed in the Supreme Court.

Careful examination of the voluminous record here submitted strengthens the impression formed at hearing, that this is an endeavor to escape the necessary effect of the decisions of the Circuit Court of Appeals above referred to. While recognizing fully the gravity of the questions now awaiting decision in the highest Court, and the novelty in that Court of at least two of

the questions involved, I am not authorized to indulge in speculations of my own regarding them, but am bound to follow and apply the decisions controlling in the Courts of this Circuit.

It is admitted that those Courts have declared the Berliner patent not to have been anticipated nor abandoned, to be patentable and not invalidated by prior use (140 Fed Rep., 861), and not to have expired with the expiration of numerous foreign patents (146 Fed. Rep., 534).

The present assertions are (1) that evidence is now offered for the first time tending to show that the Suess Canadian Patent (No. 41,901) absolutely expired six years from the granting thereof, whereby the patent in suit also expired; and (2) that while this Circuit has decreed the validity of the Berliner patent, it has never been called upon to interpret its scope.

The evidence regarding the Suess patent as a defence is the affidavit of Mr. Walker, of the Canadian bar, declaring that in his opinion the effect of not paying the second partial fee provided for by the Canadian Patent Act is to absolutely terminate the patent at the expiration of six years. It is admitted that this has never been the subject of a decision by the Canadian Courts.

It may well be that this is the universal opinion of the Canadian bar, but it does not meet the ruling of Judge Townsend in 146 Fed. Rep., at 538, who there held "that the duration of the United States Patent is limited by the duration of the *legal term* of the foreign patent and is not limited by any lapse or forfeiture of any portion of said term by means of any condition subsequent." The non-payment of the second partial fee under the Canadian Act is clearly a condition subsequent, and the legal term of a Canadian patent is not six but eighteen years. It may be that such legal term absolutely ends when the second partial fee is not paid,

and that the words "lapse" or "forfeiture" would not be used by Canadian lawyers, and a lease may by its language end for non-payment of rent or other breach of condition; but such termination does not change the original "legal term" either of the patent or the lease. Judge Townsend's declaration of the law is not a construction of the Canadian Patent Act or a declaration of what the Canadian law on that subject may be, but a statement of the law of this country as effected by a Canadian statute, and there is no intimation in his ruling that the result would have been different had the Canadian practice appeared to be as it is now declared to be by the affidavit of Mr. Walker.

As to defendant's second contention, I do not think it true that the Courts of this Circuit have not interpreted the scope of the Berliner patent. Judge Hazel declared that "the lateral undulations in (complainant's) record automatically guide or propel the stylus and diaphragm in its course over the disc, from its outer circumference toward the center, and the stylus travels in an apparently direct radial path while at the same instant of time it is pulsated or incited by the sound waves." This is a description of the method of operation of complainant's talking machine.

The principal of operation of complainant's machine as declared in the same decision (140 Fed. Rep., 863), is the "lateral vibration of the stylus point and the propelling of the same over the surface of the record without mechanical assistance and through the means of the groove alone"; such is said to be the primary object of the inventor; and again (p. 864 of 140 Fed.) it is stated that the "principle of Berliner's invention rests upon the practicability of propelling the stylus in the groove across the surface of the record without a feed screw or other mechanism."

It has thus been definitely held that Berliner's invention covers the reproduction of sound by means of

a vibrating reproducing stylus, shaped for engagement with the laterally undulated groove of a sound record, and free to be vibrated and propelled by the revolving record itself, without the assistance or guidance of a feed screw or other mechanism.

The stylus of the patent being engaged with the spirally shaped groove of a horizontally revolving record, is compelled by such revolution to move in a radial path toward the center of disc and spiral, while its contemporaneous contact with the sides of the disc groove, causes a pulsation of the diaphragm and reproduction of the sound recorded by indentations or undulations of the groove walls.

Defendant's machine in every material feature is complainant's, and so is the disc obtained from defendant for use with that machine. The only difference between the two machines is that defendant's has within its free arm a spring tending to press the stylus against the inner wall of any groove with which it may be engaged, and causing arm and stylus when disengaged from any groove, to pass the stylus point through the arc of a circle whose radius is the free arm.

This is the distinction upon which defendant relies. That it is not a feed screw or other equivalent mechanism seems to me plain.

If a record be constructed with a groove so wide that it is not possible for an absolutely free stylus to engage both sides of the groove by merely rotating the grooved disc, it is shown, that complainant's machine will not produce articulate sound; while the defendant's will reproduce the same provided that the sound record is entirely upon that side of the groove with which the spring aforesaid compels engagement. And the result is the same if the disc be constructed with a wall formed by lowering the plane of the outer edge of the disc; such wall is in effect the inner side of a groove. In other words, the spring enables a stylus otherwise

free to reproduce articulate or musical sound recorded upon one wall, instead of two.

But it is also true that the spring of defendant's machine is not strong enough, and evidently not intended to be strong enough, to prevent its use with disc records of narrow grooving bearing sound markings or indentations on both sides of the groove, and with such records the presence or absence of the spring in defendant's machine makes no difference, as has been demonstrated in the presence of counsel.

Were defendant selling a machine containing this spring, together with wide grooved or wall records with reproducing indentations only upon the side against which the spring presses the stylus; it may be that no infringement would be found; but when defendant's machine is used in the same way, with the same disc, and produces the same effect by the same means, as does complainant's machine, it is an infringement notwithstanding the spring; and this is what defendant has done according to the proof

It seems clear, therefore, that defendant has infringed complainant's patented combination, and the fact that one element in the combination (i. e., the machine) may be used in combination with articles bearing no resemblance to the other elements of the combination as patented cannot make any difference; this litigation is not concerned with what defendant might do, but what he has done. He might, perhaps, have avoided infringement by varying his combination; so might the defendants in the last case concerning this patent (154 Fed. Rep., p. 58).

An injunction may issue as prayed for.

December 27, 1907.

C. M. HOUGH,
D. J.